

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

DH INTERNATIONAL LTD.,
Patent Owner

PTAB Case No. IPR2025-00172

Patent No. 9,022,294

**PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW UNDER
37 C.F.R. § 42.75 OF A DECISION TO INSTITUTE**

July 9, 2025

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TABLE OF EXHIBITS

Exhibit	Title
1001	U.S. Patent No. 9,022,294 to Gaillard <i>et al.</i> (“’294 Patent”)
1002	U.S. App. No. 10/552,912 (issued as U.S. 7,628,333) (“Parent Application”)
1003	Prosecution History of U.S. Patent No. 9,022,294
1004	Declaration of Michael Buehrer (“ <i>Buehrer</i> ”)
1005	Japanese Patent No. 2003110751 to Suga (“ <i>Suga</i> ”)
1006	International Patent Application Publication No. WO 2001/22662 to Gorsuch (“ <i>Gorsuch</i> ”)
1007	U.S. Patent No. 8,792,454 to Taniuchi <i>et al.</i> (“ <i>Taniuchi</i> ”)
1008	U.S. Patent No. 8,165,559 to Klesper <i>et al.</i> (“ <i>Klesper</i> ”)
1009	Nokia Corporation, Nokia 6136 User Guide, 9252766 Issue 2, copyright 2007 (“ <i>Nokia 6136</i> ”)
1010	U.S. Patent Publication No. 2007/0277120 to Wilson <i>et al.</i> (“ <i>Wilson</i> ”)
1011	Feng Zhang, Vertical Handoff Between 3G Networks and WLANS, copyright 2005 (“ <i>Zhang</i> ”)
1012	Al Sacco, The Eight Hottest Smartphones of 2008, computerworld.com, https://www.computerworld.com/article/1367892/the-eighthottest-smartphones-of-2008.html (“ <i>Sacco</i> ”)
1013	U.S. Patent No. 7,660,854 to Sorotzkin (“ <i>Sorotzkin</i> ”)
1014	U.S. Patent No. 6,671,718 to Meister <i>et al.</i> (“ <i>Meister</i> ”)

1015	<i>Pending litigation Stipulation (not listed in Declaration)</i>
1016	Nokia N93 User Guide (“Nokia N93”)
1017	Japanese Patent No. 2003110751 to Suga with English Translation and Updated (after ID) Translator’s Affidavit.
2001	Declaration of Safwan Zaheer (“Zaheer”)
2002	Prosecution History of U.S. Application No. 10/552,912, U.S. Patent No. 7,628,333 (’333 Patent)
2003	2025-01-08 Tolling Agreement

Pursuant to 37 C.F.R. § 42.75, Patent Owner DH International Ltd. (“Patent Owner”) submits this Request for Director Review of the Board’s Decision Instituting (“DI”) *inter partes* review of claims 1-20 of U.S. Patent No. 9,022,294 (the “’294 Patent”). Patent Owner respectfully asserts that, in this matter, that (1) the Board failed to apply its policy for discretionary denial and instead, arbitrarily retroactively applied the March 26, 2025, “Interim Process for PTAB Workload Management” (“Interim Process Memo”), by failing to consider discretionary denial, when application of the Interim Process Memo would be impossible; (2) in view of a change in IPR discretionary denial factors, the Board must consider that Apple has delayed filing this IPR while knowing about the ’294 Patent for over eight years; and (3) the Board committed “clear error” when accepting the Japanese-to-English translation when acknowledging it was non-compliant.

I. LEGAL STANDARD FOR DIRECTOR REVIEW

“Requests for Director Review of the Board’s decision whether to institute an AIA trial ... shall be limited to decisions presenting (a) an abuse of discretion or (b) important issues of law or policy.” *See USPTO, Revised Interim Director Review Process* at 2.B, Availability of Director Review: AIA Trial Proceedings (last modified Feb. 5, 2025). 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).

The Director of the USPTO has long claimed broad statutory authority under 35 U.S.C. §§ 314(a) and 324(a) to deny institution of IPR proceedings, even when petitioners meet the threshold showing of unpatentability. The U.S. Supreme Court confirmed this authority in *United States v. Arthrex*, 594 U.S. 1 (2021) (“Congress has committed the decision to institute inter partes review to the Director’s unreviewable discretion.”)

The standard to institute an *inter partes* review is the “likelihood that the petitioner would prevail.” “The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 show that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Petitioner has the burden of proving unpatentability by a preponderance of the evidence in an IPR.

II. Discretionary Denial Arguments must be Considered Because the Interim Process Memo Does Not Apply to the '294 Patent or this IPR Proceeding

Here, the Board’s Interim Process Memo issued *after* the two-month period for requesting discretionary denial had already expired, and therefore, this IPR could not apply the bifurcated procedure. Despite that impossibility, the Board issued paper 7,

“Notice of Referral to Board Panel” finding that “Patent Owner had the opportunity to file a brief requesting discretionary denial of institution” and not considering discretionary denial. *See* Paper 7. The Board’s issuance of paper 7 resulted in an abuse of discretion because Patent Owner never had the opportunity pursuant to the Interim Process Memo to “file a brief requesting discretionary denial of institution.” *Id.*

The Interim Process Memo was issued on March 26, 2025¹. *See* Interim Process Memo. The Interim Process Memo states “within two months of the date on which the PTAB enters a Notice of Filing Date Accorded to a petition, a patent owner may file a brief explaining any applicable bases for discretionary denial of institution.” *Id.* p. 2. The PTAB entered the “Notice of Filing Date Accorded to the Petition” on January 15, 2025. Therefore, the two-month date for filing would have been March 15, 2025, eleven (11) days prior to the issuance of the Interim Process Memo. It was impossible for Patent Owner to comply with the Interim Process Memo that had not yet been issued. Thus, the PTAB abused its discretion by not considering the discretionary denial arguments made in Patent Owner’s POPR and issuing the “Notice of Referral to Board Panel.” Paper.

¹ Available at <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>.

III. Discretionary Denial is Appropriate Based upon the Settled Expectations Doctrine due to Petitioner's Actual and Constructive Knowledge of the '294 Patent

The PTAB recently indicated that the “Settled Expectations Doctrine” is a determinative factor that is important when deciding whether discretionary denial of an IPR is appropriate in view of the Petitioner's delays in filing the Petition. In *Dabico Airport Solutions Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 (June 18, 2025), a patent in force for eight years created settled expectation. Paper 21, p. 2.

A. Petitioner Had Actual Notice of the '294 Patent for at Least Eight Years

Further reinforcing the Settled Expectation Doctrine, in 2020, Apple responded to a third-party subpoena requesting prior art against the '294 Patent in an infringement action Patent Owner brought against Samsung (2:20-cv-00342-JRG Eastern District of Texas Marshall Division). Petitioner chose to take no action on the '294 Patent at that time or at any time thereafter. Instead, on October 18, 2022, Elaine Wong of Apple participated in discussions regarding whether Apple would take a license on a patent portfolio that contained the '294 Patent. Still, Apple took no action to initiate an IPR.

Patent Owner continued its discussions with Petitioner between late 2021 and the service of the district court complaint on December 14, 2023, that failed to produce a settlement. Additionally, between the filing of the complaint and service of the summons, Patent Owner was also in active discussions with RPX Patent Risk Management after being advised that potential settlement may be easier if RPX led

the discussion because settlement negotiations were currently ongoing with multiple parties, including both Apple and Google (*see* IPR2024-01322). Thus, Petitioner had 3 ½ years of actual knowledge of the '294 Patent prior to the filing of the Petition.

Further, during prosecution of Apple's U.S. Patent Application 12/286,313, an examiner cited the publication of the '294 Patent in an Examiner Form 892 "List of references cited by examiner," entered August 18, 2016. The '294 Patent was issued on May 5, 2015, prior to citation by the Examiner of the publication document in Apple's patent application. Thus, Petitioner, at the time of filing this IPR (December 3, 2024), was aware of the '294 Patent since at least August 18, 2016, *i.e.*, 8 years, 3 months, and 15 days prior to the filing of its Petition.

The facts of this case are similar to *iRhythm Tech. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (June 6, 2025) (as in this IPR), where the evidence showed that the petitioner was aware of the Welch Allyn patent during the prosecution of that petitioner's patent application, and the Board relied on that knowledge to discretionarily deny IPR. As in the *iRhythm* case, here Patent Owner's '294 Patent was cited during the prosecution of the Petitioner's patent application over eight years prior to the filing of the Petition.

B. Petitioner had Constructive Notice of the '294 Patent over Nine Years Prior to the Filing of its Petition

There is no requirement that a petitioner have specific notice or knowledge of the patent. However, in *Dabico*, the PTAB granted discretionary denial based on the Settled Expectations Doctrine. In *Dabico*, the Director relied on the constructive notice provided to the public and competitors by the publication of the issued patent by the Patent Office. *Dabico*, Paper 21, p. 3.

The Director, in *Dabico*, denied institution of *inter partes* review based on the patent owner's settled expectations regarding the challenged patent, as the patent had issued nearly eight years earlier. In its Decision, the Director acknowledged "Patent Owner's arguments regarding 35 U.S.C. § 325(d) [were] unpersuasive." *Dabico*, p. 2. Nonetheless, the Director noted that considerations in favor of discretionary denial, particularly "settled expectations," outweighed the counterarguments, stating: "In particular, the challenged patent has been in force almost eight years, creating settled expectations." *Dabico*, p. 2. The Director noted that there is "no bright-line rule on when expectations become settled," but "the longer the patent has been in force, the more settled expectations should be," analogizing the approach to the six-year statute of limitations for infringement damages. *Dabico*, Paper 21, p. 3.

The '294 Patent was in force for 9 years and 7 months prior to the filing of the Petition, creating "settled expectations" for the Patent Owner. As in *Dabico*, the particularly settled expectations outweigh any of Petitioner's counterarguments. Here.

Patent Owner has settled expectations regarding the '294 Patent due to Petitioner's actual notice with multiple interactions with the '294 Patent for over eight years and constructive notice for over nine years. Thus, Petitioner's lengthy actual and constructive notice periods certainly create "settled expectations," and the Director should exercise discretion to deny the institution of this IPR.

C. Settled Expectations Doctrine need not be raised in the Petition or POPR to be relied upon by the Director

In *Dabico*, neither party addressed settled expectations in their briefing, but the Director indicated that "the determination to exercise discretion to deny institution is based on a holistic assessment of all the evidence and arguments presented." *Dabico*, Paper 21, p. 3. In the current IPR, the settled expectation doctrine initially was not raised as a factor for discretionary denial because the Interim Process Memo did not identify it as a factor and the *iRhythm* decision did not issue until after the POPR was filed. However, here, the facts are even stronger than in *iRhythm*. First, notice of the '294 patent by publication is a known fact available to the Patent Office; second, the prosecution of Apple's patent, which identifies the '294 Patent also is a fact available to the Patent Office; third, Apple's actual knowledge of the patent through the third party subpoena from Samsung, as well as the ongoing negotiations between the parties.

The Director may consider the evidence that supports the application of the "settled expectation" doctrine in this IPR because of the recent Director decisions, and the additional facts are available to the Patent Office.

IV. The Board Committed Clear Error in Acknowledging the Suga Translation's Certification is Non-Compliant, But Still Considered the Suga Reference Prior Art

The Board agreed with Patent Owner that the “Japanese-to-English translation certification in Ex. 1005 at page 20 is non-compliant.” ID, FN.6 p. 18. In the POPR, Petitioner stated that:

Trial practice before the Board requires: “When a party relies on a document or is required to produce a document in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation must be filed with the document.” 37 C.F.R. § 42.63. Japanese Patent No. 2003110751 (“Suga”) (Exh. 1005) was filed on October 1, 2001, and published on April 11, 2003, and is in Japanese. The actual English translation document has a date of July 29, 2024 (see Exh. 1005, 20), and Andrew Raia, Project Manager in the translation company, only provide an affidavit attesting “[t]o the best of my knowledge, the aforementioned documents are a true, full and accurate translation of the specified documents.” Exh. 1005, 20. An affidavit attesting to the accuracy of the translation **MUST** be filed with the document. *Mr. Andrew Raia did not attest to his personal knowledge, rather only “to the best of my knowledge.”* Mr. Andrew Raia’s attestation is limited to only the “best of my knowledge” and has no

indication of what that “knowledge” is, that he had any personal knowledge of the actual translation, or that he had even seen the translation. The attestation fails to meet the requirements of 37 C.F.R. § 42.63 and is simply a written document created after the priority date of the ’333 Patent. The English translation should have July 29, 2024, as a priority date and is not a prior art reference. Furthermore, without the attestation for the *Suga* reference, the Board cannot rely on the foreign reference *Suga*. Exh. 2001, ¶39.

POPR, pp. 3-4. The Board agreed, finding “Patent Owner correctly notes the Japanese-to-English translation certification in Ex. 1005 at page 20 is non-compliant.” ID, FN. 6, p. 18. Thus, as a matter of law, the *Suga* Japanese reference cannot be considered prior art, and the Petitioner failed to meet its burden when it filed the Petition relying on a foreign reference with a faulty certification. The translated Japanese *Suga* reference has a July 29, 2024, priority date because the translation certificate fails to comply with 37 C.F.R. § 42.63 and 37 C.F.R. § 1.68.

IPR2025-00172 provides only one ground, and it relies on the combination of *Suga* and *Gorsuch*. Because the Petitioner failed to meet its burden by filing a Petition that relies on a translation (Exh. 1005) of the *Suga* reference, which is a foreign reference that fails to comply with 37 C.F.R. § 42.63 and 37 C.F.R. § 1.68, *Suga* cannot be considered prior art by the Board. However, after recognizing this

flaw *see* ID, FN. 6, p. 18, the Board committed clear error by basing its decision to institute on the faulty *Suga* translation and simply assumed that the Petitioner could file a corrected translation certificate at a later date. The Board cited to non-prior art *Suga* (Exh. 1005) multiple times in the ID and in doing so, improperly relied on the uncertified translation of the *Suga* reference. *See* ID, pp. 18-21, 24-28, 30-32, and 35-36.

To support the Board's erroneous decision to institute based on non-prior art, the Board's ID cites to *Hengdian Group DMEGC Magn. Co. v. Hitachi Metals, Ltd.*, IPR2017-01312, Paper 14, 2 (PTAB Jan. 3, 2018). Paper 14 in the *Hengdian* IPR is a decision granting Petitioner's request to submit updated translator affidavits. The Patent Owner in *Hengdian* did not raise the translation certification issue in the POPR (*see Hengdian* IPR2017-POPR, Paper 6), by contrast, it was raised *sua sponte* by the Board in *Hengdian*'s ID (*see Hengdian* ID, Paper 7, FN.2, p. 6.). Because the issue was not raised by the Patent Owner in *Hengdian*, it was waived, and the Board was free to consider the foreign reference. However, that is not the case in this IPR; the Patent Owner raised the issue of the translation certificate failing to meet 37 C.F.R. § 1.68 in the POPR, and the Board agreed with the Patent Owner. ID, FN.6 p. 18.

Additionally, the issue with the translator's certificate in *Hengdian* involved a translation certificate that was not an "affidavit" and required language "that

willful false statements and the like are punishable by fine or imprisonment or both” as required by 37 C.F.R. § 1.68 was missing. *See Hengdian* ID, Paper 7, FN.2, p. 6. The originally filed certificate, using *Hengdian*’s exhibit 1017 as an example, was a signed, notarized certification that stated the translation was produced in accordance with ISO standards and certified quality management system, and the agent responsible for said translation was qualified. *See Hengdian*, Exh. 1017.

By contrast, here, Mr. Raia’s attestation was limited to only the “best of my knowledge” and does not indicate what that “knowledge” was, if he had *any* personal knowledge of the actual translation, or that he had even seen the translation. Exh. 1005, p. 20. Mr. Raia’s attestation provides no assurances regarding the actual validity of the translation, unlike the translators’ certificate in the *Hengdian* IPR.

The Board agreed with Patent Owner that the Petitioner’s translation certificate failed to comply with 37 C.F.R. § 42.63. *See* ID, FN 6, p. 18. Rules and laws are not optional, and a petition must be complete when filed. *See In re Magnum Oil Tools International, Ltd.*, 829 F.3d 1364, 1375 (Fed. Cir. 2016) (“the PTO has broad authority to establish procedures for revisiting earlier-granted patents in IPRs, that authority is not so broad that it allows the PTO to raise, address, and decide unpatentability theories ... not supported by record evidence.”). The Board committed a clear error in relying on the non-prior art reference of *Suga*. It is the Petitioner’s burden to comply with the patent laws and rules when filing its Petition.

As there is only a single Ground in the '294 IPR and it is based upon *Suga* and one other reference, the '294 IPR must be denied based upon the merits

V. Conclusion

The institution of this IPR must be denied based upon the Director's discretionary denial because of the Settled Expectation Doctrine and based upon the merits because Petitioner's translation of the of the *Suga* reference (Exh. 1005) was defective and was not cured prior to filing the POPR, thus it cannot be considered as prior art.

July 9, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies the service of Patent Owner DH International Ltd. served Patent Owner's Request for Director Review on the counsel of record for Petitioner Apple Inc. in IPR2025-00172 by filing this document through the P-TACTS, as well as delivering a copy via electronic mail to the following:

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Date: July 9, 2025

By: /s/ *Robert Hart*
Robert Hart

CERTIFICATE OF COMPLIANCE

This Petition complies with the type-volume limitations as mandated in 37 C.F.R. § 42.24(a), of 15 pages or less.

Dated: July 9, 2025

By: /s/ *Robert Hart*
Robert Hart