UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ONEPLUS TECHNOLOGY (SHENZHEN) CO., LTD.

Petitioner

v.

PANTECH CORPORATION

Patent Owner

_____

IPR2025-00783

U.S. PATENT 9,288,824

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PETITIONER'S REQUEST FOR DIRECTOR REVIEW

TABLE OF CONTENTS

I. INTRODUCTION 1

II. LEGAL STANDARD 1

III. ARGUMENT 2

A. The Decision Erred in Relying on the "Settled Expectations" Rule Alone to Deny Institution 2

1. The large number and wide scope of the patents asserted in the district court litigation weigh against discretionary denial of the '824 patent 2

2. Clear evidence of examiner error warrants referral to the Board of the '824 patent 5

B. The USPTO's Guidance Leading to the Discretionary Denial Violates the APA 8

IV. CONCLUSION 10

LIST OF EXHIBITS

Exhibit	Description
EX1001	U.S. Patent No. 9,288,824 to Noh *et al*.
EX1002	Prosecution History of U.S. Patent No. 9,288,824
EX1003	Declaration of Dr. Robert Akl
EX1004	"3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Evolved Universal Terrestrial Radio Access (E-UTRA) Medium Access Control (MAC) Protocol Specification (Release 8)," 3GPP TS 36.321 V8.3.0 (2008-09)
EX1005	"Corrections Relating to RACH" by Nokia Corporation, Nokia Siemens Networks, 3GPP TSG-RAN2 Meeting #63, R2-084921, Jeju, Korea, 18 August – 22 August, 2008
EX1006	"RA_WINDOW and RA-RNTI Allocation" by Qualcomm Europe, 3GPP TSG-RAN WG2 #61bis, R2-081559, Shenzhen, China, 31st March – 4th April, 2008
EX1007	"Coding of RA-RNTI for Message 2" by ZTE, 3GPP TSG-RAN Working Group 2 meeting #59bis, R2-073933, Shanghai, China, 8th October – 12th October, 2007
EX1008	"3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Evolved Universal Terrestrial Radio Access (E-UTRA) Medium Access Control (MAC) Protocol Specification (Release 8)," 3GPP TS 36.321 V8.0.0 (2007-12)
EX1009	"Number of HARQ Processes for FDD" by Nokia, Nokia Siemens Networks, 3GPP TSG-RAN WG1 Meeting #50bis, R1-074344, Shanghai, China, October 8th – 12th, 2007
EX1010	Declaration of Friedhelm Rodermund
EX1011	U.S. Provisional Application No. 61/018,492
EX1012	Certified English Translation of U.S. Provisional Application No. 61/018,492
EX1013	Korean Patent Application No. 10-2008-0047656
EX1014	Certified English Translation of Korean Patent Application No. 10-2008-0047656
EX1015	"3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Evolved Universal Terrestrial Radio Access (E-UTRA) and Evolved Universal Terrestrial Radio Access Network (E-UTRAN); Overall Description; Stage 2 (Release 8)," 3GPP TS

Exhibit	Description
	36.300 V8.0.0 (2007-03)
EX1016	First Amended Docket Control Order, *Pantech Corp. et al. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, 5:24-cv-00038-RWS-JBB, Dkt. No. 47 (E.D. Tex. March 12, 2025)
EX1017	Joint Claim Construction and Prehearing Statement, *Pantech Corp. et al. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, 5:24-cv-00038-RWS-JBB, Dkt. No. 49 (E.D. Tex. March 26, 2025)
EX1018	E. Dahlman *et al*., "3G Evolution: HSPA and LTE for Mobile Broadband," 1st ed. Elsevier, 2007
EX1019	Prosecution History of U.S. Patent No. 8,611,297
EX1020	Correspondence with Patent Owner dated May 23, 2025
EX1021	*Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.*, 5:24-cv-00038-RWS-JBB (E.D. Tex.), Dkt. No. 1, Complaint for Patent Infringement
EX1022	*Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.*, 5:22-cv-00069-RWS (E.D. Tex.), Dkt. No. 6, First Amended Complaint for Patent Infringement
EX1023	*Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.*, 5:22-cv-00069-RWS (E.D. Tex.), Dkt. No. 223, Redacted Amended Joint Final Pretrial Order
EX1024	"Albright Worried Multipatent Trials Ask Too Much Of Jurors," Law360 (Dec. 18, 2020), at https://www.law360.com/articles/1337976/albrightworriedmultipatent-trials-ask-too-much-of-jurors
EX1025	*Sonos Inc. v. D&M Holdings, Inc.*, 1:14-cv-01330-WCB (D. Del.), Dkt. No. 418, Discovery Dispute Letter Brief
EX1026	*Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.*, 5:24-cv-00038-RWS-JBB (E.D. Tex.), Plaintiff's Patent Infringement Contentions
EX1027	USPTO Recordation of Patent Assignment Document, Reel: 052657 Frames: 0066-0090
EX1028	*Pantech Corp. v. Oneplus Tech. (Shenzhen) Co., Ltd.*, 5:25-cv-00089 (E.D. Tex.), Dkt. No. 1, Complaint for Patent Infringement
EX1029	Docket Navigator Statistics for Judge Schroeder in E.D. Tex
EX1030	*Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.*, 5:24-cv-00038-RWS-JBB (E.D. Tex.), Dkt. No. 12, Joint Motion to Stay

Exhibit	Description
	Proceedings
EX1031	*Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.*, 5:22-cv-00069-RWS (E.D. Tex.), Dkt. No. 259, Verdict Form
EX1032	*Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.*, 5:22-cv-00069-RWS (E.D. Tex.), Dkt. No. 499, Final Judgment
EX1033	*Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.*, 5:22-cv-00069-RWS (E.D. Tex.), Dkt. No. 502-1, Redacted Version of Court's Order (Dkt. No. 498)
EX1034	*Pantech Corp. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, 5:24-cv-00038−RWS-JBB, (E.D. Tex.), Dkt. No. 85, Order
EX1035	*Pantech Corp. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, 5:24-cv-00038−RWS-JBB, (E.D. Tex.), Dkt. No. 86, Third Amended Docket Control Order
EX1036	In Patent Nullity Proceedings on European Patent 2,227,923 (DE 60 2008 039323), German Federal Patent Court, 4 Ni 69/22 (EP), Judgment
EX1037	Machine Translation of EX1036
EX1038	*Pantech Corp. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, 5:24-cv-00038−RWS-JBB, (E.D. Tex.), Dkt. No. 112, Order Adopting Joint Stipulation and Staying This Case Pending Resolution of the ITC Action

All emphases in quotations are added unless otherwise noted.

Direct quotations of claim language are italicized.

I. INTRODUCTION

Petitioner respectfully requests Director review of the Decision Denying Institution of *Inter Partes* Review ("IPR") ("Decision") of U.S. Patent No. 9,288,824 (the "'824 patent").

Although the Decision purported to undertake a "holistic" review of all factors relevant to discretionary denial, the record demonstrates otherwise. The Decision denied institution solely based on a single, flawed rule of "settled expectations," while other critical considerations—including the large number and wide scope of the patents asserted in the parallel district court litigation and the clear evidence of material examiner error—were ignored. The Director has emphasized in prior decisions that these factors weigh heavily against discretionary denial. The Decision's failure to conduct a genuine, balanced analysis constitutes an abuse of discretion and legal error.

The Decision's reliance on USPTO's new guidance on discretionary denial, in particular the "settled expectations" rule, which did not go through notice-and-comment rulemaking, also violates the Administrative Procedure Act ("APA").

II. LEGAL STANDARD

Pursuant to 37 CFR § 42.75 and the USPTO's guidance on Director Review, a party may seek review of "any decision on institution under 35 U.S.C. § [314]." *See* 37 CFR § 42.75; "Guidance on Director Review Process." Review is

appropriate where the decision reflects "(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

III. ARGUMENT

A. The Decision Erred in Relying on the "Settled Expectations" Rule Alone to Deny Institution

The Decision relies on the alleged "strong settled expectations" for Patent Owner alone to deny institution and erroneously concludes that Petitioner failed to show why IPR would be an appropriate use of Board resources. Decision at 2. This finding, however, disregards the substantive arguments and overwhelming evidence presented in Petitioner's Opposition to Discretionary Denial Request ("DD Opposition")—and Director precedent—favoring referral to the Board.

1. The large number and wide scope of the patents asserted in the district court litigation weigh against discretionary denial of the '824 patent

Discretionary denial is inappropriate here, given the large number of asserted patents and the diverse, complex subject matter involved in the parallel district court

litigation. *See* DD Opp at 14-19. Specifically, in the parallel district court case,[1] Patent Owner asserts ***eight patents from eight different families***, directed to ***a diverse range of subject matter*** of sophisticated 4G/5G wireless communication technologies (e.g., the '283 patent directed to radio link failure (RLF) handling, the '251 patent directed to channel state information-reference signals (CSI-RS), the '824 patent directed to random access (RA) procedure, the '803 patent directed to handover, etc.). *See* EX1021, 4-6, 13, 16, 19-20, 23, 26, 29, 32, 35; EX1026, 2-4.

When faced with similar circumstances, the Director has routinely weighed this factor heavily and found that it counsels against discretionary denial even when the challenged patents have been in force for over seven years. In *American Airlines, Inc. et al. v. Intellectual Ventures I LLC*, IPR2025-00785 *et al*., Paper 11 (Director Aug. 29, 2025), although the two challenged patents had been in force for over 14 years, the Director still referred the IPRs to the Board because of the reduced concern of inconsistent outcomes or significant duplication of effort between the PTAB and

[1] U.S. Patent Nos. 9,288,824 (the "'824 patent"), 11,212,838 (the "'838 patent"), 9,763,283 (the "'283 patent"),10,863,573 (the "'573 patent"), 9,369,251 (the "'251 patent"), 9,769,776 (the "'776 patent"), 8,995,372 (the "'372 patent"), and 10,764,803 (the "'803 patent") asserted in *Pantech Corp. et al. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, No. 5:24-cv-00038-RWS-JBB (E.D. Tex.).

district court litigation, and determination that the PTAB is better suited to review a large number of patents involving diverse subject matter than the district court. *Id*. at 2-3.

Tracking closely with *American Airlines*, the Petition here has ***no concern*** of inconsistent outcomes or significant duplication of efforts, as the parallel district litigation has been stayed after the Decision. EX1038. As to the number and scope of the asserted patents, in *American Airlines*, the Director explained that the "large number" (12) and "wide scope" (six families) of asserted patents weighed against discretionary denial because "the Board is better suited to review a large number of patents involving diverse subject matter." *American Airlines*, Paper 11 at 3. Here, similarly, in the parallel district litigation, Patent Owner has asserted eight patents from eight different families, relating to different aspects of sophisticated 4G/5G wireless communication technologies. Moreover, the '824 patent here has been in force for a significantly shorter period than those challenged in *American Airlines*.

Similarly, in *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217 *et al*., Paper 9 (Director Jun. 13, 2025), although the challenged patents issued in 2007 and 2011 and the scheduled trial date preceded the projected final written decision (FWD) date, the Director found that "Petitioner's arguments regarding the complex and diverse litigation proceeding tip the balance against discretionary denial" because "[t]he large number and vast scope of the patents asserted in the district court

litigation … weighs against discretionary denial, as the Board is better suited to review a large number of patents involving diverse subject matter." *Id*. at 2-3; *see also*, *Shenzen Tuozhu Technology Co. Ltd. v. Stratasys, Inc*., IPR2025-00531, Paper 10 at 3 (Director Jul. 17, 2025) ("*Stratasys*") (similar). That same rationale applies here. Again, the '824 patent here has been in force for a shorter period than those challenged in *Tesla* and *Stratasys*.

Notably, in each of these prior decisions, despite the patents at issue having been in force for more than seven years, purportedly creating strong settled expectations for the patent owner, the Director still referred the petition to the Board for consideration. *See, e.g.*, US 7,916,180, US 9,232,158, and US 9,706,500 in *Tesla*, US 7,257,582 and US 7,949,785 in *American Airlines*, and US 9,168,698 in *Stratasys*.

Accordingly, consistent with the Director's decisions in *American Airlines*, *Tesla*, and *Stratasys*, the Board is better suited to review a large number of patents involving diverse subject matter, including the challenged claims of the '824 patent here.

2. Clear evidence of examiner error warrants referral to the Board of the '824 patent

Petitioner presented clear evidence in the DD Opposition that the examiner allowed the challenged claims after overlooking material prior art references. *See*

DD Opp. at 7-14.

Director precedent confirms that such evidence warrants review. *See, e.g., Microsoft Corp. v. Partec Cluster Competence Center GMBH*, IPR2025-00318, Paper 9 at 3 (Director Jun. 12, 2025) (finding that discretionary denial of institution is not appropriate as the Office erred by overlooking prior art teachings related to allowable subject matter, warranting the "use of Office resources to review the potential error"). Notably, even when the challenged patents allegedly had "settled expectations"—which do not and should not exist here—the Director has specifically credited "material errors" as a factor counseling against discretionary denial and referred the proceeding to the Board. *See, e.g.*, *Anthony Inc. v. Controltec LLC*, IPR2025-00559 *et al*., Paper 9 at 2 (Director Jul. 16, 2025) ("*Anthony*") (the challenged patents had been in force for approximately 18 and 17 years, but because "the Petitioner appears to show a material error by the Office," the Director held "it is an appropriate use of Office resources to review the potential error"); *Eunsung Global Corp. v. HydraFacial LLC*, IPR2025-00445 *et al*., Paper 14 at 3 (Director Jul. 10, 2025) ("*Eunsung*") (similar); *Xencor, Inc. v. Merus N.V.*, IPR2025-00604 *et al*., Paper 12 at 3 (Director Jul. 17, 2025) ("*Xencor*") (similar).

As explained in the DD Opposition, during prosecution of the '824 patent, the examiner states that claim 1 is allowable over U.S. Patent Application Publication No. 2010/0323736 in the name of Fischer *et al*. (hereinafter "Fischer") and U.S.

Patent Application Publication No. 2008/0232317 in the name of Jen (hereinafter "Jen") because Fischer and Jen fail to disclose, among others, that "***the offset equals three***." *See* DD Opp. at 8.

First, since neither the '824 patent nor any of its priority applications describes the specific value of subframe offset being "***three***" in the allowable subject matter, with reasonable clarity, let alone sufficient detail, claims 1 and 7 are ***not*** entitled to the benefit of any priority application under 35 U.S.C. § 112. *See* DD Opp. at 9-10. By overlooking the written description issue, the Office applied an incorrect search period during examination, necessarily omitting prior art that could have been used to reject claims 1 and 7. *See Padagis US LLC v. Neurelis, Inc*.. IPR2025-00464, Paper 12 at 3-4 (Director Jul. 16, 2025) (finding the examiner erred regarding the priority issue).

Second, as explained in detail in the DD opposition, the examiner overlooked relevant prior art, as each of ZTE (EX1007), Qualcomm (EX1006), and TS36321-V830 (EX1004) alone clearly teaches the purportedly patentable subject matter related to "*the offset equals three*" in claims 1 and 7. *See* DD Opp. at 10-14. **Notably, in the invalidity proceeding against the EP counterpart of the '824 Patent (EP 2,227,923, DE 60 2008 039323), the German Federal Patent Court found that Qualcomm discloses the purported patentable subject matter related to the "*offset*."** *Id*. at 12 (citing EX1037, 39-42).

It is inconsistent that the patents in *Anthony*, *Eunsung*, and *Xencor*—which had been in force for longer than the challenged '824 patent here—were referred to the Board for review of material errors, yet the Decision did ***not*** address this factor at all.

B. The USPTO's Guidance Leading to the Discretionary Denial Violates the APA

On March 26, 2025, the USPTO announced a new procedure governing discretionary denial in America Invents Act (AIA) trial proceedings, including IPRs, through a new memo: "Interim Processes for PTAB Workload Management" ("Stewart Memo"). The promulgation of the new Stewart Memo substantively changed the contour of discretionary denial, which is relied upon by the Decision here. Specifically, the Stewart Memo introduced a new procedure for considering discretionary denial and a host of new, additional discretionary factors, including the "settled expectations" rule that the Board relied on here. Because the Steward memo, in particular the "settled expectations" rule, did not go through notice-and-comment rulemaking, it is in violation of the APA.

Notice-and-comment "assure[s] fairness and mature consideration of rules of general application." *NLRB v. Wyman-Gordon Co*., 394 U.S. 759, 764 (1969). Agency action disregarding that procedural requirement must be set aside. *See, e.g., Coal. for Common Sense in Gov't Procurement v. Sec'y of Veterans Affs*., 464 F.3d

1306, 1317 (Fed. Cir. 2006). The Steward memo, in particular the "settled expectations" rule, imposed without notice-and-comment procedures, violates the APA and should be set aside.

The APA requires notice-and-comment rulemaking for substantive rules. 5 U.S.C. §553. The APA defines as a "rule" any "agency statement of general or particular applicability and future effect designed to implement, interpret, or prescribe law or policy." §551(4). Substantive rules, but not "interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice," require notice and comment. §553(b). Rules are "substantive" if they "effect a change in existing law or policy" or "affect individual rights and obligations." *Paralyzed Veterans of Am. v. West*, 138 F.3d 1434, 1436 (Fed. Cir. 1998).

The USPTO's "settled expectations" rule in the Steward Memo is a "rule" under the APA. It applies generally and prospectively to any IPR petition, and it implements and prescribes a concrete limit on IPR. The "settled expectations" rule "change[s] existing law and policy," *id*., by introducing a never-seen-before IPR precondition. The "settled expectations" rule affects patent challengers' rights by creating a new ground for depriving opportunities to seek patent cancellation through IPR. It substantively affects patent owners and the public by establishing a category of "old" patents that are protected against IPR, and affects challengers' rights and obligations by requiring premature IPR challenges early in a patent's life,

or forfeiture of IPR rights.

Therefore, Director Review is necessary to correct the reliance on the improper Steward Memo, particularly the "settled expectations" rule, including in the scenario that it is rescinded at a future date as a result of pending legal challenges.

IV. CONCLUSION

For all the foregoing reasons, Petitioner respectfully requests that the Director grant review, vacate the Decision, and refer the Petitions to the Board.

Respectfully submitted,

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CERTIFICATION UNDER 37 C.F.R. § 42.24

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Request for Director Review complies with the 15-page limit exclusive of the parts exempted as provided in 37 C.F.R. § 42.24(a).

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **Petitioner's Request for Director Review and Exhibit 1038** were served on October 14, 2025, via email, as agreed to by counsel of record for the Patent Owner, at the following.

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