

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUZHOU MOJAWA INTELLIGENT ELECTRONIC CO., LTD.,

Petitioner,

v.

SHENZHEN SHOKZ CO., LTD.,

Patent Owner.

PTAB Case No. IPR2025-00843

Patent No. 11,310,582 B2

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

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I. INTRODUCTION

The Acting Director materially erred in this *inter partes* review for U.S. Patent No. 11,310,582 (the “’582 patent”) by not denying institution under 35 U.S.C. § 325(d) despite Patent Owner’s clear showing that the Petition’s invalidity grounds use substantially identical references to those used by the Examiner during prosecution.

II. LEGAL STANDARD FOR DIRECTOR REVIEW

“Requests for Director Review of a Board’s decision on institution . . . shall be limited to decisions presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law.” USPTO, Revised Interim Director Review Process § 2.B (last modified Oct. 8, 2025). “The Director Review process provides a mechanism to correct errors at the institution stage, for example, to avoid unnecessary trials for patent owners.” *Id.*

III. ARGUMENT

The Director should deny institution of the Petition because the Acting Director’s referral decision, respectfully, erred in at least its findings of material fact.

A. Prosecution Record of the ’582 Patent Clearly Shows Identical And Cumulative Teachings were Considered by the Patent Office

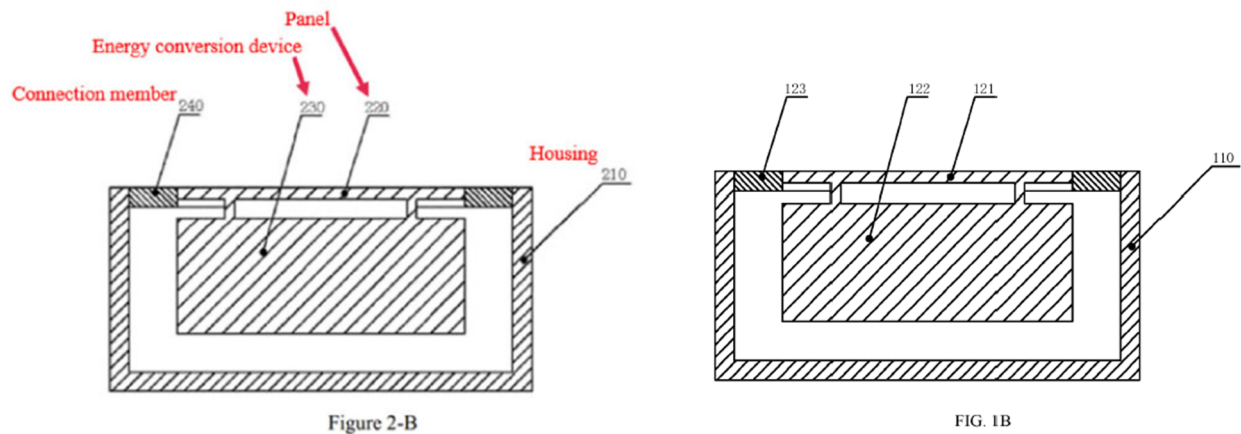
All of Petition’s invalidity grounds rely on primary reference Li (EX1004) in combination with Liao (EX1005), including for the sole independent claim, claim 1. Paper 1 (Petition) at 1.

Li Reference: It is undisputed that Li, has identical figures and identical substantive description to the Li '054 reference (EX2002) cited by the Examiner as the “closest prior art” of record during examination. Paper 8 (Request for Discretionary Denial) at 2-3; EX1002 (file history), 46-47; EX2004, ¶¶2-4. The identical nature of the two references is further demonstrated by electronic comparison in EX2011, showing identical “Description of figures” in paragraphs [0006]-[0022], and substantially identical “Specific embodiments” starting in paragraph [0023] through the end of the document in paragraph [0081]. *See* EX2011; Paper 8 at 2-3.¹ The only sections that differ between the two references are the Abstract, the claims, and five short starting paragraphs [0001]-[0005] that form the “Field of invention” and “Background of the invention,” the latter partly paraphrasing claim 1 that differs between the two references. *Id.* More importantly, all of the Petition’s relied-upon sections of Li were part of paragraphs [0006]-[0081] that were substantially identical to those in Li '054. Paper 1, at 3; Paper 8 at 6-7.

Liao Reference: The Petition’s use of the Liao reference for claim 1 is limited

¹ The black line near the top of several pages of EX2011, in paragraphs [0019], [0029], [0035], [0041], [0046], [0060], and [0073], is an artefact of the comparison program rather than a deletion between the compared exhibits. These paragraphs are identical.

to element 1[e], which relies on the features described in Liao's Fig. 2-B.² Paper 1 at 10, 34-35, 41-42; Paper 8 at 3, 6. But Fig. 2-B of Liao was identically present and described in a reference, Qi (EX2003), cited in an IDS and considered by the Examiner during the prosecution of the '582 patent. EX1002, 162, 166; Paper 8 at 4. These identical figures (Fig. 2-B of Liao and Fig. 1B of Qi) are reproduced below. Paper 8 at 4.



Examiner's Actions: The Examiner uncovered the Li '054 reference and characterized it as the "closest prior art of record" in the Notice of Allowability. Paper 8 at 7; EX1002, 46-47, 134-135, 137. Notably, the Examiner found the claims allowable over Li '054 based on both the "first plug end" element 1[c] and the

² Petitioner's expert argues at length that limitation 1[e] (a rigid connection) is already taught by Li. EX1003, ¶¶134-137. Thus, Petitioner's use of Liao in the combination is also cumulative over Li '054 reference already in front of the Examiner. Paper 8 at 7.

“vibration” element 1[e]. *Id.*; Paper 8 at 9. The Examiner also considered the Qi reference, which was cited in an IDS. EX1002, 162, 166.

Therefore, the prosecution history of the ’582 patent very clearly demonstrates that the exact teachings of prior art references that the Petition relies on were already known to, and considered by, the Examiner.

B. Petitioner’s Opposition to Discretionary Denial Request Fails to Rebut the Clear Duplicative Nature of Petition’s References

The Acting Director’s decision referring the IPR does not explain its reasoning regarding §325(d) beyond a conclusory statement that “Petitioner provides persuasive reasoning... that discretionary denial under 35 U.S.C. §325(d) is not appropriate.” Paper 14 (Decision Referring the Petitions to the Board) at 2. However, Petitioner’s arguments against discretionary denial (Paper 10, “Discretion Response”) neither rebut the clear evidence in the prosecution history that shows the Petition’s use of duplicative and cumulative art, nor show any evidence of Examiner error.

Petitioner’s Conjecture Fails to Rebut the Clear Prosecution Record:

Petitioner makes conclusory statements about the Examiner’s actions including that the Examiner allegedly performed only “a cursory review of Li,” and did not specifically mention the Qi reference. Paper 10 at 8-10. Petitioner also contends that the Examiner did not provide an “analysis or support as to why” the claims of the ’582 Patent are patentable over Li ’054. *Id.* However, there is nothing

in Petitioner's arguments indicative of an Examiner error. Notably, while the Examiner's Notice of Allowability provides ample explanations as to which claim elements are not found in the prior art (EX1002, 46-47), there is no requirement for the examiner to provide a detailed explanation regarding the allowability of a claim. *See* MPEP, §§ 1302.01-1302.04.

Furthermore, Petitioner's presumptive assertions based on guesswork and supposition fall woefully short of the type of examiner errors that prior discretionary denial decisions have found persuasive. *See Activision Blizzard, Inc. v. Milestone Entertainment, LLC*, IPR2025-00708, Paper 13 at 2-3 (Aug. 14, 2025) (petition was referred to the panel where challenged claims omitted limitations that appeared to have been basis for allowance of parent patent); *see also USAA Federal Savings Bank v. PACid Techs., LLC*, IPR2025-00697 (and related matters), Paper 9 at 3 (Aug. 14, 2025) (finding examiner error where the examiner maintained "the same prior art discussed in the ancestor application during the prosecution of the child applications, even though the child applications are directed to different technologies").

Petitioner Failed to Show Examiner Error as to Every Element Found Missing in Prosecution:

The Examiner's Notice of Allowance cited *multiple* missing limitations in the prior art (EX1002, 47), and while Petitioner makes a conclusory statement that the

Examiner erred with respect to *all* of them (Paper 10 at 10-15), Petitioner's arguments clearly fall short with respect to at least element 1[c], a "core housing for accommodating an earphone core... fixed to [a] first plug end [of an ear hook]."

Petitioner unpersuasively argues that the Examiner allegedly erred by "contradicting" her own opinion in the Notice of Allowance as to whether Li '054 taught element 1[c]. Paper 10 at 11, 13. Yet neither the Petition nor Petitioner's Discretion Response even argued that Li *itself* explicitly taught the configuration required by element 1[c], *i.e.* a plug end connecting an ear hook to a sound-producing earphone core. Rather, the Petition relied on Li's description of plugs in a different location (between a "rear hook" and a different housing (*see* Paper 8 at 27-29), and then argued that it would have been obvious to *add* a plug end to Li in the claimed position based on vague purported benefits of a "modular" headset. Petition at 23-24, 30-31; Paper 10 at 11. But the Examiner was already aware of (and indeed cited) the plugs in the identical Li '054, so there was no "oversight" with respect to this element. EX1002, 46-47.

Petitioner's Reliance on Generic "Interchangeable Headset" References did not Show Examiner Error:

Petitioner attempted to cure this deficiency by citing various references, none included in its primary combination, which it identified as "interchangeable audio headset prior art." Paper 1 at 17-18, 23-26. Yet nothing in this "interchangeable"

art taught the required configuration; Petitioner merely argued that these references suggested that “modular portions... of headsets were well-known” and that adding a plug end at the required location would achieve “the well-known benefits of a modular speaker.” Paper 1 at 23-24, 25. Nothing about this was new relative to the art in front of the Examiner: by Petitioner’s own argument, Li itself already “discloses plug ends in its design and recognizes their benefits in a modular earphone design...” Paper 1 at 27-28. Therefore, by Petitioner’s own admission, the supposedly new art “not before the Examiner” (Paper 10 at 6-7) that it relied on was cumulative with the art already considered by the Examiner, down to the specific portions of the prior art cited and the elements with respect to which the Examiner considered it.

Generic Prior Art Showing “Modular” Headsets Does not Show Error with Respect to the Specific Claimed Configuration

The supposedly “new” teaching of general benefits of “modular” or “interchangeable” headsets was not just cumulative, but legally insufficient to make up the missing element. For example, in *ActiveVideo Networks, Inc. v. Verizon Comm’cns, Inc.*, the Federal Circuit upheld a district court JMOL of no invalidity when the patent challenger’s expert relied on testimony about the “modular nature of the components in the asserted claims,” which the Federal Circuit found insufficient to show a motivation to combine elements from the prior art references

“in the way the claimed invention does.” 694 F.3d 1312, 1327-28 (Fed. Cir. 2012).

In other words, merely showing that “modular” components were known in the relevant art does not establish that a POSITA would have joined them with a “plug end” structure in a specific manner between particular components. Nothing in the “interchangeable” art cited by Petitioner showed a plug between an ear hook and a housing containing a headphone core, and Petitioner did not argue that it did. Petition, 30-31. Notably, while Patent Owner cited *ActiveVideo* in its Request for Discretionary Denial and Patent Owner Preliminary response (Paper 8 at 30, Paper 11 at 29), the Acting Director’s referral decision and the Institution Decision ignored it, as did Petitioner’s Discretion Response.

Petitioner Improperly Relied on new Art Cited for the First Time in its Discretion Response

Recognizing this deficiency, Petitioner attempted to fix it in its Discretion Response by adding a new reference, Kim (EX1032), to belatedly argue that this reference teaches the specific claimed configuration because “the modular point is between the headphone structure and sound-producing element.” Paper 10 at 16. Although Petitioner argues that the Examiner erred by failing to identify Kim (*id.* at 17), and that its Petition offered a chance to “rectify” the error, no error is “rectified” by considering a reference that the *Petition did not even cite*. The referral decision does not indicate whether Petitioner’s Kim argument was part of the “persuasive

reasoning” relied on to refer the case to a merits panel. Thus, Director Review is appropriate at least to clarify that a Petitioner cannot rely on the discretionary review process to belatedly fix holes in their obviousness case, particularly where their existing arguments relied entirely on cumulative art.

IV. CONCLUSION

For the foregoing reasons, the Director should review the referral and institution decisions and find that discretionary denial under §325(d) is appropriate because the Petition squarely relies on duplicative art already considered by the examiner, and because Petitioner’s arguments fail to show an examiner error.

Dated: December 3, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of this PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW has been served by electronic mail to the attorneys of record for Petitioner:

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