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Paper 25
Date: May 12, 2026

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

WILUS INSTITUTE OF STANDARDS AND TECHNOLOGY INC.,
Patent Owner.

IPR2025-00933 (Patent 11,470,595 B2)
IPR2025-00988 (Patent 10,687,281 B2)[1]

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.*

ORDER
Denying Request for Director Review

[1] This order applies to each of the above-listed proceedings.

Wilus Institute of Standards and Technology Inc. ("Patent Owner") filed requests for Director Review of the Decisions instituting *inter partes* review ("IPR") in the above-captioned cases, and Samsung Electronics Co., Ltd. ("Petitioner") filed an authorized response to each request. *See* Papers 17 ("DR Request"), 18 ("DR Response").[2]

Petitioner filed the Petitions on May 13, 2025, and May 20, 2025. In response to Patent Owner's Discretionary Denial Brief (Paper 8), Petitioner stipulated in each IPR that:

> if the PTAB institutes review in this proceeding, [Petitioner] will not pursue in District Court litigation the specific grounds asserted in inter partes review in this proceeding, or any other ground that could have been reasonably raised in this proceeding (i.e., any ground that could have been raised under §§ 102 or 103 on the basis of prior art patents or printed publications), . . . [and] if the PTAB institutes review in this proceeding, [Petitioner] will not pursue in District Court litigation combinations of the prior art asserted in this proceeding with unpublished system prior art (or any other type of prior art).

Ex. 1023. The Petitions were referred to the Board to consider the merits and non-discretionary considerations, and the Board instituted the IPRs in February 2026. *See, e.g.*, Paper 15.

After Petitioner filed its stipulation, but before the Board granted institution, Petitioner served an election of prior art (Ex. 2016) on January 6, 2026, and an expert report (*see* DR Request 3–4) on January 30, 2026, in the co-pending district court litigation. Patent Owner contends that, through those documents, Petitioner "prepared trial invalidity arguments regarding

[2] Citations are to the record in IPR2025-00933. The parties filed similar papers in IPR2025-00988.

the [challenged patents] that rest on the same prior art—art that it had promised not to use when arguing earlier against discretionary denial and for institution before the PTAB." DR Request 3–6. Patent Owner argues I should vacate institution because Petitioner made promises to the Board regarding its future conduct in the co-pending district court litigation and later broke those promises. *Id.* at 7.

Petitioner responds that, because the Board had not yet instituted these IPRs when Petitioner served its papers in district court, the conditional event of its stipulation—institution of these IPRs—had not occurred or triggered any limitation to Petitioner's invalidity options in district court. DR Response 3. Petitioner further contends that Patent Owner's Director Review request is moot because Petitioner has confirmed it will abide by its stipulation now that the Board has instituted these IPRs. *Id.* at 1–2.

I agree with Petitioner. By its terms, Petitioner's stipulation did not take effect until the Board instituted these IPRs, which occurred after Petitioner served its prior art election and expert report in the litigation. Shortly after institution, Petitioner confirmed in an email to Patent Owner and the Director that it will not pursue in district court: (1) any prior art used in any of the asserted grounds in the IPRs, or (2) combinations of the prior art asserted in these proceedings with unpublished system prior art or any other type of prior art. Ex. 3102; *see* DR Request 1 n.1 (acknowledging that Petitioner has confirmed the stipulation). Accordingly, Petitioner did not violate its stipulation and there is no basis to vacate the Decisions and deny institution.

Having reviewed the Director Review requests and responses, it is:

ORDERED that the Director Review requests are denied.

FOR PETITIONER:

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