UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS AMERICA, INC., SAMSUNG SEMICONDUCTOR, INC., and SAMSUNG AUSTIN SEMICONDUCTOR LLC,
Petitioners,

v.

W&WSENS DEVICES INC.,
Patent Owner.

Case IPR2025-00995
U.S. Patent No. 10,468,543

PATENT OWNER'S AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

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Patent Owner W&Wsens Devices, Inc. ("W&Wsens") respectfully submits this response to Petitioner's Request for Director Review (Paper 20, "DRR") of the Decision denying institution of *inter partes* review of U.S. Patent No. 10,468,543 ("the '543 Patent"). *See* Paper 17 ("DI"). The Board authorized this response on November 18, 2025. Ex. 3102.

I. INTRODUCTION

Samsung's request for review should be denied because Acting Chief Administrative Patent Judge Deshpande correctly declined to institute Samsung's Petition. The DI appropriately and holistically weighed the record, the parties' arguments, and the applicable discretionary considerations. Samsung fails to carry its burden to show that any of the limited grounds for review are applicable.

In the time since the DI issued, further developments confirm that the decision to deny institution was appropriate. Judge Gilstrap denied Samsung's Motion to Stay the District Court Action as premature (*Fintiv* factor 1), such that there is no likelihood of a stay halting the progression of that case. *See W&Wsens Devices, Inc. v. Samsung Elecs. Co.,* No. 24-cv-00854-JRG, Dkt. No. 90 (E.D. Tex. Nov. 3, 2025). And, the Director denied institution of two of Samsung's other IPR petitions challenging W&Wsens' family of patents, further negating any possibility that IPR proceedings would materially narrow the validity issues that will need to be decided in the District Court Action. *See Samsung v. W&Wsens Devices, Inc.*, No. IPR2025-

00993, Paper 14 (Director Nov. 20, 2025); No. IPR2025-00994, Paper 14 (Director Nov. 20, 2025). Thus, there is no basis to revisit the decision to deny institution on Samsung's Petition.

II. SAMSUNG FAILS TO MEET THE STANDARD FOR DIRECTOR REVIEW

Requests for Director Review ("DRR") of a decision made in PTAB proceedings are limited to decisions that present "(a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law." 37 C.F.R. § 42.75; *see also* Director Review Process webpage, § 2(B).[1] Samsung fails to show that any of these errors are present in the DI.

III. THE DI WEIGHED THE DISCRETIONARY DENIAL FACTORS

The DI holistically weighed the parties' arguments on discretionary denial and, in the end, determined that key, undisputed facts regarding timing and settled expectations support denial, notwithstanding Samsung's limited proposed stipulation. DI at 2 (denying institution "[a]fter considering the parties' arguments and the record," "in view of all relevant considerations," and "based on the totality of the evidence and arguments the parties have presented"). Samsung's

[1] Available at: https://www.uspto.gov/patents/ptab/decisions/director-review-process.

disagreement with the Acting Chief Administrative Judge's ultimate weighing of these factors is not a valid basis for Director review.

Samsung does not identify any factual errors in the DI's determination that the *Fintiv* factors "favor[ed] discretionary denial" because "it is unlikely that a final written decision in these proceedings will issue before the district court trial occurs, resulting in significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions." DI at 2. Nor does Samsung dispute that the patent has been in force for "approximately six years" and "there was evidence demonstrating [Samsung] was aware of the challenged patents as early as 2020." *Id*.

Rather than dispute the factual findings that the DI found most relevant to exercising discretion to deny institution, Samsung argues that the DI should have weighed the various factors differently, which is not a valid basis for requesting Director Review. DRR at 2 (asserting that its stipulation should have been given more weight). Samsung's proposed stipulation fell well short of the kind of broad stipulation that would represent a "true alternative" to district court litigation—a result of Samsung's tactical decision to try to have its cake and eat it too by seeking IPR while also seeking to preserve a wide range of backup invalidity arguments to present in the District Court Action. Samsung's stipulation is narrower than the Director's stipulation proposed in the October 17, 2025, Notice of Proposed Rulemaking ("NPRM"), which provides that the petitioners "will not raise grounds

of invalidity or unpatentability with respect to the challenged patent under 35 U.S.C. 102 or 103 in any other proceeding." NPRM at 22. Samsung's stipulation is inadequate for reasons identified in the Director's rationales in the Notice of Proposed Rulemaking. For example, Samsung could "still [] bring repetitive challenges based on slightly rebranded evidence." *Id*. at 5 (cleaned up).[2]

For these reasons, Samsung's stipulation would not simplify the District Court Action because Samsung could "substitute[] a new invalidity theory in district court for the ones it may be estopped from raising in district court." *Id*. at 6. Samsung's stipulation does not significantly reduce overlap or present a true alternative to the validity portion of the District Court Action. As W&Wsens noted in its Request for Discretionary Denial, "Samsung's stipulation seeks to exploit the loophole recognized by the Federal Circuit, without meaningfully narrowing its invalidity grounds in the District Court action." Paper 10 ("Req. DD") at 17-18 (citing *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367 (Fed. Cir. 2025) (recognizing that IPR estoppel does not preclude a petitioner from relying on a prior art system "with related printed publications at trial to prove the claimed invention was known or used by others, on sale, or in public use")). The Acting Chief Administrative Patent Judge correctly took this into account in deciding to deny

[2] Available at https://public-inspection.federalregister.gov/2025-19580.pdf.

institution and did not clearly err in doing so, which is dispositive of Samsung's DRR.

IV. SAMSUNG'S REMAINING *FINTIV* ARGUMENTS ARE INCOMPLETE AND INACCURATE

The DRR should be denied because it does not identify any factual or legal error in the DI's weighing of the *Fintiv* factors. DRR at 3-4. Far from it, the DRR is riddled with its own omissions and errors.

Samsung's omission of *Fintiv* Factor 1 in its own analysis is alone sufficient reason to deny this DRR. *Id.* at 3 (mentioning only *Fintiv* factors three, six, four, two and five). Factor 1 asks the critical question of whether the district court is likely to stay the parallel proceeding. *Apple Inc. v. Fintiv*, Inc., No. IPR2020-00019, Paper 11 at 6-9 (P.T.A.B. Mar. 20, 2020) (precedential). If the district court is unlikely to stay the case, the risk remains for duplication of efforts and inconsistent decisions. *Id*. at 6. Samsung chose to not even address this factor in its request, which is a tacit admission of how heavily this factor weighs against institution.

Samsung offers no response to the DI's factual findings regarding the low probability of a stay. And that low probability was recently confirmed when Judge Gilstrap denied Samsung's motion to stay the District Court Action. Req. DD at 10-12; *W&Wsens Devices, Inc. v. Samsung Elecs. Co.,* No. 24-cv-00854-JRG, Dkt. No. 90 (E.D. Tex. Nov. 3, 2025).

Samsung also objects to the DI's explanation of "how it weighed the *Fintiv* factors" (DRR at 3), but Samsung's reliance on *CommScope Techs. LLC v. Dali Wireless, Inc.*, No. IPR2022-01242, Paper 23 at 5 (P.T.A.B. Feb. 27, 2023) (precedential) is misplaced. In *CommScope*, Director Vidal faulted the Board for (1) failing to explain why the Petition presented "compelling merits" and (2) using the "compelling merits" analysis to entirely disregard *Fintiv* Factors 1-5. *CommScope*, Paper 23 at 4-5. Neither of those facts are present here because the compelling merits standard is no longer binding, and because the DI did address the *Fintiv* factors in this case.[3]

Samsung protests that the DI "failed to discuss" its stipulation (*Fintiv* factor 4), but that does not mean the Acting Chief Administrative Patent Judge did not

[3] The decision in *CommScope* addressed the Board's decision-making pursuant to a defunct procedure. *CommScope*, Paper 23 at 2-5, n.1 (citing the rescinded June 21, 2022, Guidance Memo, formerly available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf); *see also* "USPTO rescinds memorandum addressing discretionary denial procedures," published February 28, 2025, *available at* https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures.

consider it. DI at 3 (explaining "[a]lthough certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on a holistic assessment of ***all of the evidence and arguments presented***") (emphasis added); DRR at 2. *CommScope* does not suggest that the Director must expressly discuss every piece of evidence and argument, it requires that the Board "provide reasoning sufficient to allow the parties to challenge that finding and sufficient to allow for review of the Board's decision." *CommScope*, Paper 23 at 5. Samsung does not and cannot argue that the DI fails to meet this standard (or that it necessarily applies in situations where, as here, the Board did not issue the decision in questions).

Regarding the DI's handling of time-to-trial statistics, Samsung's argument is without merit. DRR at 3-4 (arguing "quoting that entire span is incorrect"); DI at 2 (finding "time-to-trial statistics suggest trial could begin between August 2026 and early December 2026"). Even if Samsung was correct that the trial date "will slip, on average, by about four months," (DRR at 4), a four-month delay would only push the scheduled August 3, 2026, trial date to around ***early December*** 2026, which still occurs before the projected final written decision due date of December 24, 2026. And even if the trial date was pushed, as Samsung forecasts, to "mak[e] the trial date about the same as the final written decision date," the Office has previously found that such differences in timing are "not significant." DRR at 4; *Samsung Elecs. Co. v. VB Assets, LLC*, No. IPR2025-00870, Paper 11 at 2 (Deshpande Oct. 10, 2025)

("*VB Assets*") ("Although the time-to-trial statistics suggest that it is possible that a trial might occur before the projected final written decision due date, the difference in timing is not significant.").

The facts and scenario in *VB Assets* are nearly identical to this case. There, the Acting Chief Administrative Patent Judge denied institution because the projected final written decision due date was five months (December 10, 2026) after the district court's scheduled trial date (July 6, 2026), and the parties offered different time-to-trial statistics suggesting that trial will begin between June 2026 and December 2026. The Acting Chief Administrative Patent Judge reasoned that "even though a district court trial date that occurs after a projected final written decision date reduces the possibility of conflicting decisions, that benefit does not outweigh the efficiencies gained by avoiding parallel proceedings under these circumstances." *VB Assets*, Paper 11 at 2. The same timeframe and analysis apply equally here, where the DI correctly found that discretionary denial was appropriate to avoid "significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions." DI at 2.

V. THE OFFICE'S CONSIDERATION OF SETTLED EXPECTATIONS IS CONSISTENT WITH PRECEDENT AND THE APA

Samsung fails to show any error in the DI's analysis of settled expectations.

First, Samsung makes the internally inconsistent claim that there is a "*de facto* rule" that "improperly elevated the patent's age above all other considerations." DRR at 1. Samsung then protests that the DI did not follow the Director's previous decisions for patents that have been in force for the same amount of time, citing cases where IPR petitioners for patents of similar age were referred to the Board. *Id.* at 7. The fact that in cases involving patents of the same age the institution decisions vary ***confirms*** that there is no rigid rule about timing and that institution decisions are being made on the totality of the circumstances. *Id.* at 5.

Accordingly, the challenged patent's age is but one of several considerations weighed "based on a holistic assessment of all of the evidence and arguments presented," including evidence demonstrating a petitioner's longstanding notice of the challenged patents. DI at 2-3. In fact, Samsung's briefing cites a decision that weighed the age of challenged patents (which were in force for over Samsung's alleged "time-based bar") against considerations under 35 U.S.C. § 325(d) and ultimately instituted *inter partes* review. *Anthony Inc. v. ControlTec, LLC*, No. IPR2025-00559, Paper 12 at 2 (Acting Director July 16, 2025) (referring to panel

despite the challenged patents at issue being in force at least 17 years); DRR at 8 (citing *Anthony*). There is no time-based bar.

Second, the Acting Chief Administrative Patent Judge did not base his decision on the age of W&Wsens' patent alone. Rather, he also weighed W&Wsens' "evidence demonstrating Petitioner was aware of the challenged patents as early as 2020," which distinguished the "prior decisions from the Director" cited by Samsung. DI at 2 (citing Ex. 2001; Ex. 2002; Ex. 2003; Ex. 2004); DRR at 7 (citing *Cambridge Indus. USA, Inc. v. Applied Optoelecs., Inc.*, No. IPR2025-00434, Paper 11 at 2-3 (Director June 26, 2025); *Berkshire Hathaway Energy Co. v. Birchtech Corp.,* No. IPR2025-00274, Paper 23 at 2-3 (Director July 2, 2025)). For example, in *Cambridge Indus. USA, Inc., Inc.*, the patent owner only pointed to the challenged patents' ages, and there was no evidence of petitioner's longstanding knowledge of the challenged patents, or other factors. *See* No. IPR2025-00434, Paper 8 (PO's Req. DD) at 24; *see also Berkshire Hathaway*, Paper 15 (PO's Req. DD) at 10-11 (similar).

Samsung does not dispute the DI's factual findings that Samsung was aware and on notice of the challenged patents for a long period of time. DI at 2; *see contra* DRR at 5-6, n.2. The DI's finding of settled expectations in the challenged patents is consistent with the Office's prior decisions and guidance. *See Yangtze Memory Techs. Co. v. Micron Tech., Inc.*, No. IPR2025-00500, Paper 10 at 2 (Deshpande

Aug. 14, 2025) (finding "strong settled expectations" for challenged patent "in force for ***approximately*** . . . ***six years***") (emphasis added).

Third, Samsung incorrectly contends that the DI "conflicts" with the Federal Circuit's determination in *Celgene Corp. v. Peter*. DRR at 5-6 (citing 931 F.3d 1342 (Fed. Cir. 2019)). Samsung misreads *Celgene* as holding that a "patent owner lacked an expectation that its patent would not be subject to IPR." *Id.* at 5. Not so. *Celgene*'s holding was that a patent owner of a ***pre-AIA*** patent did not have an expectation that its patent would not be subject to an *inter partes* review proceeding (that did not exist when the patent at issue was granted). *Celgene,* 931 F.3d at 1361-63. *Celgene* did ***not*** hold that a ***petitioner*** has any expectation to be able to challenge any particular patent in an IPR. The Director retains broad authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314(a); *Cuozzo Speed Techs., LLC v. Lee,* 579 U.S. 261, 273 (2016) (the Director's "decision to deny a petition is a matter committed to the Patent Office's discretion"); *Mylan Lab'ys Ltd. v. Janssen Pharmaceutica, N.V.,* 989 F.3d 1375, 1382 (Fed. Cir. 2021) ("The Director is permitted, but never compelled, to institute an IPR. And no petitioner has a right to such institution."). Thus, there was no clear error in the Acting Chief Administrative Patent Judge's findings of settled expectations for W&Wsens.

VI. THE DECISION DID NOT OVERLOOK SAMSUNG'S ALLEGATIONS OF MATERIAL ERROR

Samsung's Director Review Request now argues its prior allegations of material error "outweighs all other factors." DRR at 7-9. At the outset, Samsung fails to show or even allege that this issue of the DI was (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law, and therefore Director Review of this issue is not warranted. Director Review Process § 2(B). Thus, Samsung does not even make a prima facie case for Director Review.

Moreover, the DI correctly found that Samsung's allegations of material error did not weigh against discretionary denial. *See generally* DI at 2. Though the Acting Chief Administrative Patent Judge did not specifically dismiss Samsung's allegations in the DI, he gave the issue an appropriate level of attention, going so far as to authorize additional briefing on that precise issue of examination error. Ex. 3101 at 1 (authorizing a Patent Owner reply and Petitioner sur-reply "to address alleged errors that occurred during examination of the subject patents").

W&Wsens showed in its Reply on Discretionary Denial that there was no error during prosecution of the '543 Patent because its claims were already different from the claims of its parents when the patent application was amended to achieve

allowance, and because the Examiner pointed to limitations found only in the '543 Patent in its Notice of Allowance. *See* Paper 14 ("PO Reply") at 1-2.

Also, as previously argued, Samsung's material error argument is irrelevant to the petitioned grounds because W&Wsens raised no § 325(d) argument in this case. *See* PO Reply at 3 (arguing the asserted reference Kuboi "is far less relevant to the claimed invention than the prior art considered during examination"). Samsung's Request for Director Review fails to show any error in law or inconsistency with prior decisions because every case Samsung cites involves 35 U.S.C. § 325(d). DRR at 8; *see Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH*, No. IPR2025-00318, Paper 9 at 2 (Director June 12, 2025) (finding the petitioner "provides persuasive reasoning, supported by evidence, that discretionary denial under 35 U.S.C. § 325(d) is not appropriate"); *Tesla, Inc. v. Charge Fusion Techs., LLC*, No. IPR2025-00152, Paper 11 at 2 (Director June 12, 2025) (same); *Eunsung Glob. Corp. v. HydraFacial LLC*, No. IPR2025-00445, Paper 14 at 2 (Director July 10, 2025) ("reviewing Patent Owner's arguments under 35 U.S.C. § 325(d)"); *Anthony*, Paper 12 at 2 (similar). Thus, there is no basis for Director review relating to alleged error in prosecution.

VII. CONCLUSION

The Acting Chief Administrative Patent Judge correctly determined discretionary denial of institution was appropriate for this IPR. DI at 2. For at least

the reasons above, Director Review of the Decision denying institution is not warranted and Samsung's request should be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), and pursuant to agreement by the parties that filing with the Board through the Patent Trial and Appeal Case Tracking System (P-TACTS) constitutes electronic service, that service was made on Petitioner as detailed below.

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