

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

THETA IP, LLC,
Patent Owner.

Case IPR2024-00816
U.S. Patent No. 7,010,330

**PATENT OWNER THETA IP LLC'S
REQUEST FOR DIRECTOR REVIEW**

FEE PAYMENT AUTHORIZATION

P-TACTS fee payment was unavailable. Credit card payment form submitted via FAX on 12/29/2025. Please charge all fees required for this submission, including any additional fees that may be incurred, to Deposit Account No. 606715. The undersigned authorizes the United States Patent and Trademark Office to debit the specified deposit account for any amounts due in connection with this request.

/ Aaron R. Hand /
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EX2002	"Yannis Tsividis, Path-Breaking Researcher and Educator," IEEE Solid State Circuits Magazine, Fall 2014
EX2003	Y. Tsividis <i>et al.</i> , "Internally Varying Analog Circuits Minimize Power Dissipation," IEEE Circuits & Devices Magazine, Jan. 2003
EX2004	Y. Tsividis, "Signal-to-Noise Ratio, Dynamic Range, and Power Dissipation," IEEE Solid State Circuits Magazine, Fall 2018
EX2005	Declaration of Professor Lawrence Larson, Ph.D. under 37 C.F.R. § 1.68 in support of Patent Owner's Preliminary Response in IPR2024-00816, -00817, -00818, -00819, and -00820.
EX2006	<i>Curriculum Vitae</i> of Professor Larson
EX2007	IPR2023-00694, Paper 10, Decision Denying Institution (P.T.A.B. Oct. 23, 2023)
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EX2009	U.S. Patent No. 5,001,776 (<i>Clark</i>)
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EX2011	Excerpts of Invalidity Contentions, <i>Theta IP, LLC v. Lenovo (United States) Inc., et al.</i> , 1-22-cv-03441 (N.D. Ill.)
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EX2015	March 25, 2024 Email from Court listing Preliminary Constructions, <i>Theta IP, LLC v. Apple Inc.</i> , No. 6:23-cv-00314-ADA (W.D. Tex.)
EX2016	March 25, 2024 Email from Apple to Court re: <i>Markman, Theta IP, LLC v. Apple Inc.</i> , No. 6:23-cv-00314-ADA (W.D. Tex.)
EX2017	Transcript of <i>Markman</i> hearing, <i>Theta IP, LLC v. Apple Inc.</i> , No. 6:23-cv-00314-ADA (W.D. Tex. Mar. 26, 2024)
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I. Introduction

This proceeding should not have gone forward—and should be vacated and dismissed now. This proceeding, and the Board’s resulting decision invalidating an expired, litigated patent—which claims foundational RF circuit power saving inventions of respected Columbia University Professor, Yannis Tsividis—was and is contrary to Office policies for multiple reasons. First, the art at issue here was considered by the Examiner, and the Petition failed to show that the Examiner materially erred. Second, this IPR is an admitted follow-on to prior IPR proceedings against the ’330 and related patents that include substantively the same claim limitation, in which the Board reached different, irreconcilable results. Yet, the Board issued a Final Written Decision here that fails to explain “why a different outcome is warranted” on the same “in the signal path” language. It was not warranted, and it is not. Memorandum, PTAB Consideration of Prior Findings of Fact and Conclusions of Law (Sept. 16, 2025). Finally, the Board ignored Theta’s settled expectations in its long-held patent rights that have been litigated and recognized. *See, e.g.*, Memorandum, Interim Processes for PTAB Workload Management (Mar. 26, 2025).

The inventions of the ’330 Patent save power by dynamically adjusting an impedance, or bias current, during operation, in response to changing signal conditions. Response, Paper 16, at 13-19; EX1001 (claim 23). Critically, the claims do so by adjusting circuit parameters rather than making changes to the signal path.

Id. Specifically, the claims of the '330 Patent require that, *e.g.*, “***an*** impedance [or ***a*** bias current] ***in*** the signal path is configured to be dynamically adjusted.” EX1001 (claim 23). In other words, a circuit component must be and remain ***in*** the signal path and have its impedance or bias parameter adjusted dynamically in response to changing conditions. Professor Tsividis disclosed and taught these inventions to the world, both in the patent and in published articles. *Id.*; EX2002-EX2004. They are used to great benefit in most cellular devices today. Continuation patents with claims including similar limitations were litigated against Samsung to a courthouse steps settlement in 2021, with Samsung taking a license hours before trial was set to begin. Response, 4.

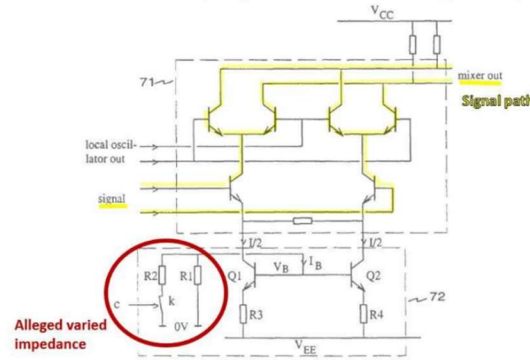
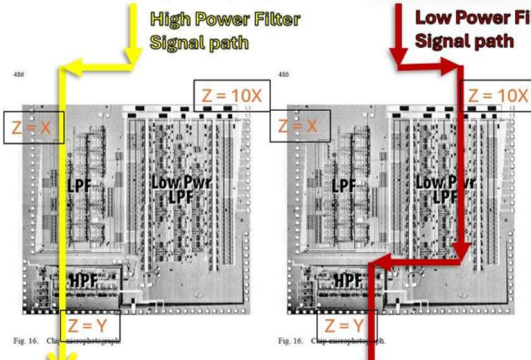
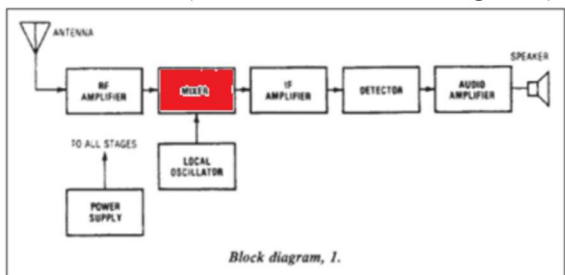
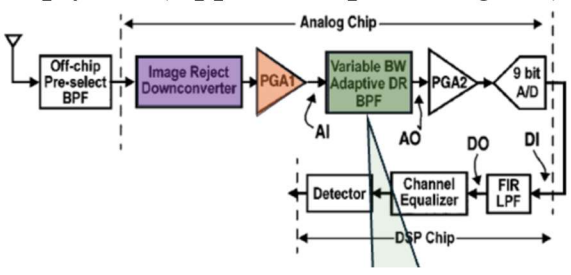
In Apple’s cited prior art, however, which was previously before the Examiner, the signal path ***itself*** is what is changed, to re-route the path through one entire filter instead of another with a different impedance and bias. It is undisputed that either one path, or a different path, must be chosen. No impedance [or bias current] remains in the signal path to be adjusted in Apple’s cited prior art. This is fundamentally different than dynamically adjusting “***an*** impedance [or ***a*** bias current] ***in*** the signal path.”

In view of this critical distinction, it is no surprise that that the '330 Patent claims issued over the art that Apple asserted here, which Theta and Professor Tsividis put before the Examiner decades ago. Response, 1. But Apple failed to show material error by any Examiner considering that art, as the Office has precedentially and

repeatedly required challengers to do. Indeed, the Director reaffirmed the need to show material error during pendency of this proceeding—specifically disallowing the exact rationale the Board cited in instituting here. Sur-Reply, 25-27.

The '330 Patent and two of its continuations also survived on their merits over prior IPRs filed by Lenovo. *Id.*; EX2007, EX2008, EX2022-EX2024. In the prior IPRs, Lenovo argued that an entire mixer block was in the signal path and was “not separable into a portion within the signal path and a portion without.” EX2024, 1. This argument was soundly rejected by that prior Board panel. Response, 4-5, 30-32; Paper 31 (Hearing Tr.) at 45-46; EX2008 (Decision Denying Rehearing), 2 (rejecting argument that “the entirety of Figure 7 is a mixer within the signal path”), 8-9.

Here, Apple argued that an entire bandpass block was in the signal path. In contrast to the prior panel, the Board *accepted* Apple’s invitation to ignore the actual signal path inside what is labeled as the bandpass block—wherein *the signal path* admittedly changes.

Lenovo IPRs	Apple IPRs
EX2008, 9 (Signal Path Diagram)  Fig. 7	EX2020, ¶75 (Signal Path Diagram)  Fig. 16: High Power Filter Signal path Fig. 16: Low Power Filter Signal path
EX2024, 6 (Lenovo Mixer Diagram)  Block diagram, 1.	Reply, 14 (Apple Bandpass Diagram) 

Neither signal path diagram above shows dynamically adjusting an impedance [or a bias] that remains “in the signal path,” and this panel’s FWD simply cannot be reconciled with the Examiner’s decision to issue the claims or the Board’s prior decisions as to the ’330 or related patents with the same limitations. *See, e.g.*, EX2020, ¶¶81-83. The Board applied an interpretation and application of the “in the signal path” claim language that contradicted the prior art itself, refusing to accept something that was undisputed by any witness. *Compare* FWD (Paper 32) at 49 (“We are not persuaded that different routing *within* the Variable Bandpass Filter Block ‘changes’ or ‘re-routes’ the signal path.”) *with* Reply, 17 (“Petitioner’s core theory: ...

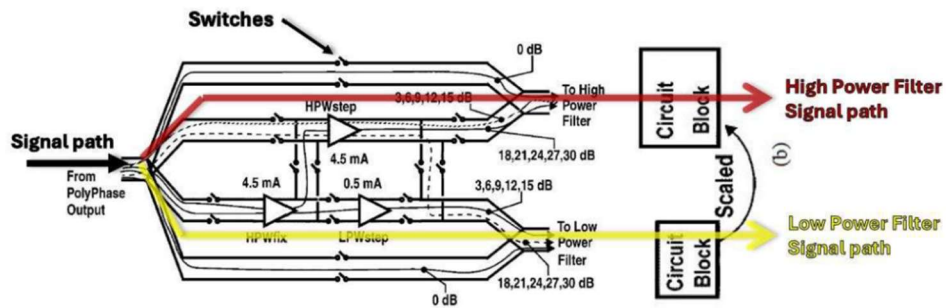
impedance is dynamically adjusted by switching between two alternative filter paths ...”); *see also* EX2021 (Abidi Dep.) at 67:5-69:18, 76:16-77:24; EX2020, ¶¶81-83.

Theta’s settled expectations, Office policies promoting consistency and difference to prior decisions, and stakeholder confidence in the patent system have all been frustrated by the result in this case. As noted in recent proposed rulemaking, “multiple challenges to the same patent through IPRs jeopardize the reliability of patent rights and incentives to invest in new technologies,” and “[e]ven extremely strong patents become unreliable when subject to serial or parallel validity challenges.” Revision to Rules of Practice before the Patent Trial and Appeal Board, 90 FR 48335 (Oct. 17, 2025) (“Proposed Rule”). This is precisely what happened here, in a particularly egregious fashion, as the Board panel came out the opposite way on a similar question here, versus the Board panel in prior IPRs. And the Board failed to adequately explain why this different result could be warranted. Theta’s settled expectations, and the Examiner’s and Board’s prior determinations, deserved more deference than they got from the Decision here.

II. The Board’s interpretation of “in the signal path” is inconsistent with the claims, specification, extrinsic evidence, and the Board’s prior interpretation of “in the signal path.”

The Board acknowledged that the dispute here turned on whether swapping a high-power filter for a low-power filter was dynamically adjusting an impedance *in the signal path* as claimed—or instead was just the different approach of changing the

signal path. FWD (Paper 32), 40, 36-39. There was no dispute that the prior art change involved substituting one path, through one low-pass filter, for another path, through another low-pass filter. *Id.*; Reply, 17; EX2021 (Abidi Dep.) at 67:5-69:18, 76:16-77:24 (“... the transconductance block that the signal is experiencing has been swapped. A. Yes.”); FWD, 38:



Yet the Board argued, seemingly against logic, and certainly against the evidence, that choosing one of two paths was not changing the path. FWD, 49 (“The signal path is not “re-routed” or “changed,” as Patent Owner argues – it just chooses which filter to put into operation and follows that signal path.”). Switching one path to be followed for another is re-routing or changing the signal path.

Because the change was to the signal path and the signal “experience,” not an adjustment to any individual circuit block, Theta’s expert explained that: “What the band-pass filter of the *Behbahani* papers does not have is any individual impedance “in the signal path” that changes dynamically during operation.” EX2020, ¶¶81-83 (“*no impedance remains in the circuit path and is adjusted*”). Theta showed, in unrebutted testimony, the two alternative signal paths through the band-pass filter and

the unchanged impedances (“Z”) of each. *Id.* (annotating diagram of bandpass filter). This argument is simple, un rebutted, and directly from the claims. One does not “dynamically chang[e] *an* impedance of *a* component *in* the signal path” by changing the signal path to run *through different components*. EX1001 (claim 1).

And as for what is the component: Apple’s expert first identified the two swapped low-pass filters *within* the Variable Bandpass Filter Block. EX1003, ¶133; EX2021 at 67:5-69:18 (“Q. So, in your opinion, what component in the signal path has its impedance dynamically changed? A. The transconductors. Q. *Of the low-pass filter?* A. *Yes*. Q. Okay. Now you’re saying this occurs upon the switch from the low- to the high-power filter; right? A. Yes.”). The Decision focuses heavily on Apple’s subsequent identification in its reply of the entire “bandpass” as the component, but even at that higher level view, the change is still a signal path swap, which is distinct from what is claimed. EX2020, ¶¶81-83.

But even Apple admits that the *signal path* *does* switch between one or the other of the low-pass filters. *See, e.g.*, Reply, 6-7 (“As illustrated below, this variable filter block is dynamically adjusted by *switching between two scaled low pass filter (“LPF”) paths*”) 17; Sur-Reply, 9-11, 14-15; EX2020, ¶¶57-63; EX2021 (Abidi Tr.) at 33:11-15 (“When you did the swap, the signal was, as you said, rerouted to the other filter, and that filter is turned on and used. And then, when you're not using it, you turn it off to save power; right? A. Correct. That's right.”), 77:10-24.

Because the path changes and one filter is completely disabled in the swap for another, even with the larger block, no *individual* impedance both remains in the circuit path and is adjusted. EX2020, ¶¶81-83; EX1001 (claim 23) (“*an* impedance *in* the signal path is ... adjusted”). The Board’s treatment of the entire bandpass as a single impedance was contradicted by the evidence. *See, e.g.*, EX2020, ¶¶82-83; Sur-Reply, 11-13, 14-15. The bandpass block is made up of multiple sub-blocks and impedance, none of which changes while it is “in the signal path.” *Id.* That the signal path both goes in and out of the bandpass filter block does not change the fact that the only identified change in the *Behbahani* system results from a wholesale swap of the signal path within that block.

As explained above, Lenovo made the same argument in its failed IPRs as Apple did here—drawing a bigger box around a change that was not “in the signal path,” to suggest that the distinction didn’t matter, because the entire larger block was in the signal path. Response, 4-5, 29-31; EX2007; EX2008 (Decision Denying Rehearing), 2 (“the entirety of Figure 7 is a mixer within the signal path”), 8-9. The Board in IPR2023-00694 rejected that argument—because the element alleged to have changed was not in the signal path. *Id.*

The Board’s Decision does not distinguish the Board’s prior result—which rejected an attempt to cite to an entire “mixer” block in the signal path to avoid the consequence of the signal path inside that block—from the result here, where Apple

cited to an entire “bandpass” block to avoid the consequence of the signal path change inside that block. FWD at 53-54. It was error here for the Board to ignore the progress of the signal path *inside* the bandpass block—and the different way that the identified change was accomplished, by re-routing a signal path instead of making a change to anything remaining “in the signal path.” The Board’s in-one-side-out-the-other interpretation could refer to any arbitrary division or even the whole device. FWD, 48-49. It would remain contrary to the undisputed evidence of how the change occurs. These conflicting results were not explained by the Board, and cannot be because they are irreconcilable.

III. Apple’s follow-on IPR should have been de-instituted.

A. Apple failed to show material error in the Examiner’s 2003 review of the *Behbahani* papers and Tsividis article.

Section 325(d), and the precedential *Advanced Bionics* decision guiding its application, both serve valuable policy goals of the Office—giving deference to prior Office determinations in order to protect expectations and reliance, and to avoid inconsistency that undermines stakeholder confidence in the patent system. *See, e.g., Advanced Bionics, LLC v. MedEl Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 at 9 (P.T.A.B. Feb. 13, 2020) (precedential) (“At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.”). The requirement to show material error, when as here the asserted prior art has been previously considered by

the Office, directly serves these core purposes. Prelim. Response, Paper 8 at 57-59. For example, deference to prior decisions avoids embarrassing and frustrating inconsistent results—after patentees have relied on rights granted by the Office.

At institution, the Board found that even though Apple had not shown material error by the Examiner in consideration of the *Behbahani* papers, such failure could be avoided “by pointing to the proposed grounds.” Inst. Decision, Paper 12, at 23. Theta had argued that allowing “general and conclusory reference to ‘the strength of the Proposed Grounds’” to substitute for such a material error showing is “inconsistent with the express precedential language of *Advanced Bionics*.” Paper 8, at 56-62.

After institution and Theta’s Response, the Acting Director precedentially disagreed with the Board’s rationale here. The Director resolved disagreement between various Board panels applying section 325(d), as to “whether a petitioner must explain how the Examiner erred or whether a petitioner can simply rely on its unpatentability contentions to imply that an error occurred.” *Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 5, 2025 WL 1441509 (P.T.A.B. May 19, 2025) (precedential). The Director precedentially took the same view that Theta had argued, finding that: “Petitioner’s ***generalized statements as to the strength of its Petition fail to identify sufficiently a material error***. Ordinarily, that would mean a denial of institution.” *Id.* at 5. Here, where that exact Petitioner reliance on “generalized statements” occurred, and was incorrectly used to justify institution,

discretionary de-institution was, and remains, warranted.

Theta raised the *Ecto World* decision, and its rejection of the Board’s institution rationale, in its next pleading. Sur-Reply, 25-27 (“Here, Section 325(d) discretion was not exercised, on a disputed basis that was disallowed months later.”). Theta asked for dismissal in the Director’s *ongoing* discretion to efficiently control the Office’s docket, protect settled expectations, and avoid inconsistent results. *Id.* The Director’s ongoing discretion to de-institute is a matter that should have been considered, after *Ecto World* directly refuted the panel’s basis for institution—and that discretion should be exercised now for all the reasons herein. Settled expectations and consistency of results remain important considerations even after a panel Decision.

The Board’s Final Written Decision declined to apply the *Ecto World* precedential rule, stating that it would only be appropriate to do so for “subsequent matters.” FWD, 57. ***This was error.*** See, e.g., *Sling TV, L.L.C. v. Realtime Adaptive Streaming LLC*, 2020 WL 261827 at *2 (P.T.A.B. Jan. 17, 2020) (finding post-institution request to be “just such a ‘subsequent matter,’ even if the original Petition is not,” and also applying a rule in the Board’s “‘inherent authority to reconsider [our] decisions,’ regardless of whether Patent Owner filed a request for rehearing.”); see also *ZTE (USA) Inc. v. Fundamental Innovation Systems International LLC*, IPR2018-00111, 2019 WL 1811121 at *3, fn. 3 (P.T.A.B. Apr. 24, 2019) (applying rule made precedential after briefing by the parties). The Director maintains the discretion to

prevent invalidation of the strong '330 Patent now, and should do so.

The claims require the dynamic adjusting remain “in the signal path,” and in the *Behbahani* references, *any* change that occurs results instead from swapping the signal path. Crediting this distinction is apparently a question about which different panels may differ. *See Advanced Bionics*, IPR2019-01469, Paper 6 at 9; Proposed Rule, 90 FR 48335 (“Because reasonable minds may, and frequently do, disagree about whether a particular patent claim meets the statutory requirements, patents cannot serve their economic function if they are perpetually subject to *de novo* review.”).

The original Examiner (presumptively), the Board panel reviewing Lenovo’s IPRs, and Theta’s expert all understood that a change that was not made to something in or remaining in the signal path did not meet the “in the signal path” element as claimed—and understood that this distinction could not be abstracted away by only looking at a higher level description of a block diagram. *See, e.g.*, Sur-Reply, 9-18, 20-21; EX2020, ¶¶ 81-83. But the Board here was “not persuaded.” FWD, 49. Allowing a strong patent to fall, under prior art first put before the Examiner more than twenty years ago, and in an admitted follow-on challenge, would frustrate not just the economic value of Theta’s strong patent, but also all of the policies discussed herein and the Director’s goal of promoting a reliable patent system where this sort of thing does not happen to good patents. Response, 11-12, Sur-Reply, 8, 25-27.

B. Follow-on Petitions like Apple’s are disfavored, including because they can create inconsistencies and frustrate reliance, as happened here

Here there was no question that this proceeding was merely a follow-on to failed efforts to invalidate the Tsividis Patents by Samsung (in district court litigations) and Lenovo (before the Board). Apple self-described its challenge as trying to correct a gap in the prior art that has “plagued prior invalidity challenges.” Petition, 36. Theta explained why such a proceeding should not be instituted. Prelim. Response, 52-56; Response, 11-12.

The case against follow-on challenges is well presented in the Office’s recently proposed rulemaking that would amend institution rule 37 C.F.R. § 42.108. *See* Proposed Rule, 90 FR 48335 (“[M]ultiple challenges to the same patent through IPRs jeopardize the reliability of patent rights and incentives to invest in new technologies.”). As the Office noted: “Even extremely strong patents become unreliable when subject to serial or parallel validity challenges.” *Id.*

In an effort to prevent strong patents from falling to the additive pressure of repeated *de novo* review initiated by accused infringers, the Board has repeatedly disfavored follow-on Petitions. *See, e.g., id.; General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, 2017 WL 3917706, at *12 (P.T.A.B. Sept. 6, 2017) (precedential as to § II.B.4.i) (“Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.”). The Board has repeatedly found Petitions that roadmap from prior challenges to be “unfair to patent

owners” and “an inefficient use of the *inter partes* review process.” *Id.*

Yet despite this guidance, “serial and parallel patent challenges, including challenges raising the same or substantially similar prior art and/or arguments, remain a significant problem.” Proposed Rule, 90 FR at 48336. And what happened here shows precisely the harm of letting each accused infringer have its own serial challenge, based on its own selection of art, before different factfinders. Theta seemingly cannot rely on the Office’s considered grant of strong intellectual property rights in Theta’s inventions even at or after the end of the ’330 Patent’s term. This harm is underscored by this Board panel’s failure to reconcile its analysis with those of the prior Board panel.

Compounding the follow-on nature of its challenge, Apple chose cumulative prior art references long ago cited to the Examiner—and known to Samsung, Lenovo, Apple, and the rest of the world from the ’330 Patent itself. EX1001, 2. Samsung, Lenovo, and Apple each included *Behbahani* in their respective district court invalidity contentions. *See, e.g.*, EX2010, 2; EX2011, 2-3; EX2012, 3. Apple has also insisted that it can take its arguments about the *Behbahani* papers to jury trial in the Western District of Texas. There was, and there remains, no need for this proceeding. If the Final Written Decision is not reversed, then Theta’s settled expectations in its important, oft challenged, and successful patent will have been completely frustrated.

C. Theta’s settled expectations in its rights under the ’330 patent were frustrated by this proceeding

The decades over which the ’330 patent remained valid, was widely cited, and was asserted against infringers—and overcame their invalidity challenges—created settled expectations of Theta that it could continue to assert the patent family against Apple without bearing the burden of duplicative, and potentially inconsistent, additional proceedings before the Board. *See, e.g., Dabico Airport Sol’ns Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 (P.T.A.B. June 18, 2025). Theta’s settled expectations provide yet another reason this proceeding would not have been instituted today, and should be de-instituted in the Director’s ongoing discretion now.

IV. Conclusion

For all the reasons detailed above, including because the Decision misinterprets and misapplies the “in the signal path” language of the claims—contrary to the evidence and to prior determinations by the Office—the Decision should be vacated, and this proceeding should be de-instituted in the Director’s ongoing discretion.

Dated: December 29, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

Petitioners have consented to e-mail service in this proceeding. Pursuant to 37 C.F.R. §42.6, the undersigned certifies that on December 29, 2025, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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