

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

U.S. Patent No. 11,310,582
Inter Partes Review No.: IPR2025-00843

**PETITIONER'S AUTHORIZED RESPONSE TO
DIRECTOR REVIEW REQUEST**

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Rather than show any purported erroneous findings of material fact, Patent Owner’s (“PO’s”) Request for Director Review targets the Acting Director’s referral decision by retreading 35 U.S.C. § 325(d) arguments already extensively briefed by both parties at the discretionary denial stage. Notably, PO takes no issue with the Acting Director finding no settled expectations and crediting the stay of the parallel district court case, which are sufficient grounds alone to refer petitions. Petitioner incorporates by reference its already filed response regarding 35 U.S.C. § 325(d) at Paper 10 (Petitioner’s Response to PO’s Brief in Support of Discretionary Denial). For those same reasons, including the Examiner’s multiple errors, and for Petitioner’s further detailed response below, the Acting Director did not err in her referral decision.

I. ARGUMENT

A. PO Did Not Meet Its Burden of Showing Erroneous Findings of Material Fact.

PO asserted that “the Acting Director’s referral decision, respectfully, erred in at least its findings of material fact.” Paper 17 (Request) at 1. However, PO’s Request does not identify *any* alleged erroneous finding of material fact. Instead, the only reference to the Acting Director’s findings stated: “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.’” *Id.* at 4.

Accordingly, PO's Request should be denied for not meeting its burden to show erroneous findings of material fact.

Further, PO did not identify any important issues of law or policy or erroneous conclusions of law because, as noted above, PO only stated that the Acting Director "does not explain its reasoning." *Id.* Instead of showing erroneous findings of material fact as promised, PO retreads arguments that did not persuade the Acting Director and certainly does not evidence an abuse of discretion, which PO did not raise as a ground for Director Review in its Request.

B. The Acting Director Properly Referred the Petitions Where There Are No Settled Expectations and the Parallel District Court Proceeding Is Stayed.

PO's Request for Director Review reargues the 35 U.S.C. § 325(d) aspect of the Acting Director's referral decision without mentioning the findings of no "strong settled expectations that favor discretionary denial" or the stayed parallel district court proceeding "counsel[ing] against discretionary denial." Paper 14 (Decision Referring the Petitions to the Board) at 2. The Acting Director's reasoning remains unchallenged on these points and rightfully supports referring the petitions on these grounds alone. *See MIM Software Inc. Inc. v. EXINI Diagnostics AB, Inc.*, IPR2025-00827, Paper 12 at 2-3 (Director Aug. 22, 2025) (referring petition to the Board where PO had not developed strong settled expectations, related district court proceeding was stayed, and Petitioner provided persuasive reasoning that § 325(d)

denial was not appropriate); *Orca Security Ltd. v. Wiz, Inc.*, IPR2025-01087, Paper 10 at 2-3 (Director Oct. 17, 2025) (discretionary denial inappropriate where no strong settled expectations and district court proceeding was stayed). Further, PO’s argument that the Acting Director somehow erred in her 35 U.S.C. § 325(d) analysis is unfounded—and certainly does not evidence an abuse of discretion—as explained further below, and should not change the tide of the Acting Director’s other findings.

C. *Advanced Bionics* Part 1: The Petition’s Challenges Are Not the Same or Substantially the Same as those Considered During Prosecution.

As noted by the Director:

In determining whether to discretionarily deny a petition under § 325(d), Office policy requires a determination of “(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.”

Tesla, Inc. v. Charge Fusion Techs., LLC, IPR2025-00152, IPR2025-00153, Paper 11 at 2 (Director June 12, 2025) (citing *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”)). As briefed by Petitioner below, applying the two-part framework discussed in *Advanced Bionics*, it is evident that

referral of the petitions was proper and the Acting Director did not err in findings of material fact to the extent PO identified any errors.¹

Regarding section III.A. of the Request, PO asserts that Li and Liao are cumulative art to the art cited in prosecution. Request at 1-4. However, PO simply repeats its past arguments with no further detail as to how the Acting Director erred in her referral decision. PO again makes arguments regarding only two of the 18 prior art references supporting the Petition. First, PO argues the Li '492 reference in Mojawa's petition is cumulative of the Li '054 reference. *Id.* at 2. Second, PO argues the Liao reference in Mojawa's Petition is cumulative of the Qi reference applicants cited in an IDS. *Id.* at 2-3. PO continues to ignore the 16 other pieces of prior art discussed in the Petition and the supporting expert declaration when evaluating whether the same art or arguments was presented to the Office. Paper 1 (Petition) at vi, 1. Critically, it is uncontested that among the art not before the Examiner is all of the Petition's interchangeable audio headset prior art, which PO mentions in a later section of its Request, evidencing that modular portions of headsets, including speakers, control circuits, and batteries, were well-known as of the '582 Patent's

¹ Though the Acting Director's decision referred both petitions in IPR2025-00842 and IPR2025-00843, PO challenges the referral only of the petition in IPR2025-00843.

priority date. Petition at 17-18 (citing EX1011-EX1016, EX1019). This art, as cited throughout the Petition, including for claim 1, evidences the obviousness to a POSITA of the claimed plug ends in Li. Significantly, the challenges in the Petition are therefore not the same or substantially the same as those considered during prosecution. PO's restatement of its arguments here adds nothing and does not explain how the Acting Director erred.

D. *Advanced Bionics* Part 2: The Office Erred in a Manner Material to the Patentability of the Challenged Claims.

Rather than cite to *Advanced Bionics*, PO states, without support, that it is Petitioner's burden to "rebut the clear duplicative nature of [the] petition's references." Request at 4. This inquiry is wrong. The right inquiry for whether to discretionarily deny a petition under § 325(d) is the *Advanced Bionics* framework. As previously briefed by Petitioner, *Advanced Bionics* part (2) counsels against discretionary denial due to the Examiner's multiple errors as to each of the claim 1 elements purportedly not found in the prior art. Paper 10 at 7-19. PO's retread of the same arguments, or minor refinements following Petitioner's discretionary denial brief, provide no basis for disturbing the Acting Director's findings.

1. The Examiner Erred

PO faults Petitioner's discretionary denial briefing for being "conclusory" as to both the Examiner's cursory review of Li and the Examiner not mentioning Qi. Request at 4. But Petitioner's analysis was not conclusory: It was factual. The

Examiner provided no analysis or support as to why Li did not disclose certain claim 1 elements. Paper 10 at 8-10 (Examiner simply listing claim 1 elements she believed not found in Li or any other prior art with no explanation). It is undisputed the Examiner did not discuss Qi in any way. *Id.* at 2. PO argues the Examiner provided “ample explanations as to which claim elements are not found in the prior art,” Request at 5, but that simply is not true where no explanation was provided. Paper 10 at 8-10. As explained by Petitioner below, the Office did not consider or apply the art as set forth in the Petition. Paper 10 at 7. It is undisputed that the Examiner overlooked Petitioner’s combination of Li with Liao (the Examiner making no mention of the Liao or Qi reference), as well as all of the other art cited by Petitioner and Petitioner’s expert, including the interchangeable audio headset prior art. *Id.* at 9. Further, the Examiner did not have the benefit of expert Dr. Kyriakakis’s declaration and detailed analysis laying out where each claim element is found in the prior art, including in Li, as well as the analysis of the POSITA’s knowledge. *Id.* at 9-10. It cannot be said that Petitioner’s theories, including the obviousness of the claimed plugs in Li to a POSITA, were considered or rejected by the Examiner. *Id.* at 10. Petitioner briefed where the Examiner erred across all claim 1 elements cited by her. *Id.* at 10-18.

PO unsuccessfully attempts to distinguish the ’582 Patent Examiner’s errors from purportedly more egregious errors previously found to warrant referral.

Request at 5. For example, PO cited the decision in *Activision*, which referred the petitions in IPR2025-00711 through IPR2025-00713 because, *inter alia*, the parallel district court proceeding had been stayed, and Patent Owner had not developed strong settled expectations. *Activision Blizzard, Inc. v. Milestone Entertainment, LLC*, IPR2025-00708, Paper 13 at 2 (Director Aug. 14, 2025). The same is true here. In *Activision*, it was only when the patent owner had developed strong settled expectations for the patent in IPR2025-00708 (not the case here) that the judge addressed Petitioner arguments regarding examiner error. *Id.* at 2-3. Similarly, the Acting Director in *USAA Federal Savings Bank* found a final written decision would likely issue before trial in the district court, as here. *USAA Federal Savings Bank v. PACid Techs., LLC*, IPR2025-00697, Paper 9 at 2 (Director Aug. 14, 2025). In both decisions, the judges mention investigating examiner error, which Petitioner has extensively briefed here. Paper 10 at 7-19. PO cites no authority that limits examiner error to the examples in the two decisions it cites or excludes the examiner error identified here.

Next, PO, without citing authority, puts the burden on Petitioner to “show Examiner error as to every element found missing in prosecution.” Request at 5. This is the wrong inquiry. The right inquiry is the *Advanced Bionics* framework. Petitioner detailed the Examiner’s mistakes at length in its briefing across all elements cited by the Examiner, Paper 10 at 10-19, and again did not simply “make[]

a conclusory statement” that the Examiner erred. Request at 5-6. Notably, PO in its Request only specifically takes issue with *one* of the six elements briefed by Petitioner, leaving the other five unrebutted. *Id.* PO’s counterargument to that one element—element 1[c]²—misses the point as to how the Examiner contradicted herself. As Petitioner explained below, the Examiner found Li disclosed “***the core housing being fixed to the first plug end.***” Paper 10 at 11. Li discloses the protective sleeve is an elastic, silicone layer, and waterproof. *Id.* at 10-11. Therefore, it follows that in order to be waterproof, as disclosed by Li, the core housing must be ***elastically abutted against the protective sleeve***, which the Examiner did not find. *Id.* at 11. PO’s Request does not address or rebut this contradiction at all. At any rate, in making its element 1[c] argument now, PO disputes that Li discloses “***the core housing being fixed to the first plug end,***” despite the Examiner finding that element was disclosed. Request at 5-6. That issue itself supports referring the Petition.

2. Petitioner Properly Cites the Interchangeable Headset Prior Art

PO continues to object to Petitioner’s citing of interchangeable audio headset prior art in the Petition to demonstrate the knowledge of the person having ordinary skill in the art. Request at 6-7. But the Board in its institution decision found nothing

² a “core housing for accommodating an earphone core . . . fixed to [a] first plug end [of an ear hook]”

improper about Petitioner's reliance on this evidence. *See, e.g.*, Paper 15 (Institution Decision) at 48-49 ("To show 'the background knowledge possessed by a person having ordinary skill in the art,' Petitioner cites documentary evidence consisting of prior art. . . . We do not understand Petitioner to propose combining the seven 'Interchangeable Audio Headset Prior Art' references with each other or with Li."). It remains uncontested that among the art not before the Examiner is all of the Petitioner's interchangeable audio headset prior art, evidencing the modular portions of headsets, including speakers, control circuits, and batteries, were well-known as of the '582 Patent's priority date. Paper 10 at 6-7. PO's only argument that this art is cumulative is that Petitioner has somehow admitted it is cumulative. Request at 6-7. Petitioner makes no such admission.

As it did in its discretionary denial briefing, PO cites a Federal Circuit decision, *ActiveVideo Networks*, but the case is inapposite. Request at 7-8. At issue in *ActiveVideo Networks* was "the expert's testimony on obviousness was essentially a conclusory statement that a person of ordinary skill in the art would have known, based on the 'modular' nature of the claimed components, how to combine **any of a number of references** to achieve the claimed inventions." *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1327 (Fed. Cir. 2012) (emphasis added). The court also found the expert's motivation to combine testimony "generic and bear[ing] **no relation to any specific combination of prior art elements.**" *Id.* at

1328 (emphasis added). The Board has made the *opposite* finding regarding the Petition here, supported by Dr. Kyriakakis's declaration, where the Petition's combinations are clearly defined: "[W]e disagree with Patent Owner that a 'lack of specificity' in the Petition warrants denial of institution because we determine Petitioner has complied with the requisite rules and the Petition demonstrates a reasonable likelihood of success. . . . Under the heading 'Statement of Precise Relief Requested,' the Petition (at page 1) provides the table of four grounds reproduced above under section II (F)." Paper 15 at 20-21. "Based on the current record and for the reasons stated by Petitioner as supported by Dr. Kyriakakis's testimony, Petitioner establishes sufficiently for purposes of institution that an ordinarily skilled artisan would have had reason to combine Liao's teachings with Li's teachings in the way Petitioner proposes." *Id.* at 34. PO does not argue against this reasoning other than accusing the Board of ignoring *ActiveVideo Networks*. Request at 7-8. But that case simply does not compare, and PO's blanket prohibition on "modular" component prior art arguments is a red herring that should be ignored.

3. Petitioner Added No New Grounds with the Kim Reference

Last, PO argues Petitioner "add[d] a new reference, Kim (EX1032), to belatedly argue that this reference teaches the specific claimed configuration." Request at 8. As with other arguments in PO's Request, this is simply not true. As PO is aware, Petitioner discusses Kim as a prior art reference that was cited by a

different Examiner when prosecuting the related '084 Patent, but was overlooked by the '582 Examiner. Paper 10 at 16-18. Nowhere does Petitioner argue Kim as part of a prior art ground in the Petition, as PO acknowledges. Rather, it is cited as one of many prior art references overlooked by the '582 Examiner in error. It is undisputed the '582 Examiner overlooked this reference. PO's attempts to somehow pin that error on Petitioner should be ignored.

II. CONCLUSION

PO's Request for Director Review should be denied. For all of the above reasons, the Acting Director's Decision Referring the Petitions to the Board and the Board's Decision on Institution were correct.

Date: December 10, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6(e) that on December 10, 2025, a true and correct copy of the PETITIONER'S AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST was served via electronic mail to the following attorneys for the Patent Owner:

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