

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONEPLUS TECHNOLOGY (SHENZHEN) CO., LTD.

Petitioner

v.

PANTECH CORPORATION

Patent Owner

IPR2025-00887

8,995,372U.S. PATENT 8,995,372

PETITIONER’S REQUEST FOR DIRECTOR REVIEW

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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. 8,995,372 (the “’372 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 ’372 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 '372 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. EX1044. 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 ’372 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, Shenzhen 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 ’372 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 ’372 patent here.

2. Clear evidence of examiner error warrants referral to the Board of the ’372 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 6-14.

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, there are two separate and distinct indicators of material error in the prosecution of the ’372 claims.

First, the USPTO has **thrice** determined the primary reference in the

Petition's four grounds (U.S. Pat. App. Pub. No. 2011/0158116 ("Tenny," EX1004)), discloses subject matter substantially similar to the claims challenged here. The '372 patent's inventors, Kibum Kwon and Myungcheul Jung, are also the named inventors of U.S. Pat. No. 9,854,545 (the "'545 patent") and its continuation U.S. Pat. No. 11,012,954 ("the '954 patent"). EX1039; EX1040. In each of IPR2023-01269 (the "'269 IPR"), Reexam. No. 90/019,704 (the "'704 Reexam"), and Reexam. No. 90/019,726 (the "'726 Reexam"), the USPTO has determined that the contents of Tenny teach the subject matter claimed by Kwon and Jung. EX1036 ('704 Reexam Order); EX1037 ('726 Reexam Order); EX1038 ('269 IPR Institution Decision).

As detailed in the Opposition, all three of the '372, '545, and '954 Patents and claims are directed towards establishing wireless communications between devices grouped based on "uplink timing information" using a "delegate" for configuration and organization, share inventors, figures, and specification descriptions, and, most critically, recite substantially similar claim limitations. *See* DD Opp. at 7-10; EX1001, 1:60-2:4; EX1039, 2:17-29; and EX1040, 2:39-53.

In each of the '269 IPR and '704 Reexam (which both challenged the '545 patent) and the '726 Reexam (which challenged the '954 patent), the USPTO has determined that the Tenny reference disclosed subject matter highly relevant to the work of Kwon and Jung. As described by the Board in instituting the '269 IPR,

“Tenny ‘relates generally to wireless communications, and more particularly to methods and apparatuses that facilitate maintaining timing synchronization for user equipment in a multicarrier Long Term Evolution Advanced (LTE-A) system.” EX1036, 14. In so doing, the Board determined that Tenny disclosed nearly every element of claim 2 of the ’545 patent, and that “Petitioner shows a reasonable likelihood of prevailing in demonstrating that claim 2 is unpatentable... .” EX1036, 21. The USPTO made similar determinations in both the ’704 and ’726 Reexams.

Accordingly, where the USPTO has already determined Tenny’s disclosures teach the subject matter taught by Kwon and Jung in *three separate decisions of related patents, involving substantially similar claims and the same prior art*, is therefore a proper and efficient use of the Board’s resources to review the patentability of challenged claims to correct the clear error in overlooking Tenny during the original prosecution.

Second, even absent the consistent, repeated findings regarding Tenny and the recited subject matter, and as described in the Opposition, the Board has identified the allowance of the shared Kwon-Jung subject matter of these related patents as attributable to material error. *See* DD Opp. at 13-14. During the ’269 IPR, the Board determined that to the extent Tenny is cumulative of the teachings in U.S. Pat. App. Pub. No. 2009/0279495 (“Yoo”), “the Office erred in a manner material to the patentability of the challenged claims by allowing the claims.” EX1038, 12.

In fact, Patent Owner itself made the argument that Tenny was cumulative over the previously considered prior art, i.e., Yoo. IPR2023-01269, Patent Owner Preliminary Response at 32 (“Tenny—and secondary references are cumulative of those previously considered by the Office...”). Accordingly, any error resulting from the purportedly cumulative subject matter of Tenny and Yoo is present in the prosecution of both the ’595 and ’372 patents.

Given Patent Owner’s own declaration of shared subject matter between Tenny and Yoo, the shared limitations detailed in the Opposition, and the Board’s ’269 determination of material error in allowing the shared subject matter over Yoo, it is clear that the Board’s determination of material error in allowing the ’545 claims over Yoo applies equally to allowing the ’372 claims over Yoo.

It is inconsistent that the patents in *Anthony*, *Eunsung*, and *Xencor*—which had been in force for longer than the challenged ’372 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 Stewart 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 Stewart 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).

/Zhiwei Zou/

Zhiwei (Wayne) Zou

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Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **Petitioner's Request for Director Review** was served on October 31, 2025, via email, as agreed to by counsel of record for the Patent Owner, at the following.

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