

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

**SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,**

Petitioners,

v.

ICASHE, INC.,

Patent Owner.

Case IPR2025-00644
Patent No. 9,208,423

**PETITIONERS' REQUEST FOR DIRECTOR REHEARING AND/OR
REVIEW**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	BACKGROUND	2
III.	LEGAL STANDARD	5
IV.	ARGUMENT	5
A.	The Recission of the Vidal Memo Violates the Administrative Procedure Act	7
B.	The USPTO’s New Guidance Violates the Administrative Procedure Act and Violates Samsung’s Due Process Rights.....	9
C.	The Decision Failed to Follow the USPTO’s Current Guidance.....	11
D.	The Decision’s Reliance on “Settled Expectations” Is Factually Unfounded and an Abuse of Discretion	12
V.	CONCLUSION.....	15

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>United States ex rel. Accardi v. Shaughnessy</i> , 347 U.S. 260 (1954).....	11
<i>Apple Inc. v. Gesture Tech. Partners, LLC</i> , 127 F.4th 364 (Fed. Cir. 2025)	14
<i>In re Chestek PLLC</i> , 92 F.4th 1105 (Fed. Cir. 2024)	7
<i>Chrysler Corp. v. Brown</i> , 441 U.S. 281 (1979).....	7
<i>Coal. for Common Sense in Gov’t Procurement v. Sec’y of Veterans Affs.</i> , 464 F.3d 1306 (Fed. Cir. 2006)	7
<i>Encino Motorcars, LLC v. Navarro</i> , 579 U.S. 211 (2016).....	8
<i>FDA v. Wages & White Lion Invs., L.L.C.</i> , 145 S. Ct. 898 (2025).....	8
<i>Intel Corp. v. Proxense LLC</i> , IPR2025-00327, Paper 12 (PTAB June 26, 2025)	12
<i>Landgraf v. USI Film Prods.</i> , 511 U.S. 244 (1994).....	10
<i>Martin v. Franklin Cap. Corp.</i> , 546 U.S. 132 (2005).....	14
<i>Mexichem Fluor, Inc. v. EPA</i> , 866 F.3d 451 (D.C. Cir. 2017).....	10
<i>SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC</i> , 580 U.S. 328 (2017).....	14

<i>Serv. v. Dulles</i> , 354 U.S. 363 (1957).....	11
<i>Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.</i> , IPR2025-00438, Paper 10 (PTAB July 17, 2025)	13
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020)	<i>passim</i>
<i>Tafas v. Dudas</i> , 511 F. Supp. 2d 652 (E.D. Va. 2007)	10
<i>Tesla, Inc. v. Intell. Ventures II LLC</i> , IPR2025-00217, Paper 9 (PTAB June 13, 2025)	13
<i>Tesla, Inc. v. Navy</i> , IPR2025-00341, Paper 12 (PTAB June 13, 2025)	13
<i>Vitarelli v. Seaton</i> , 359 U.S. 535 (1959).....	11
Statutes	
5 U.S.C. § 553(b)	7
35 U.S.C. § 2(b)(2).....	10
35 U.S.C. § 311(c)	14
35 U.S.C. § 315(b)	14
35 U.S.C. § 316(a)	10
Other Authorities	
37 CFR § 42.75	5

EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001*	U.S. Patent No. 9,208,423 (“’423”)
1002*	File History of U.S. Application No. 14/833,113 (“’423FH”)
1003*	Declaration of Henry Dreifus in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent. No. 9,208,423 (“Dreifus”)
1004	U.S. Patent App. Pub. 2011/0240748 (“Doughty-CON”)
1005	U.S. Patent App. Pub. 2004/0133787 (“Doughty”)
1006	U.S. Patent No. 11,270,174 (“’174”)
1007	File History of U.S. Application No. 17/021,347 (“’174FH”)
1008	Redline Between Doughty and Doughty-CON
1009	U.S. Patent No. 5,943,624 (“Fox”)
1010	U.S. Patent No. 7,917,444 (“Bursch”)
1011-1027	<i>Reserved</i>
1028	U.S. Patent App. Pub. 2006/0017626 (“Kannan”)
1029	U.S. Patent No. 6,400,965 (“Phillips”)
1030	U.S. Patent No. 4,877,947 (“Mori”)
1031	U.S. Patent App. Pub. 20040235450 (“Rosenberg”)
1032	U.S. Patent No. 5,466,919 (“Hovakimian”)
1033-1036	<i>Reserved</i>
1037	U.S. Patent No. 5,955,961 (“Wallerstein”)
1038-1049	<i>Reserved</i>

Exhibit No.	DESCRIPTION
1050	Docket Control Order, <i>iCashe, Inc. v. Samsung Electronics Co.</i> , No. 2:24-cv-00429-JRG (E.D. Tex.)
1051	Docket Control Order, <i>Valtrus Innovations Ltd. v. NTT Data Services, LLC</i> , No. 2:24-cv-00361, (E.D. Tex.)
1052	Docket Control Order, <i>Fleet Connect Solutions LLC v. The Kroger Co.</i> , No. 2:24-cv-00430 (E.D. Tex.)
1053	Docket Control Order, <i>C47 Technologies LLC v. TCL Technology Group Corporation f/k/a TCL Corporation</i> , No. 2:24-cv-00417 (E.D. Tex.)
1054	Docket Control Order, <i>SiOnyx, LLC v. Samsung Electronics, Co., Ltd.</i> , No. 2:24-cv-00408 (E.D. Tex.)
1055	Docket Control Order, <i>Stingray IP Solutions LLC v. Allegion Public Limited Company</i> , No. 2:24-cv-00396 (E.D. Tex.)
1056	Docket Control Order, <i>ElectraLED, Inc. v. Astera LED Technology GmbH</i> , No. 2:24-cv-00512 (E.D. Tex.)
1057	Docket Control Order, <i>Alto Dynamics, LLC v. Fresha.com SV Ltd.</i> , 2:24-cv-00468 (E.D. Tex.)
1058	Docket Control Order, <i>Cloud Byte LLC v. Dell Inc.</i> , No. 2:24-cv-00637 (E.D. Tex.)
1059	September 20, 2024 Production Letter in <i>iCashe, Inc. v. Samsung Electronics Co.</i> , No. 2:24-cv-00429-JRG (E.D. Tex.)
1060	December 12, 2024 Production Letter in <i>iCashe, Inc. v. Samsung Electronics Co.</i> , No. 2:24-cv-00429-JRG (E.D. Tex.)
1061	Declaration of Cheryl Sloane in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,208,423
1062*	Petitioners' Offered Stipulation
1063	Complaint, <i>iCashe, Inc. v. Samsung Electronics Co.</i> , No. 2:24-cv-00429-JRG, Dkt, 1 (E.D. Tex.)
1064	Samsung Mobile Payment Service – Samsung Pay, Available Starting Today in the U.S., Samsung Press Release (September 28, 2015) (https://news.samsung.com/global/samsung-mobile-payment-service-samsung-pay-available-starting-today-in-the-u-s)
1065	Samsung Announces Launch Dates for Groundbreaking Mobile Payment Service: Samsung Pay, Samsung Press Release (August 14, 2015) (https://news.samsung.com/global/samsung-announces-

Exhibit No.	DESCRIPTION
	launch-dates-for-groundbreaking-mobile-payment-service-samsung-pay)
1066	<i>Multimedia Techs. PTE Ltd. v. LG Elecs. Inc.</i> , et al., 2:22-cv-00494-JRG-RSP, Dkt. 273 (E.D. Tex. Mar. 18, 2025)
1067	Judge Rodney Gilstrap (E.D. Tex.) Case Calendar for April 6, 2026 as of July 12, 2025
1068	Order Denying Without Prejudice to Refile Motion to Stay Pending IPRs, <i>iCashe, Inc. v. Samsung Electronics Co.</i> , No. 2:24-cv-00429-JRG, Dkt. 38 (E.D. Tex.)
1069	Petition, <i>Cisco Sys., Inc. v. Lionra Techs. Ltd.</i> , IPR2024-01281, Pap. 2
1070	File History of U.S. Patent No. 11,694,053
1071	Comparison of U.S. Patent Application No. 13/038,341 to U.S. Patent Application No. 12/188,346
Petitioners have used the same exhibit number to refer to the same document across IPR2025-00642, -00643, -00644, and -00645, except for those exhibits designated by an *, which indicates that the exhibit is unique to each IPR proceeding.	

I. INTRODUCTION

Petitioners respectfully request that the Director reconsider the Decision Denying Institution (Pap. 11, “Decision”) granting discretionary denial.

Director rehearing and/or review is necessary to consider the effect of the improper rescission of the USPTO’s binding guidance that provided that a *Sotera* stipulation offered protection from discretionary denial under §314(a) due to a co-pending district court litigation. Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (“Vidal Memo”)¹. Similarly, Director review is necessary to consider the effect of the USPTO’s improper promulgation of new guidance in the “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (“Boalick Memo”)² and in the “Interim Processes for PTAB Workload Management” Memo (“Stewart Memo”)³, both of which announced new substantive

¹https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf

²https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_rescission_20250324.pdf

³<https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt->

and retroactive rules that were applied to Samsung here.

Additionally, even if the USPTO's changes to its rules were proper, rehearing/review is necessary because the Decision failed to follow the currently binding guidance that continues to require consideration of a timely *Sotera* stipulation. See Boalick Memo (“[A] timely-filed *Sotera* stipulation ... is highly relevant, but will not be dispositive by itself. Instead, the Board will consider such a stipulation as part of its holistic analysis under *Fintiv*.”).

Finally, reconsideration is also warranted because settled expectations weigh against discretionary denial—not for it. This Decision reflects inconsistency with prior Board proceedings in similar cases that found no settled expectations, and Director Review should correct these inconsistent results.

For the foregoing reasons, the Decision should be reversed to ensure the Director's guidance is being properly and consistently applied.

II. BACKGROUND

Patent Owner iCashe, Inc. (“iCashe”) brought suit in the Eastern District of Texas against Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively “Samsung”), accusing Samsung of infringing seven of iCashe's patents

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on June 6, 2024. *See iCashe, Inc. v. Samsung Electronics Co., Ltd.*, No. 2:24-cv-00429-JRG-RSP (E.D. Tex.). In response, Samsung began searching for prior art and prepared and filed its Petitions in IPR2024-00639 to IPR2024-00645 by March 10-11, 2025. *See* Pap. 2. Samsung’s Petitions were filed shortly after the USPTO rescinded the “binding” discretionary denial regime guided by Director Vidal’s so-called “Vidal Memo” on February 28, 2025. *See* Recission Announcement.⁴ The recission of the Vidal Memo did not go through notice and comment rulemaking, nor did it provide detail about what the new procedure for discretionary denial would be, but it did continue to refer to *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) as providing “precedent for guidance.” *Id.*

Shortly after Samsung filed its petitions, on March 24, 2025, Chief Administrative Patent Judge Boalick issued the “Boalick Memo,” which continued to maintain that “a timely-filed *Sotera* stipulation” is “highly relevant,” and should be considered by the Board. *See* Boalick Memo. Two days after the Boalick Memo, Director Stewart issued the “Stewart Memo” announcing a new discretionary denial procedure and new factors to be considered for discretionary denial. Despite issuing after Samsung’s filings, both the Boalick Memo and the Stewart Memo were applied

⁴<https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures>

to Samsung's petitions.

Samsung's petitions included a standard *Sotera* stipulation in which Samsung stipulated that, upon institution, Samsung would not pursue the grounds of invalidity asserted in the IPR or any other ground that was raised or could reasonably have been raised in an IPR with respect to the challenged claims. See Pap. 2 at 21. On May 16, 2025, a month prior to iCashe's discretionary denial briefing, Samsung went a step further and stipulated that upon institution it would not pursue in district court **any** combination of the prior art asserted in the IPR proceedings with any other type of prior art, including unpublished system prior art. Pap. 6, Ex. 1062.

On August 14, 2025, because Acting Director Stewart is recused from this matter, the Acting Director delegated her authority to Acting Deputy Chief Administrative Patent Judge Deshpande, and Judge Deshpande issued a Decision discretionarily denying institution. See Pap. 11. In particular, Judge Deshpande found that it was unlikely that a final written decision would issue before the district court trial occurred. *Id.*, 2. Judge Deshpande further found that settled expectations weighed in favor of denying institution based on the age of the asserted patents (five of which have been in force for six years or longer and two of which have been in force for only a few years). The Decision did not refer to Samsung's *Sotera* stipulation. *Id.* Samsung now seeks Director rehearing and/or review.

III. LEGAL STANDARD

Pursuant to 37 CFR § 42.75 and the USPTO’s guidance on Director Review, a party may request review of “any decision on institution under 35 U.S.C. § [314].” *See* 37 CFR § 42.75; Guidance on Director Review Process⁵. Review of a decision on institution under § 314 is proper for “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.” *Id.* Review of “discretionary ... issues” is specifically allowed. *See* Guidance on Director Review Process at 2B.

IV. ARGUMENT

Director rehearing and/or review is warranted⁶ because one of the primary bases for discretionary denial was alleged overlap with the district court litigation and the timing of trial, but Samsung’s *Sotera* stipulations ensure that there would be no overlap between the district court litigation and *inter partes* review. Indeed, under

⁵<https://www.uspto.gov/patents/ptab/decisions/director-review-process>

⁶ While the Acting Director is recused from this matter and delegated her authority to Judge Desphande (Pap. 11, at 1 n.1 (citing <https://www.uspto.gov/sites/default/files/documents/deshpande-delegationletter.pdf>)), a new Director may be confirmed. Samsung requests Director rehearing and/or review as appropriate.

the previously “binding” Vidal Memo, Samsung was entitled to file *Sotera* stipulations after which the Board should not have considered the district court litigation. The USPTO’s decision to rescind the Vidal Memo without utilizing notice and comment rulemaking violates the Administrative Procedure Act.

Further, Director Review is required to consider the effect of the USPTO’s new Boalick and Stewart Memos, neither of which went through notice-and-comment rulemaking, and both of which were retroactively applied to Samsung. Regardless, even under the current guidance provided by the Boalick Memo, consideration of Samsung’s *Sotera* stipulations was still required, but the Decision does not mention Samsung’s *Sotera* stipulations.

Director review is also warranted to reconsider settled expectations which do not favor discretionary denial in this matter. Five of the seven patents asserted against Samsung (including the patent challenged here) issued between 2013 and 2016 with the remaining two issuing in 2022 and 2023, respectively. However, iCashe waited until 2024 to assert any of these patents, creating settled expectations that the patents **would not** be enforced against Samsung or anyone else.

Rehearing/review of the Decision to discretionarily deny institution is necessary to consider the proper impact of the Vidal, Boalick, and Stewart Memos and to reconsider the settled expectations of the parties.

A. The Recission of the Vidal Memo Violates the Administrative Procedure Act

With respect to the Administrative Procedure Act, the recission of the Vidal Memo is in violation because it did not go through notice-and-comment rulemaking. Under the APA, all rules require notice-and-comment rulemaking except for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice.” 5 U.S.C. § 553(b). The recission of the Vidal Memo was a substantive rule that required notice-and-comment rulemaking because it “effect[ed] a change in existing law or policy or ... affected individual rights and obligations.” *Coal. for Common Sense in Gov’t Procurement v. Sec’y of Veterans Affs.*, 464 F.3d 1306, 1317 (Fed. Cir. 2006); *see also In re Chestek PLLC*, 92 F.4th 1105, 1109 (Fed. Cir. 2024). Specifically, the Vidal Memo—which was enacted after the USPTO received and considered “822 comments from a wide range of stakeholders” (*see* Vidal Memo)—created a “binding” policy that a *Sotera* stipulation could protect petitioners from discretionary denials based on parallel litigation. The recission of the Vidal Memo overturned that binding policy without any notice or comment period or any explanation at all. As such, the recission of the Vidal Memo affects the individual rights and obligations of petitioners, like Samsung. *See Chrysler Corp. v. Brown*, 441 U.S. 281, 302 (1979) (holding that “affecting individual rights and obligations ... is an important touchstone for distinguishing” substantive rules that require notice-and-comment rulemaking). Because the recission of the Vidal Memo

did not go through notice-and-comment rulemaking, it violates the APA.

The rescission of the Vidal Memo also violates the APA under the change-in-position doctrine because the USPTO previously promised that it would not deny petitions on *Fintiv* grounds if accompanied by a *Sotera* stipulation, but it then “turned around and did something different” in the rescission of the Vidal Memo and subsequent application of the Boalick Memo. *See FDA v. Wages & White Lion Invs., L.L.C.*, 145 S. Ct. 898, 917 (2025). The change-in-position doctrine prevents an agency from changing its policies without “provid[ing] a reasoned explanation for the change, display[ing] awareness that [it is] changing position, and consider[ing] serious reliance interests.” *Id.* (cleaned up). An agency violates the change-in-position doctrine when it (1) changes existing policy without (2) displaying awareness and offering “good reasons” for the policy change. *Id.* at 918. In explaining its change, the agency must be cognizant of “serious reliance interests” in its prior policy. *Encino Motorcars, LLC v. Navarro*, 579 U.S. 211, 221-22 (2016) (quoting *FCC v. Fox Television Stations, Inc.*, 556 U.S. 502, 515 (2009)). Here, despite the clear policy change in rescinding the Vidal Memo, the USPTO has failed to offer any explanation at all for its change beyond merely announcing its effect. Because there has been no reasoned explanation for the change, the rescission of the Vidal Memo (and subsequent promulgation of the Boalick Memo) is in violation of the change-in-position doctrine and thus the APA.

Because the rescission of the Vidal Memo violates the APA, Director rehearing/review is required, and institution should be granted.

B. The USPTO's New Guidance Violates the Administrative Procedure Act and Violates Samsung's Due Process Rights

After Samsung filed its IPR petitions, the USPTO improperly promulgated new guidance which it then retroactively applied to Samsung. These actions violate both the Administrative Procedure Act and the Due Process clause of the United States Constitution.

Samsung began investing money and resources in preparing its IPR petitions well ahead of the USPTO's rescission of the Vidal Memo. In doing so, Samsung understood that there was co-pending district court litigation involving the same patents, but reasonably relied on the Vidal Memo's guidance that this co-pending litigation would not prevent institution. However, without warning, on February 28, 2025, the USPTO withdrew the Vidal Memo in a three-sentence announcement without providing for an alternate procedure, and while continuing to cite the PTAB's decision in *Sotera* as providing guidance. See Rescission Announcement. After the rescission, Samsung filed its petitions on March 10-11, 2023 and paid the required filing fees, and it was only after that date that the USPTO announced new procedures through the Boalick and Stewart Memos. Specifically, the Boalick Memo announced that a timely-filed *Sotera* stipulation (which Samsung had already provided) would no longer be "dispositive" and the Stewart Memo introduced a new

procedure for considering discretionary denial and a host of new discretionary factors, including the “settled expectations” factor that the Board relied on here. See Boalick Memo; Stewart Memo. These memos were then retroactively applied to proceedings that had already been filed at the USPTO, including Samsung’s petitions here. See *Landgraf v. USI Film Prods.*, 511 U.S. 244, 269–70 (1994) (explaining that retroactivity is defined by “whether the new provision attaches new legal consequences to events completed before its enactment”).

Both the Boalick Memo and the Stewart Memo violate the Administrative Procedure Act, because these memorandums effected substantive changes in existing law or policy but did not go through notice-and-comment rulemaking. Moreover, Congress did not grant the USPTO the authority to retroactively enforce (or decline to enforce) rules or guidance. *Cf.* 35 U.S.C. §§ 2(b)(2), 316(a); *see also*, *e.g.*, *Tafas v. Dudas*, 511 F. Supp. 2d 652, 666 (E.D. Va. 2007) (“Congress did not expressly grant the PTO” “the power to promulgate retroactive rules.”). The retroactive application of the Stewart and Boalick Memos violates the Due Process Clause because it altered the legal consequences of actions that Samsung had already taken. See *Mexichem Fluor, Inc. v. EPA*, 866 F.3d 451, 462 (D.C. Cir. 2017) (“To satisfy the Due Process Clause, [an agency] must at a minimum ‘provide regulated parties fair warning of the conduct a regulation prohibits or requires.’”). Samsung received no such “fair warning.”

Director rehearing/review is required to consider the promulgation and retroactive effect of the Stewart and Boalick Memos on the Decision to discretionarily deny institution.

C. The Decision Failed to Follow the USPTO’s Current Guidance

An agencies’ ability to exercise discretion is constrained by the agencies’ own established rules and procedures. *See United States ex rel. Accardi v. Shaughnessy*, 347 U.S. 260, 267 (1954) (establishing the so-called “Accardi doctrine” and reversing the agencies’ decision because the agency acted “contrary to existing valid regulations”); *see also Serv. v. Dulles*, 354 U.S. 363, 388 (1957) (“It being clear that [the applicable regulation] was not complied with by the Secretary in this instance, it follows that under the Accardi doctrine petitioner’s dismissal cannot stand”); *Vitarelli v. Seaton*, 359 U.S. 535, 545 (1959) (“Because the proceedings attendant upon petitioner’s dismissal from government service on grounds of national security fell substantially short of the requirements of the applicable departmental regulations, we hold that such dismissal was illegal and of no effect.”).

Here, in addition to violating the terms of the Vidal memo, which was improperly rescinded, the discretionary denial Decision violates the currently applicable Boalick Memo, which was promulgated by the USPTO, and which remains in effect. The Boalick Memo continues to specifically instruct that “a timely-filed *Sotera* stipulation...is highly relevant” and that “the Board will consider

such a stipulation as part of its holistic analysis under *Fintiv*.” See Boalick Memo. In contrast to that instruction, the discretionary denial Decision never even mentions Samsung’s timely filed *Sotera* stipulation, nor does it consider its impact on the overlap of issues with the district court litigation. By failing to consider Samsung’s *Sotera* stipulation, the Decision runs afoul of even the currently implemented agency procedure and therefore violates the Accardi doctrine.

Director rehearing/review is necessary to properly consider Samsung’s *Sotera* stipulations and the overlap (or lack thereof) with the district court litigation.

D. The Decision’s Reliance on “Settled Expectations” Is Factually Unfounded and an Abuse of Discretion

Consistent with the Board’s prior rulings, and contrary to the decision here, the period of dormant existence since the issuance of iCashe’s patents does not support “settled expectations” that weigh in favor of the Patent Owner but instead weigh against discretionary denial. Five of the seven patents-in-suit issued between 2013 and 2016 but were never asserted against anyone (by iCashe or any previous patent owner) until iCashe filed its suit against Samsung on June 6, 2024. In other decisions, the Director has noted that years of non-enforcement, as in this proceeding, weigh ***against*** the patent owner’s claim to “settled expectations” of enforceability. *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12, *2-3 (PTAB 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. Stratasy, Inc.*, IPR2025-00438, Paper 10, *3 (PTAB July 17, 2025) (referring petitions to the Board 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).

Consistent with the Board’s prior rulings, and contrary to the decision here, the period of up to or exceeding a full decade of dormant existence since the issuance of five of the seven patents involved in this suit does not support PO’s claim to any positive “settled expectations,” and instead weighs against discretionary denial. *Id.*, see also *Tesla, Inc. v. Intell. Ventures II LLC*, IPR2025-00217, Paper 9, *2-3 (PTAB June 13, 2025); *Tesla, Inc. v. Navy*, IPR2025-00341, Paper 12, *2-3 (PTAB June 13, 2025). And the shorter period of existence for the remaining two patents (which issued in 2022 and 2023 respectively) similar weighs against a settled expectation property interest, because of the short time period in which these patents were in effect prior to being challenged. Decision at 3 (explaining that the circumstances surrounding the short length of time in which these patents were in force would “ordinarily . . . counsel against discretionary denial”).

The Decision is also inconsistent with the governing statutes. Congress was

explicit on the time frame to file IPR petitions. A petition may be filed any time after “the later of either ... 9 months after the grant of a patent ... or the date of the termination of [any] post-grant review,” and must be filed within one year of the date on which a petitioner is served with a complaint alleging infringement of that patent (requirements that Samsung complied with here). 35 U.S.C. §§ 311(c), 315(b). Petitions can also be filed after patent expiration, and have been for more than a decade. *See Apple Inc. v. Gesture Tech. Partners, LLC*, 127 F.4th 364, 368-69 (Fed. Cir. 2025). There is no *sub silentio* point when patents become immune to IPR petitions due to so-called “settled expectations.” Analogously, in *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, the Supreme Court rejected as a matter of law any attempt to limit actions based on timing where Congress was express about the time frame in which such actions are to take place. 580 U.S. 328, 346 (2017).

“Discretion is not whim,” and must be “limited” according to “legal standards” to “promote the basic principle of justice that like cases should be decided alike.” *Martin v. Franklin Cap. Corp.*, 546 U.S. 132, 139 (2005). The Decision failed to consider factors that have resulted in the rejection of discretionary denial in other proceedings. That resulted in the Decision being at odds with precedent, which is itself an abuse of discretion.

V. CONCLUSION

Petitioners respectfully request that the Director withdraw the Decision and refer the matter to a panel for consideration of the grounds presented.

Dated: September 12, 2025

Respectfully submitted,

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Lead Counsel for Petitioners

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Petitioners' Request for Director Rehearing and/or Review was served in its entirety by filing this document through the Patent Trial and Appeal Case Tracking System (P-TACTS) to the following attorneys of record for the Patent Owner listed below:

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