

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MURATA MANUFACTURING CO., LTD,
Petitioner,

v.

GEORGIA TECH RESEARCH CORPORATION,
Patent Owner.

IPR2025-00384
U.S. Patent No. 7,489,914

**PETITIONER'S REQUEST FOR DIRECTOR REVIEW OF
DECISION GRANTING PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL AND DENYING INSTITUTION
OF *INTER PARTES* REVIEW**

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PETITIONER'S EXHIBIT LIST

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EX1002	Prosecution History of U.S. Patent No. 7,489,914
EX1003	Second Declaration of Matthew B. Shoemake under 37 C.F.R. § 1.68
EX1004	<i>Curriculum Vitae</i> of Matthew B Shoemake
EX1005	U.S. Patent No. 6,128,508 (“Francisco”)
EX1006	JP 2001-267466 (“JP466”) including original Japanese language document, English translation, and Translator’s certification
EX1007	European Patent Application EP 1 189 345 A2 (“Okubora”)
EX1008	U.S. Patent Application Publication No. 2002/0118067 (“Hirayama”)
EX1009	U.S. Patent No. 5,995,814 (“Yeh”)
EX1010	Design and Implementation of High-Q Passive Devices for Wireless Applications Using System-On-Package (SOP) Based Organic Technologies, by Sidharth Dalmia, 2003 (“Dalmia”)
EX1011	“Concurrent Multiband Low-Noise Amplifiers—Theory, Design, and Applications,” Hashemi et al., IEEE Transactions On Microwave Theory And Techniques, Vol. 50, No. 1, January 2002 (“Hashemi”)
EX1012	<i>Fundamentals of Microsystems Packaging</i> , Rao Tummala, McGraw-Hill, Table of Contents and Chapter 11, 2001
EX1013	<i>Reserved</i>
EX1014	U.S. Patent No. 6,825,818
EX1015	U.S. Patent No. 5,457,734
EX1016	U.S. Patent No. 5,406,615
EX1017	<i>RF Microelectronics</i> , Behzad Razavi, Prentice Hall PTR, 1998
EX1018	U.S. Patent No. 5,821,820
EX1019	US Patent Application Publication No. 2002/0030545
EX1020	European Patent Application Publication No. EP 0 851 576 A2
EX1021	A CMOS RF Bandpass Low Noise Amplifier for Multi-band Wireless Communication Applications, Mou et al., IEEE, 2002
EX1022	<i>The Wiley Electrical and Electronics Dictionary</i> , Steven M. Kaplan, 2004, pp. 628, 662, 630
EX1023	RF Characterization of a low cost multichip packaging technology for monolithic microwave and millimeter wave integrated circuits, Jayaraj et al., IEEE, 1995
EX1024	JP 2001345648 (“JP648”) including original Japanese language

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	document, English translation, and Translator's certification
EX1025	NIST Technical Note 1520, "Dielectric and Conductor-Loss Characterization and Measurements on Electronic Packaging Materials, 2001
EX1026	US Patent Application Publication No. 2004/0127182
EX1027	Embedded Passives Technology Implementation in RF Applications, Savic, et al., IPC Printed Circuits Expo, 2002
EX1028	US Patent Application Publication No. 2004/0113719
EX1029	US Patent Application Publication No. 2003/0063427
EX1030	<i>Microwave Engineering Second Edition</i> by David M. Pozar, Wiley, 1998
EX1031	Datasheet NE38018, NEC, 2000
EX1032	Characterization of Liquid Crystal Polymer for High Frequency System-in-a-Package Applications, Zou et al., IEEE Transactions On Advanced Packaging, Vol. 25, No. 4, 2002
EX1033	Liquid Crystal Polymers (LCP) for High Performance SOP Applications, 2002 Proceedings. 8th International Advanced Packaging Materials Symposium (Cat. No.02TH8617), Stone Mountain, GA, USA, 2002
EX1034	<i>Microwave Transistor Amplifiers Analysis and Design</i> , Second Edition, Guillermo Gonzalez, Wiley, 1997
EX1035	Complaint NDGA-1-24-cv-05268-1
EX1036	United States District Courts: Federal Court Management Statistics-Comparison within Circuit (September 30, 2024)
EX1037	JPA H06-97315 including original Japanese language document, English translation, and Translator's certification
EX1038	Declaration Dr. Sylvia Hall-Ellis
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EX1040	U.S. Application No. 10/402,313 and applications referred to therein
EX1041	I-24-cv-05268-JPB Docket retrieved 2025-05-14
EX1042	Sotera Stipulation dated May 15, 2025
EX1043	Declaration of Hiroshi Iwatsubo
EX1044	Evaluation report to JMD
EX1045	Mobile Vendor Market Share United States of America, Statscounter Global Stats
EX1046	Motion Success Northern District of Georgia on or after Jan. 1 st

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	2020
EX1047	EP1375112

I. Introduction

The Decision Denying Institution of *Inter Partes* Review (Paper 13, “Decision”) is wrong and should be reversed. As an initial matter, the Decision failed to recognize and correct—despite briefing—the erroneous priority claim asserted by the applicants of the '914 patent that was not substantively examined during prosecution. Instead, the Decision insulated the overbroad claims from review despite uncontested evidence of the erroneous priority claim and the withholding of material information by the inventors during prosecution. This failure constitutes both factual error and an abuse of discretion. The Director should have referred the IPR to a merits panel and allowed the Office to take corrective action to rectify the material error of the erroneous priority claim asserted by the '914 patent.

Instead, the Decision denied on discretion based on the newly announced construct of “settled expectations.” In doing so, the Decision failed to consider the very factors that the Acting Director has identified as countervailing to denial under that new construct.¹ Accordingly, the Decision was an abuse of discretion.

¹ Petitioner does not concede “settled expectations” is an appropriate consideration in determining whether to institute IPR and reserves all rights to challenge the Director’s discretionary denial procedures. Even if “settled expectations” were an appropriate consideration, its application here calls for correction.

Contrary to the Decision, here the material facts related to settled expectations do **not** weigh in favor of discretionary denial; they weigh heavily against it. As Patent Owner **admitted**, it did not commercialize, mark, license, or assert the '914 patent during its entire 16-year term. Rather, it is uncontested that the '914 patent remained dormant from issuance to expiration—"sitting in a drawer" for its entire term. As such, Patent Owner did not—and could not—have developed any settled expectations regarding the validity of, or the scope of exclusive rights afforded by, the '914 patent. The Director has consistently stated a position that the mere age of a patent is not dispositive in its discretionary denial process, yet that very criterion was treated as the sole determinative factor in this proceeding. This constituted an abuse of discretion.

Moreover, it is Petitioner that had strong settled expectations regarding the technology of the '914 patent; the Decision failed to acknowledge the relevant material facts, much less consider and properly weigh them. Petitioner had no reason to be concerned with the '914 patent's invalidity and had no reason to think the '914 patent would be enforced against it. Petitioner's meeting and communication with inventors of the '914 patent—**prior to** the '914 patent grant—demonstrated that the inventors' purported technology **did not work**. The '914 patent issued after these discussions and only after detailed communication of the inventors' technology failures, which were made of record but the Decision failed to acknowledge, much

less consider and properly weigh. And through the subsequent full 16-year term of the '914 patent, Patent Owner never followed up with Petitioner, never addressed the identified failures of its technology, and never indicated any applicability of its patents to Petitioner. Patent Owner's failure to address the demonstrated failures of its purported technology, coupled with its inaction throughout the entire term of the '914 patent, further substantiated and reinforced Petitioner's settled expectations regarding the '914 patent. The Decision's failure to even consider Petitioner's settled expectations as detailed by Petitioner's Opposition to Discretionary Denial (Paper 11) ("Opp.") was an erroneous negation of material facts and an abuse of discretion.

Also, the Decision was an abuse of discretion for failing to acknowledge and properly weigh other important factors like the compelling—and indeed unopposed—merits of the Petition, efficient allocation of PTAB resources to the merits issues given the overwhelming strength of the Petition, the strength of *all Fintiv* factors, and Petitioner's *Sotera* stipulation. It was also an abuse of discretion and a violation of the IPR statute that the Decision failed to comply with the requirements of 35 U.S.C § 314(c). Further, the Discretionary Denial violates at least the Due Process clause and the Administrative Procedure Act (APA) because it was based on retroactive and improperly issued guidance.

For each of these reasons, the denial should be vacated, and the Petition should be referred to a merits panel for institution of trial and consideration of the

compelling merits of the Petition's unpatentability grounds.

II. The Decision Failed to Recognize and Failed to Correct the '914 Patent's Erroneous Priority Claim.

The Decision failed to acknowledge, much less consider the '914 Patent's erroneous priority claim despite uncontested evidence. The priority error is highly material and particularly egregious here, as the applicant's own art evaded review based on the Office's failure to test priority and applicant's failure to disclose. By taking no action, the Decision effectively acquiesces to the '914 patent's erroneous priority assertion, which constitutes both an erroneous finding of material fact and an abuse of discretion, and compounds the material error introduced in prosecution.

Specifically, the '914 patent claims priority as a continuation-in-part (CIP) to U.S. Patent No. 6,900,708 ("the '708 patent"). It is uncontested that there is no priority supporting disclosure within the '708 patent for an "active device" expressly required by the claims of the '914 patent. *See* IPR2025-00384, Paper 2, 15-18 (demonstrating that claims of the '914 patent lack written description support in the parent application); IPR2025-00384, Paper 9 (waiving preliminary response). The Decision's inaction preserved the factually incorrect priority claim of the '914 patent. This is a clear factual error.

Furthermore, equities demand that the Office allow the merits process to address the erroneous priority claim of the '914 patent, obtained through the Patent Owner's failure to make proper disclosures during prosecution. Opp. 32. During the

Office's original examination leading to the '914 patent, the inventors did not inform the Office that its continuation-in-part priority claim did not support its actual claims requiring an active device. Opp. 32. Further, they failed to disclose their own relevant published documents, which were prior art under the correct priority date. Opp. 32. Thus, the Decision's inaction to address the materially erroneous priority claim, in the face of uncontested evidence and withholding of material information by the inventors during prosecution, is an abuse of discretion.

III. The Decision's Finding on "Settled Expectations" is Factually Incorrect and an Abuse of Discretion.

A. The Decision failed to properly weigh Patent Owner's admission of non-enforcement of 16 years.

The Decision failed to properly weigh Patent Owner's admission of non-enforcement for 16 years. That failure was an abuse of discretion. Patent Owner affirmatively asserted that it had never commercialized the '914 patent or marked any product with '914 patent. Opp. 19–20; EX1035, 18, 23. The Decision acknowledged that Patent Owner admitted it had never commercialized the challenged patent or marked any product with it. Decision, 2 (citing Opp. 19–20 (citing EX1035, 18, 23)). However, the Decision failed to properly weigh Patent Owner's admission of non-enforcement for 16 years. Instead, the Decision's "strong settled expectations for Patent Owner" was based *solely* on how long the challenged patent had been in force. Decision, 2.

The Decision's failure to properly weigh Patent Owner's admission of non-enforcement for 16 years was an abuse of discretion. Indeed, it contradicts the Director's other decisions and public statements. For example, the Director has noted that years of non-enforcement, as in this proceeding, weigh against a patent owner's claim to "settled expectations" of enforceability. *Intel Corp. v. Proxense LLC*, IPR2025-00327-329, P. 12, 2-3 (Stewart June 26, 2025) ("[t]here may be persuasive reasons why the Board should review challenged claims several years after their issuance date," including when "a patent may have been in force for years but may not have been commercialized, asserted, marked, [or] licensed."); *Shenzhen TuoZhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, -531-532, -585, -611, P. 10, 3 (Stewart July 17, 2025) (referring petitions based in part on evidence that the challenged patents, which had been in force for approximately 10 years, had "never been commercialized, asserted, marked, licensed, or otherwise applied" in petitioner's "technology space"—a factor that weighed against patent owner's claim of settled expectations). The Director has publicly stated that the mere age of a patent is not dispositive. *See* USPTO's Stewart Suggests Org. Is Eyeing Patent Fee Changes, Law360 (August 6, 2025), 1 ("Stewart said that her and her advisers' approach to the discretionary denial process is holistic...a patent that's been '**sitting in a drawer**' for 15 years does **not** necessarily have settled expectations protecting it, she said."); EX3100(Director denying Petitioner's request for authorization to add

as evidence). However, that very criterion was applied by the Decision as the sole determinative factor in this proceeding. Thus, the Decision failed to properly weigh Patent Owner's admissions of non-enforcement, which was an abuse of discretion.

B. The Decision failed to acknowledge—let alone consider and properly weigh—facts of Petitioner's settled expectations.

1. The Decision's finding on discussions in 2007 between Patent Owner and Petitioner was factually erroneous.

The Decision asserted, "Petitioner and Patent Owner had discussions in 2007 regarding the technology space involving the challenged patent." Decision, 2 (citing Opp. 21–26). This is incorrect. As explained in the Opposition Brief, a named inventor of the '914 patent, representing *another* entity (JMD), declared that he presented a slide deck to Petitioner in April 2007. *See* PO Brief, 7; EX2001, 4. However, the meeting had no discussion regarding a then-pending application that is now identified by Patent Owner as leading to the '914 patent. Opp. 22-23; *see also* EX1043, ¶5. In fact, the 2007 meeting was part of the 2006-2008 communications that demonstrated that the inventors' purported technology *did not work*. Opp. 21-26. The Decision overlooked the factual context of the 2007 meeting and communications, incorrectly identifying Patent Owner, GTRC, as a party to the communications. It further disregarded the inventors' technology failures and the fact that the Patent Owner thereafter kept its later-issued patent "sitting in a drawer" for its entire life.

2. **The Decision failed to acknowledge—let alone consider and properly weigh—Petitioner's settled expectations.**

As discussed at III.B.1, the 2006-2008 communications demonstrated that the inventors' purported technology *did not work*. Opp. 21-26. Following those communications and through the issuance and full 16-year term of the '914 patent, Patent Owner never followed up or suggested any ability to address those failures or any applicability of its purported technology to Petitioner. Patent Owner's failure to address those demonstrated technology failures, together with its inaction throughout the entire term of the '914 patent, further substantiated and reinforced Petitioner's settled expectations.

As detailed in the Opposition Brief, Petitioner developed a settled expectation that a patent related to a failed technology, including the later-issued '914 patent, would not be commercialized or asserted. Petitioner's expectation arose from the discussions with the inventors (in the context of their JMD entity) and the failure of the technology. And Petitioner's expectations were confirmed by the subsequent inaction by the '914 patent inventors, their JMD entity, and Patent Owner. Opp. 21-26. Specifically, the '914 patent—at any time from issuance to expiration—had never been commercialized, asserted, marked, or commercially licensed. Patent Owner's inaction and the '914 patent's lack of use reinforced Petitioner's very reasonable and settled expectation that the '914 patent would ***not*** be asserted.

The Decision's failure to acknowledge—let alone consider and properly

weigh—these settled expectations detailed by Petitioner (expectations that the Director has faulted other petitioners for failing to articulate) was an abuse of discretion. *See Dabico Airport Solutions Inc. v. AXA Power APS*, IPR2025-00408, Paper 24 (P.T.A.B. August 21, 2025) (Director faulting Petitioner for failing to “make its own arguments about settled expectations”); Director Memo March 2025 (“the parties are permitted to address all relevant considerations [including] [s]ettled expectations of *the parties*”).

Further, even assuming *arguendo* that the Director concluded the Patent Owner developed settled expectations based on the age of the '914 patent, this must be weighed against Petitioner's own settled expectations. Given Petitioner's strong settled expectations—developed prior to the grant of the '914 patent and further reinforced by Patent Owner's inaction for 16 years, this factor heavily favors the Petitioner, or at most, devolves into a net zero factor favoring neither party. The remaining factors, including the *Fintiv* factors and the strong merits, overwhelmingly favor referral to a merits panel.

However, here, the Director created an irrebuttable presumption of Patent Owner's settled expectation, despite facts demonstrating that Patent Owner abandoned all interests under the '914 patent. The dormant 16 years—the patent's entire term, no less—of no commercialization, licensing, or marking, do not establish Patent Owner's settled expectations. Rather, the dormant 16 years establish

and reinforce Petitioner's own settled expectations regarding the '914 patent and its invalidity, unenforceability, and commercial irrelevance that arose from the 2007 (pre-grant) communications. The Director's creation of, and reliance on, such an irrebuttable presumption was abuse of discretion. Moreover, the application of such here—on this detailed record—belies the Director's own statements that Petitioner's settled expectations matter, raising issues of arbitrary and capricious decisioning.

IV. The Decision Failed to Acknowledge and Properly Weigh Other Important Factors, further demonstrating Abuse of Discretion.

A. The Petition presents strong merits.

The Decision whether to institute *inter partes* review is governed by 35 U.S.C. § 314(a), which requires the Director to consider whether “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Yet, the Decision failed to address the strength of the merits of the Petition or properly weigh it against other factors. That failure was an abuse of discretion, as evidenced by other proceedings in which the Director has weighed similar evidence that a petition presented strong evidence of unpatentability and found that it weighed against discretionary denial.

The Petition presents strong merits. It plainly shows that the '914 patent claims no more than well-known subject matter. In fact, the merits of the Petition are so strong that Patent Owner offers *no* response. Opp. 13-15; *see* IPR2025-00383, Paper 10 (waiving preliminary response); IPR2025-00384, Paper 9 (waiving

preliminary response). Accordingly, the Decision's failure to properly weigh the strength of the Petition and refer this Petition to the merits panel is wrong.

B. Fintiv factors overwhelmingly favor institution.

The Decision failed to address the strength of the *Fintiv* factors or properly weigh it against other factors, which was an abuse of discretion. Here, the *Fintiv* factors overwhelmingly favor institution. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential). Petitioner diligently filed the Petition **three (3) months** after Patent Owner filed its complaint in NDGA. No scheduling order has been issued, and based on the median time-to-trial for NDGA, the FWD can be expected **over a year before** any district court trial. Opp. 1. Further, Petitioner filed a “*Sotera*” stipulation on May 15, 2025, and explained that given the technical nature of the technology at issue and given the skill of the PTAB to address the complex technology, the efficiency and integrity of the patent system is best served by the PTAB reviewing the unpatentability/obviousness questions already before it. Opp. 11-12; EX1042. Even the Decision acknowledged that “there is currently no concern of inconsistent outcomes and duplication of efforts resulting from two proceedings operating in parallel.” Decision, 2.

However, the Decision failed to acknowledge the *Fintiv* factors in their entirety or properly weigh the overwhelming strength of those factors against others. Accordingly, the Decision's failure to properly weigh the *Fintiv* factors and refer

this Petition to the merits panel is improper and should be reversed.

V. The Decision's Failure to Provide a Written Decision as Required by 314(c) was an Abuse of Discretion.

An IPR may not be instituted “unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows 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). Section 314(c) further requires that “[t]he Director shall notify the petitioner and patent owner, in writing, of the Director’s determination under subsection (a).”—*i.e.*, of the determination of that merits question. “[S]hall” means that the requirement set out in §314(c) is mandatory and cannot be ignored by discretion. *See U.S. ex rel. Siegel v. Thoman*, 156 U.S. 353, 360 (1895) (explaining “shall” is a “command”). Here, the Decision fails to comply with the Director’s statutory obligation and thus deprives a reviewing court of a decisional record necessary to evaluate whether “the factors considered in the exercise of discretion are part of a balanced assessment of all the relevant circumstances in the case, including the strength of the merits.” *See* Guidance on USPTO's rescission of "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation" (Boalick Memo, March 24, 2025).

VI. The Decision Violates at Least the Due Process Clause and the APA.

The Decision violates the Due Process Clause of the Fifth Amendment and

the APA by retroactively applying new rules, issued without notice and comment, that did not exist at the time Petitioner filed its petition.

A. The Decision failed to properly credit Petitioner's *Sotera* stipulation.

At the time Petitioner filed the IPR, the rule was the Board “will not discretionarily deny institution in view of parallel district court litigation” where a petitioner files a *Sotera* stipulation. See Director Vidal's June 21, 2022 Memorandum (“Vidal Memo”), 3 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (Dec. 1, 2020) (precedential as to §II.A)). The Vidal Memo states that it was “issued under the Director's authority to issue ***binding agency guidance*** to govern the PTAB's implementation of various statutory provisions.” Vidal Memo, 3 (citing 35 U.S.C. 3(a)(2)(A)). In reliance on this, Petitioner filed this IPR and presented a *Sotera* stipulation (EX1042), which the Vidal Memo says would dispositively prevent the PTAB from discretionarily denying institution in view of parallel district court litigation. Vidal Memo, 3, 7, 9. The Vidal Memo was then rescinded without notice or explanation. It is a violation of due process and the APA for the Director to retroactively apply the rescission of the Vidal Memo's “binding” guidance to this already-filed Petition. The Decision's failure to credit Petitioner's *Sotera* stipulation and refer to the merits panel is improper and should be reversed.

B. The Patent Office's changes to the criteria for institution did not

satisfy the requisite statutory and constitutional obligations for prescribing new regulations.

The Director should apply only the June 2022 Memo in effect when this petition was filed, not the February/March 2025 guidance. 35 U.S.C. § 316(a) mandates that “[t]he **Director shall prescribe regulations**” including regulations “(2) setting forth the standards for the showing of sufficient grounds to institute a review under section 314(a).” The February 2025 rescission of the June 2022 Memo—and the subsequent March 2025 memorandum (identifying considerations including “settled expectation of the parties”)—and the various *ad hoc* decisions and guidance issued since then—did not satisfy the requisite statutory and constitutional obligations for new regulations and the rulemaking procedures of the APA.

As an example, the new rules introduced by the February 2025 rescission and the subsequent March 2025 memorandum affect “the substantive ... standards by which [the USPTO] examines a party’s application,” and as such could only properly issue through notice and comment rulemaking. *In re Chestek PLLC*, 92 F.4th 1105, 1109 (Fed. Cir. 2024). These new rules did not go through notice-and-comment rulemaking, and therefore violated the APA and the requirement to issue “regulations” regarding institution standards. § 316(a)(2).

As another example, applying a new “settled expectations” bar to institution announced after the IPR petition was filed (and through *ad hoc* decision making) is contrary to statute and impermissibly retroactive. This new consideration lacks any

basis in Federal Circuit or PTAB case law, and shown by the decision in this case, it continues to remain unclear how the Director will apply this new factor in a given case. But even if the Director had a statutory basis to consider “settled expectations,” bedrock principles preclude agencies from applying a new rule retroactively to unduly intrude upon reasonable reliance interests. “The Due Process Clause limits the extent to which the Government may retroactively alter the legal consequences of an entity’s or person’s past conduct.” *PHH Corp. v. CFPB*, 839 F.3d 1, 46-47 (D.C. Cir. 2016), order vacated (Feb. 16, 2017), reinstated in relevant part, 881 F.3d 75, 83 (D.C. Cir. 2018). Further, an agency must “provide a reasoned explanation for the change, display awareness that they are changing position, and consider serious reliance interests.” *FDA v. Wages & White Lion Invs., L.L.C.*, 145 S. Ct. 898, 917 (2025) (citation and alterations omitted). Instead of instituting based on the “compelling merits” of the petition (as in the June 2022 guidance), the new rules changed existing policy without considering the serious reliance interests thereby affected and without providing a reasoned explanation for the change. Under the change-in-position doctrine, the new rules are in violation of the APA. *See Dep’t of Homeland Sec. v. Regents of Univ. of Cal.*, 591 U.S. 1, 30 (2020).

VII. Conclusion

Petitioner respectfully requests the Director withdraw and vacate the Decision and refer the Petition to a merits panel for consideration.

Respectfully submitted,

Date: August 28, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. §42.6(e) and 37 C.F.R. §42.105, service was made on Patent Owner as detailed below.

Date of service August 28, 2025

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