UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. AND SAMSUNG ELECTRONICS AMERICA, INC.

Petitioners,

v.

HARBOR ISLAND DYNAMIC, LLC

Patent Owner.

Patent No. 9,147,609
Filing Date: March 8, 2012
Issue Date: September 29, 2015

Inventor: Hady Jebory and David J. Howard
Title: THROUGH SILICON VIA STRUCTURE METHOD OF FORMATION, AND INTEGRATION IN SEMICONDUCTOR SUBSTRATE

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

Case No. IPR2024-01404

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EXHIBIT LIST

Exhibit No.	Description of Document
2001	Docket Control Order, Dkt. 38, in *Harbor Island Dynamic, LLC v. Samsung Elecs. Co.*, Case No. 2:24-cv-00140-JRG-RSP (E.D. Tex. Aug. 5, 2024)
2002	Order Denying Samsung's Motion to Stay Pending *Inter Partes* Review, Dkt. 62, in *Harbor Island Dynamic, LLC v. Samsung Elecs. Co.*, Case No. 2:24-cv-00140-JRG-RSP (E.D. Tex. Dec. 19, 2024)
2003	Defendants' Invalidity Contentions, served on September 26, 2024, in *Harbor Island Dynamic, LLC v. Samsung Elecs. Co.*, Case No. 2:24-cv-00140-JRG-RSP (E.D. Tex.)
2004	Merriam-Webster Dictionary definition for the word "tapered."
2005	Dictionary.com definition for the word "tapered."
2006	Oxford English Dictionary definition for the word "tapered."

I. INTRODUCTION

On January 10, 2025, Patent Owner filed a Preliminary Response in this action, arguing for denial of institution based on technical failures of the prior art as well as seeking discretionary denial as the trial date in the parallel district court action is currently scheduled for January 2026, three months before the statutory deadline for Final Written Decision in this action. *See* Paper No. 7.

On April 4, 2025, the Board granted institution of *inter partes* review of all challenged claims of U.S. Patent No. 9,147,609. *See* Ex. 1001 (the "'609 Patent"); *see also* Paper No. 9 ("Decision" or "Dec.").

The panel's analysis of the discretionary denial considerations is fundamentally flawed and inconsistent with both *Fintiv* and the March 26, 2025 Memorandum Regarding Interim Processes for PTAB Workload Management ("March 26 Memo"). The panel inappropriately discounted the January 5, 2026 trial date in the parallel district court action by stating that the trial date "may be continued under certain circumstances" The panel found that "the final decision date in this case will be approximately four months after the originally scheduled trial date" and therefore found that *Fintiv* Factor 2 only "weighs slightly in favor of exercising our discretion to deny institution." Dec. at 8-9. But the panel misread the District Court scheduling order, which merely provides situations in which continuances are *not* appropriate, and also notes that certain dates (such as jury

selection) "cannot be changed without an acceptable showing of good cause. Good cause is not shown merely by indicating that the parties agree that the deadline should be changed." Ex. 2001 at 5, 6. The panel's dismissal of the trial date in the pending district court action based on a fact that occurs in every litigation—the trial date potentially moving—effectively rendered *Fintiv* Factor 2 meaningless, and was, therefore an abuse of discretion.

Patent Owner, therefore, respectfully requests Director Review of the panel's *Fintiv* analysis.

II. BACKGROUND

Approximately a month prior to the Institution Decision, on February 28, 2025, the USPTO rescinded a June 21, 2022 memorandum issued by the former Director that provided guidance on discretionary denials. In its place, the USPTO issued a Memorandum Regarding Guidance on USPTO's Recission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" ("March 24 Memo").

The USPTO issued a March 26, 2025 Memorandum Regarding Interim Processes for PTAB Workload Management, creating a new bifurcation procedure wherein the Director, in consultation with at least three PTAB judges, will decide issues related to discretionary denial separate from merits-based issues. March 26 Memo. The March 26, 2025 Memorandum specifically reaffirmed the precedential

status of *Fintiv*, explaining that discretionary denial will continue to rely on that and other cases. March 26 Memo at 2.

III. LEGAL STANDARD

The Director "may review final PTAB decisions and . . . issue decisions . . . on behalf of the Board." *United States v. Arthrex, Inc.*, 141 S. Ct. 1970, 1987 (2021). "Requests for Director Review of a Board's decision on institution under 35 U.S.C. §§ 135, 314, or 324, or decisions granting rehearing of such a decision, shall be limited to decisions presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law. Both discretionary and merits-based issues may be raised, subject to limitations (a)–(d) above." *See* USPTO, Revised Interim Director Review Process at 2.B, Availability of Director Review: AIA Trial Proceedings (last modified March 18, 2025), https://www.uspto.gov/patents/ptab/decisions/director-review-process. "'An abuse of discretion is found if [a] decision: (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact finding; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.'" *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016) (quoting *Bilstad v. Wakalopulos*, 386 F.3d 1116, 1121 (Fed. Cir. 2004) (citations omitted)).

IV. DISCUSSION

Patent Owner respectfully requests that this proceeding be remanded to the panel with instructions to deny institution based on the discretionary denial factors outlined in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020).

Foremost, the panel abused its discretion by failing to adequately weigh the proximity of the District Court's trial date. Director Review is necessary to remedy this error. In *Fintiv*, the PTAB held that "[i]f 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 . . . ." *Fintiv*, IPR2020-00019, Paper 11 at 9. The PTAB did not make an exception or give a panel the power to decide, on a whim, that the trial date ***may*** move, and, based on that subjective judgment, afford this factor only "slight" weight. The panel's decision to afford the trial date such little weight is in conflict with *Fintiv* and other decisions.[1]

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[1] In situations such as these, the PTAB routinely declines to institute based almost exclusively on the proximity of the trial date. *See Supercell Oy v. Gree, Inc.*, IPR2020-00513, Paper 11 at 10-12 (P.T.A.B. June 24, 2020) (denying institution where the jury trial was scheduled to conclude approximately ten months before the statutory deadline); *Edward LifeSciences Corp. v. Evalve, Inc.*, IPR2019-01479,

The trial date in the parallel district court action is among the dates that *cannot* be moved without "good cause," thus showing that the trial date is *less* likely to move than other dates earlier in the schedule. Nevertheless, the panel noted that there is a section in the district court's scheduling order which relates to continuances, and therefore decided that the schedule "contemplates that the trial date may be continued under certain circumstances." Dec. at 8 (citing Ex. 2001 at 6). But that section only delineates situations that do *not* warrant a continuance, including the

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Paper 7, at 6-13 (P.T.A.B. Feb. 26, 2020) (denying institution where jury trial would conclude more than nine months before a final decision would be due); *Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7, at 7-10 (P.T.A.B. Jan. 7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TrustID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude "several months," before a final decision would be due); *Cisco Sys., Inc. v. Ranot At Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 8 (P.T.A.B. May 15, 2020) ("Because the trial date is substantially earlier than the projected statutory deadline for the Board's final decision, this factor weighs in favor of discretionary denial.").

pendency of summary judgment motions, the fact that the attorneys have trials scheduled in other matters, or that discovery is incomplete. Ex. 2001 at 6 ("Motions for Continuance"). This indicates that the district court is less likely, not more likely, to move the trial date based on frequently-occurring situations that often cause continuances in other districts.

In addition, the PTAB's March 24, 2025 Memorandum providing Guidance on the recission of the prior Discretionary Denial Memorandum, provides persuasive authority that the proximity of the trial date should have been found, alone, to warrant discretionary denial. The March 24, 2025 Memorandum states that the *Fintiv* factors apply when there is a parallel proceeding before the International Trade Commission ("ITC"). March 24 Memo at 2. The Memorandum states that "the Board is more likely to deny institution where the ITC's projected final determination date is earlier than the Board's deadline to issue a final written decision . . . ." *Id.* Although the parallel litigation in this action is in district court and not at the ITC, the same logic applies: the proximity of the district court's trial date should be treated the same way as the final determination date in the ITC, and therefore it should be more likely to deny institution in this very situation. The Board erred by holding that *Fintiv* Factor 2 weighs only "slightly" in favor of discretionary denial, when this factor weighs *strongly* in favor of discretionary denial.

Moreover, regarding *Fintiv* Factor 3, the panel minimized the investment in the parallel proceeding by the Court and the Parties, merely noting that "the parties and district court have invested some time" in the litigation, but that "substantial work remains to be done including the completion of fact and expert discovery, claim construction briefing and decision, pretrial motions, and preparation of a joint pretrial order." Dec. at 8. If that analysis were proper, there could be no discretionary denials until after these events occur, several of which may be mere weeks before the trial date. In contrast to its dismissal of the trial date, the panel relied on the district court's scheduling order for these dates without comment, while in the prior factor expressly discounting a date because it "may" move.

V. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests Director Review of the institution decision.

Respectfully submitted,

Dated: April 11, 2025 By: /*Joseph M. Mercadante* /

Joseph M. Mercadante (Reg. No. 64,077)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796
Email: jmercadante@fabricantllp.com

CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. §§42.6(e) and 42.105, the undersigned certifies that on April 11, 2025, a complete and entire copy of the foregoing was served on Petitioner's counsel of record as follows:

Joshua L. Goldberg
Email: joshua.goldberg@finnegan.com
Alexander E. Harding
Email: alexander.harding@finnegan.com
Chen Zang
Email: chen.zang@finnegan.com
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
901 New York Avenue NW
Washington, DC 20001-4413

Abhay A. Watwe
Email: abhay.watwe@finnegan.com
Biju I. Chandran
Email: biju.chandran@finnegan.com
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
1875 Explorer Street, Suite 800
Reston, VA 20190-6023

Shawn S. Chang
Email: shawn.chang@finnegan.com
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
271 17th Street, NW, Suite 1400
Atlanta, GA, 30363-6209

Attorneys for Samsung Electronics Co., Ltd.; Samsung Electronics America, Inc.

April 11, 2025

By: /*Joseph M. Mercadante* /

Joseph M. Mercadante (Reg. No. 64,077)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796