

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 No. IPR2025-00996
U.S. Patent No. 10,446,700

**PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

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I. INTRODUCTION

The Director should reject Patent Owner W&WSens Devices Inc.’s (“W&W”) request for discretionary denial (Paper 10, “DD Req.”). First, the Office materially erred when granting the ’700 Patent. During prosecution, the applicant amended the claims to recite “said reverse-bias electrodes being free of a pattern of openings that matches said holes.” The Examiner allowed the claims, relying on this amendment. But the Examiner overlooked that the claimed electrodes may simply be solid electrodes as was well known in the art. IPR is therefore required to correct the Office’s error.

Second, the parties’ settled expectations weigh against denial. W&W sent a handful of unsolicited communications in 2019-2020 related to merger/acquisition (“M&A”) requests. Petitioners had an expectation of non-enforcement based on the nature of the communications. Regardless, all but one of the patents that Petitioners challenge—including the ’700 Patent—did not exist at the time of the first communications six years ago. The Director routinely declines to deny institution for such young patents. The Director should refer this case and the others for institution not only because the patents are young, but also because the Board is best suited to address their complex semiconductor technology.

Third, the *Fintiv* factors, on balance, weigh against denial. There is evidence that a stay is likely upon institution. The median time-to-trial and trial judge’s

specific time-to-trial place trial slightly before the last possible final written decision (“FWD”) date. However, the Board typically issues institution and FWDs early, putting the Board’s resolution at or slightly before trial.

II. INSTITUTION IS REQUIRED TO CORRECT MATERIAL ERRORS AND IS AN APPROPRIATE USE OF THE OFFICE’S RESOURCES

During prosecution, the Office allowed the claims of the ’700 Patent only after the Applicant “proposed amendments to overcome the prior art” to amend the sole independent claim to add the language “said reverse-bias electrodes being free of a pattern of openings that matches said holes.” Ex. 1003, 123-124, 126. The Examiner’s Reasons for Allowance relied on this amendment when allowing the ’700 Patent’s claims:

Regarding claim 1, the prior art teaches a similar microstructure enhanced photodetector device, but fails to disclose the specific characteristic recited in the claims of the instant invention e.g. the single chip device ... *in conjunction with the details of the electrodes do not have the pattern of openings.*

Ex. 1003, 124 (bold italics added).

But the Office erred. The Examiner’s focus on whether the “proposed amendments ... overcome the prior art of Okamoto” (Ex. 1003, 126) was too narrowly focused and failed to recognize that such limitations can be met by simply not having holes in a transparent electrode layer, as in *Kuboi*. Petition 51. Petitioners’

expert explains this (Ex. 1002, ¶¶148-149) and the Examiner did not have the benefit of this teaching or explanation. The Director has denied discretionary denial when the Petition and corresponding expert testimony further explains the allowable element. *See Anthony Inc. v. ControlTec, LLC*, IPR2025-00559, Paper 12 at 2 (Director July 16, 2025); *id.*, Paper 9 at 16-17; *Xencor, Inc., v. Merus N.V.*, IPR2025-00604, Paper 12 at 3 (Director June 17, 2025) (referring to Board where challenged patent issued nine years ago, finding material error where petitioner's prior art references taught the specific claim limitation on which the examiner relied for allowance). W&W's DD Request has not disputed the substance of the petition, including that *Kuboi* teaches the claim element that the Examiner relied on as novel over the prior art. *See Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11 at 2-3 (Director June 12, 2025) (referring to Board where petitioner showed that prior art in petition established missing element of claims and Patent Owner did not dispute that reference taught missing element); *infra* § IV.F.1 (strength of merits).

III. SETTLED EXPECTATIONS SUPPORT REFERRAL

The “settled expectations” of the parties weigh against denial because (1) W&W admits that it has not previously licensed, enforced, or commercialized the '700 Patent; and (2) Petitioners' products were on the market years before the '700 Patent and other patents issued.

A. The Ages of the '700 Patent and Other Challenged Patents Favor Referral, Not Denial

W&W argues that it has “strong settled expectations” in the '700 Patent based on the age of the '700 Patent and other challenged patents, alleged “notice of the '700 Patent” to Samsung, and supposed investments in the “inventions of the '700 Patent.” DD Req. 3-9. None withstand scrutiny.

1. The Ages of the '700 Patent and Other Challenged Patents Do Not Favor Denial; They Instead Favor Referral

The '700 Patent issued October 15, 2019, six years and nine days before the expected discretionary denial decision date. The Director has found that such patents “have not been in force for a significant period of time ..., and, accordingly, Patent Owner has not developed strong settled expectations,” which weighs against denial. *See, e.g., Cambridge Indus. USA, Inc. v. Applied Optoelects., Inc.*, IPR2025-00434, Paper 11 at 2-3 (Director June 26, 2025) (patent that issued in 2019 (6 years and 22 days before DD decision date) “ha[d] not developed strong settled expectations”); *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 2-3 (Director July 2, 2025) (same for patents that “issued in 2019 and 2020”).

Half of the challenged patents issued less than three years ago, and do not have settled expectations. The '360 Patent issued April 2023 (IPR2025-00994), the '871 Patent issued September 2024 (IPR2025-00993), and the '948 Patent issued March 2025 (PGR2025-00082). The '543 Patent (issued in November 2019, less

than six years ago; IPR2025-00995) does not have strong settled expectations for the same reason as the '700 Patent, explained above. These weigh against denial.

Although W&W argues that U.S. Patent No. 9,525,084 (IPR2025-00997) “issued close to nine years ago” (DD Req. 4-5), this still does not favor denial. In *Embody, Inc. v. LifeNet Health*, IPR2025-00248, Paper 13 at 2-3 (Director June 26, 2025), the Director found that one patent “issued in 2022” did not have settled expectations and “the other patent [issued in 2018] is a parent of the first [2022 patent].” The Director concluded that “Patent Owner has not developed strong settled expectations that favor discretionary denial as to the first [2022] patent, and it *is an efficient use of Board resources to address the related patent.*” *Id.* (emphases added). As in *Embody*, the slightly older '084 Patent cannot overcome the lack of settled expectations for the other five related patents, three of which issued in 2023 or later (after the determinative patent in *Embody*).

The case W&W cites (*iCashe*) is inapposite. DD Req. 5. There, the petitioner challenged seven patents, five of which issued between 2013 and 2016, while two patents issued in March 2022 and July 2023. Even though the two younger patents “ordinarily ... might counsel against discretionary denial,” the Director denied institution because, in part, it would be an “inefficient use of Board resources” to review two patents while the district court considers the other five patents (which issued nearly nine or more than nine years ago). *Samsung Elecs. Co. v. iCashe, Inc.*,

IPR2025-00639, Paper 11 at 2-3 (Director Aug. 14, 2025). This case is different. Here, half (3) of the challenged patents issued in 2023-2025 (like in *Embody*), two patents are just under or at 6 years old, and only one patent issued earlier (but still after each of the five older patents in *iCashe*). These differences counsel against discretionary denial, as in *Embody*.

2. W&W's Alleged "Notice" Fails

W&W's handful of unsolicited LinkedIn messages (Exs. 2001-2004) do not show Petitioners had notice of the '700 Patent. DD Req. 5-6.

W&W alleges that it "continued to" communicate with "four executives at Samsung" in 2019-2020 for "over a year." DD Req. 6. It did not and its brief communications weigh against discretionary denial. W&W stopped communicating with Mr. Schuessler in April 2019. *See* Ex. 2001. Mr. Deane explained that he was "no longer directly linked with Samsung VC funds," and there is no evidence that anyone at Petitioners received any communications from him. Ex. 2003, 6. Exhibits 2002-2003 also show there were no communications between April 2019 and August 2019 or between August 2019 and February 2020.

As to the alleged April 2019 presentation (Ex. 2020), there is no indication that it was opened by any recipient. Mr. Deane stated he was not affiliated with Samsung. Ex. 2003, 6. Mr. Ting responded that he "[doesn't] open unsolicited presentations." Ex. 2004, 4. Mr. Schuessler referred the message to others without

comment. Ex. 2001, 4. Mr. Charles may have passed it on, but there is no indication that he opened the presentation. Ex. 2002, 4. Moreover, the two February 2020 emails appended to Exhibits 2002 and 2003 were sent to ***non-Samsung*** email addresses, making it unclear whether they were even received or opened by the recipients, let alone made it to Petitioners (or that the email addresses are correct). Ex. 2002, 9; Ex. 2003, 13.

Even taking W&W's representations as true, Petitioners had no expectation of being sued. W&W admits that it "has not offered for sale or sold any product that embodies any claim of any of the Asserted Patents, nor has it licensed the Asserted Patents to any third party" (Ex. 2011, Compl. ¶36), which weighs against denial. *See, e.g., Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12 at 2-3 (Director June 26, 2025) (explaining that "a patent may have been in force for years but ***may not have been commercialized, asserted, marked, licensed, or otherwise applied in a petitioner's particular technology space, if at all***" may "***weigh against a patent owner's claim of settled expectations***" (emphases added)); *cf. Home Depot U.S.A., Inc. v. H2 Intellect LLC*, IPR2025-00480, Paper 11 at 2-3 (Director Sep. 4, 2025) (expectation that patents would not be asserted against petitioner weighed against discretionary denial). Nor has W&W asserted any challenged patent in any previous litigation, which also weighs against denial. Ex. 1081; *see Intel v. Proxense*, IPR2025-00327, Paper 12 at 2-3; *Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc.*,

IPR2025-00438, Paper 10 at 3 (Director July 17, 2025) (finding lack of commercialization, assertion, marking, or licensing “weighs against Patent Owner’s claim of strong settled expectations” even though patent “ha[d] been in force for approximately 10 years”).

W&W’s evidence also shows that *all* communications were for the purpose of “engaging in M&A discussions” and referred the recipients to a broker at “Bank of America Merrill Lynch” for M&A discussions. Ex. 2001, 2; Ex. 2002, 2; Ex. 2003, 1-2; Ex. 2004, 2. None of these communications ever suggested enforcement, that Samsung used W&W’s technology, or that Samsung infringed any patent.

Petitioners, by contrast, had strong expectations that they would not be sued based on the M&A communications, outweighing any expectations of W&W. For example, Samsung released many of the now-accused sensor features in 2014-2018. Samsung released the earliest of these before any challenged patent was filed and the latter of these before four patents were filed and before all but one patent issued. *See* Ex. 1084; Ex. 2011, Compl. ¶49 (accusing sensors in Ex. 1084); Exs. 1085-1086. If W&W truly believed Samsung infringed, it should have said so earlier. Discretionary denial is therefore not appropriate where, as here, the circumstances of the communications—related to M&A talks, funding, or sale through a broker—led Petitioners to “not expect enforcement” of the patents. *Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11 at 3 (Director Sep. 5, 2025); *see also Intel v. Proxense*,

IPR2025-00327, Paper 12 at 2-3.

W&W argues that Petitioners should have challenged the '700 Patent in 2019 or 2020 because W&W requested M&A talks. DD Req. 5-7. This is disingenuous. For companies, such as startups, patents and IP protection improve the chances of venture capital investment and future acquisition. Expecting recipients of their partnership/M&A requests to respond with IPR or PGR challenges would harm patent owners, especially smaller entities, by clouding patent portfolios for 18 months of IPR proceedings, and could chill the M&A market. It would also result in high costs—although less than litigation—for these companies, diverting needed funds away from their business. It makes no sense for W&W to argue that Petitioners should have hindered W&W's "process of selling the company." Ex. 2003, 7. Good-faith M&A requests that did not progress, with no suggestion or history of enforcement, should weigh against denial to avoid chilling the business ecosystem or burdening patent owners. *See Apple v. Allani*, IPR2025-00856, Paper 11 at 3 (communications leading the petitioner to expect non-enforcement weighed against discretionary denial).

W&W also cannot claim that it did not expect IPR challenges, regardless of the length of time in force. All challenged patents, including the '700 Patent, are AIA patents, which W&W knew at filing could potentially be subject to IPRs during litigation. Both the Federal Circuit and Supreme Court have recognized that a

patent's age does not create settled expectations against a validity challenge. Indeed, IPR proceedings “serve the purpose of correcting prior agency error of issuing patents that should not have issued in the first place,” like reexaminations have “for nearly four decades.” *Celgene Corp. v. Peter*, 931 F.3d 1342, 1360-63 (Fed. Cir. 2019); *see also Genentech, Inc. v. Hospira, Inc.*, 946 F.3d 1333, 1343 (Fed. Cir. 2020); *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 360 (2018) (finding that IPR was created “[t]o remedy” patents that should not have issued). Moreover, W&W's ability to seek injunctions on improperly issued patents, as it has here, is exacerbated by the passage of time. Ex. 2011, 105.

3. Citations to Related Applications Do Not Provide Notice of the '700 Patent

W&W also argues “constructive notice” of the '700 Patent because the USPTO cited “*applications related to* the '700 Patent”—but not the application or published application of the '700 Patent or the '700 Patent itself—during prosecution of Samsung patents. DD Req. 7 (emphasis added). Courts have expressly rejected what W&W now argues. As Judge Gilstrap explained: “Saying you knew about the family is not too far a step from saying you knew there was this PTO in Virginia, and you should just go check everything there and see if anything there applies. It's too nebulous.” *See Intell. Ventures I LLC v. T-Mobile USA, Inc.*, Hearing Tr. 61:2-9, No. 2:17-cv-00577-JRG, Dkt. 297 (E.D. Tex. Jan. 3, 2019).

Moreover, the cases W&W cites (*Dabico* and *iRhythm*) do not show otherwise. DD Req. 7-8. *Dabico* mentions searchable USPTO systems, but never suggests that this alone creates notice. And, in *iRhythm*, the petitioner cited the “then-pending application *that issued as the challenged patent*” in an IDS. *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 3 (Director June 6, 2025) (emphasis added). But the application that became the ’700 Patent was not cited and, as explained above, courts reject the theory that knowledge of a family member provides knowledge of the entire family. Moreover, the application for the ’700 Patent is a continuation-in-part of the application W&W alleges provides “notice,” but there is no allegation that all of the subject matter of the ’700 Patent’s claims exist in the parent CIP.

4. W&W’s Alleged “Investment” Does Not Create Settled Expectations

W&W’s alleged “investment, time, and resources dedicated to research, development, [and] trials” does not favor denial. DD Req. 8-9. W&W identifies only alleged conception in April 2013, then over a year later “fabricat[ing] proof of concept” in June 2014, then nothing until November 2024 to “conduct[] computer simulations.” *Id.* None of these activities show meaningful investment or development. The Director in *Amgen* required “an extraordinary amount of investment” that “correlates to settled expectations.” *Amgen Inc. v. Bristol-Myers*

Squibb Co., IPR2025-00601, Paper 9 at 2-3 (Director July 24, 2025). W&W’s minimal activities are the “absence of such information” that *Amgen* rejected. *Id.*

B. Samsung’s Settled Expectations Outweigh Any Expectations of W&W

Even if W&W could prove that it has settled expectations—it does not—Petitioners had no reason to anticipate assertion of the ’700 Patent, as explained above, because the circumstances related to M&A discussions being referred to a broker and W&W admits that it “has not offered for sale or sold any product that embodies any claim of any of the Asserted Patents, nor has it licensed the Asserted Patents to any third party” (Ex. 2011, Compl. ¶36), which weighs against denial. *See Apple v. Allani*, IPR2025-00856, Paper 11 at 3; *cf. Globus Med., Inc. v. Spinelogik, Inc.*, IPR2025-00225, Paper 8 at 2 (Director June 12, 2025) (referring to merits panel when petitioner showed it did not expect enforcement); *Intel v. Proxense*, IPR2025-00327, Paper 12 at 2-3; *Home Depot*, IPR2025-00480, Paper 11 at 2-3.

IV. THE *FINTIV* FACTORS SUPPORT REFERRAL

The Director should not deny the Petition under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential) (“*Fintiv*”), because, holistically, Factors 1, 3, 4, and 6 weigh against denying institution, and Factor 2 should weigh against denying institution or, at worst, be neutral. Factor 5 should be neutral or, at worst, weigh slightly in favor of denial.

A. Factor 1: The Trial Court Is Likely to Grant a Post-Institution Motion to Stay

Factor 1 weighs against denial. W&W argues that “Judge Gilstrap is highly unlikely to stay the District Court Action.” DD Req. 10. This is wrong because “evidence exists that [a stay] may be granted if [this] proceeding is instituted”—i.e., post-institution.¹ *Fintiv*, IPR2020-00019, Paper 11 at 5-6.

Judge Gilstrap frequently grants post-institution stays at similar case stages, providing objective “evidence ... that [a stay] may be granted if [this] proceeding is instituted.” *Id.* at 5-7; *see also Twitch Interactive, Inc. v. Razdog Holdings LLC*, IPR2025-00307, Paper 18 at 2-3 (Director May 16, 2025) (referring to Board and noting petitioner’s evidence showing likelihood of post-institution stay). Where, as here, the *Markman* hearing will be well after the institution decision date, Judge Gilstrap has frequently stayed cases after institution, including in cases that were much closer to trial than this one. *See, e.g., Resonant Sys., Inc. v. Samsung Elecs. Co.*, No. 2:22-CV-00423-JRG, 2024 WL 1021023, at *2-4 (E.D. Tex. Mar. 8, 2024)

¹ W&W cites pre-institution denials granted without prejudice to renew (DD Req. 10-12), which actually weigh ***against*** discretionary denial. *See Fintiv*, IPR2020-00019, Paper 11 at 6-7 (denial without prejudice “has usually weighed against exercising authority to deny institution under *NHK*”).

(Gilstrap, J.) (granting stay with institution seven months before trial; FWD five months after trial); *Commc'n Techs., Inc. v. Samsung Elecs. Am., Inc.*, No. 2:21-CV-00444-JRG, 2023 WL 1478447, at *3 (E.D. Tex. Feb. 2, 2023) (Gilstrap, J.) (same); *Broadphone LLC v. Samsung Elecs. Co.*, No. 2:23-CV-00001-JRG-RSP, 2024 WL 3524022, at *2-3 (E.D. Tex. July 24, 2024) (Gilstrap, J.) (granting stay with institution nine months before trial; FWD three months after trial); *Harbor Island Dynamic, LLC v. Samsung Elecs. Co.*, No. 2:24-CV-00140-JRG-RSP, Dkt. 81, at 4 (E.D. Tex. May 19, 2025) (granting post-institution stay with eight months before trial).

General Access Solutions, Ltd. v. Cellco P'ship, No. 2:22-cv-00394-JRG, Dkt. 225, at 3-4 (E.D. Tex. May 22, 2024), does not support W&W's position because it had five months between institution and trial, unlike the minimum of nine months here.

B. Factor 2: Trial Statistics and Objective Evidence Show the FWD Will Likely Issue Around or Before Trial

Factor 2 should weigh slightly against denial or, at worst, is neutral. Although trial is currently set to begin August 3, 2026, both the official time-to-trial statistics and data on the presiding judge show that the date will slip, on average, by about four months, making the trial date about the same as the final written decision date.

W&W incorrectly alleges that “[t]he median time-to-trial in the Eastern

District of Texas is 21.9 months.” DD Req. 13. Rather, the median time-to-trial statistics show **25.1 months** between filing and trial, at or less than one month before the last possible FWD. Ex. 1077, 35; *see Google LLC v. BrodTi Inc.*, IPR2025-00472, Paper 19 at 2 (Deshpande, C.J., June 25, 2025) (considering median time-to-trial).

For the particular judge, 13 of the 14 patent trials in the last year (93%) have been delayed by, on average, 4 months, with a median time-to-trial of 25.5 months. Ex. 1078. The likelihood of delay is confirmed because Judge Gilstrap has 8 trials scheduled for August 3, and 29 trials scheduled for August 2026. *See* Ex. 1079. Average delay would place trial in early December 2026, only a couple weeks before the last possible statutory FWD date. The Board also issues institution decisions about two weeks (on average) before the deadline, eliminating any expected difference between trial and the last possible FWD date. Ex. 1082. If the Board also issues the FWD early, it would precede the median time-to-trial date.

Moreover, in determining the most efficient resolution, the USPTO should account for the time when the forum will issue an ***appealable*** final judgment. For the Board, that is the FWD. But the district court issues a post-trial final judgment on average 9 months after trial. Ex. 1080. Thus, the Board will enter a final, appealable decision on patentability between 5 months (current trial date) and 9 months (median time-to-trial date) ***before*** the district court, making the Board the most expeditious forum to resolve patentability.

Factor 2 should be, at worst, neutral.

C. Factor 3: Samsung Was Diligent and Little Investment in the District Court Has Occurred

The Director has often considered the dates of a *Markman* hearing, close of fact discovery, and close of expert discovery relative to institution in weighing Factor 3. *See, e.g., Google LLC v. Truesight Commc'ns LLC*, IPR2025-00024, Paper 12 at 2 (Deshpande, C.J., June 25, 2025); *Am. Airlines, Inc. v. Intell. Ventures I LLC*, IPR2025-00785, Paper 11 at 3 (Director Aug. 29, 2025) (finding “little investment” under Factor 3 when *Markman* is scheduled after institution decision; *see id.*, Paper 7, Opposition, at 11 (Aug. 11, 2025)). Here, all of those dates will occur **after** the institution decision. Ex. 1083. At the last possible institution date, the parties will have exchanged contentions among themselves, exchanged proposed claim constructions, Plaintiff will have narrowed its asserted claims (which is negligible effort as it is selecting from contentions already exchanged), and Plaintiff may have filed its opening claim construction brief. *Id.* But the bulk of the case—including Petitioners’ responsive claim construction brief; W&W’s reply claim construction brief; Petitioners’ election of prior art; *Markman* hearing; mediation (if sought); the bulk and completion of fact discovery; all expert reports; expert discovery, including depositions; dispositive motions, responses, and replies thereto; pretrial motions, such as motions *in limine*; trial; and post-trial briefing—will remain. *Id.*

Next Caller, Inc. v. TRUSTID, Inc., IPR2019-00961, Paper 10 at 16 (Oct. 16, 2019), bears no resemblance to this proceeding. DD Req. 15. In *Next Caller*, the relevant delay finding was due to the six months ***between petition filings using the same prior art*** (Oct. 2018 and Apr. 2019), with the latter being a full year after the amended complaint was filed, and 15 months after the original complaint.

D. Factor 4: Petitioners’ Broad Stipulation Eliminates Any and All Overlap Between Proceedings

W&W argues that “‘the same or substantially the same claims, grounds, arguments, and evidence’ ... are at issue in the parallel District Court Action.” DD Req. 15-18. That is false. There can be no dispute that, if instituted, Petitioners’ stipulation removes all overlapping arguments from the district court.

Petitioners’ stipulation includes a *Sotera* stipulation ***and further stipulates*** away any ground that includes references named in the Petition’s grounds (i.e., *Kuboi*), even in combination with system art.² See Paper 9. This stipulation exceeds that which was found to overcome a FWD trailing the expected trial date by about two months. See *Tesla, Inc. v. Intell. Ventures II LLC*, IPR2025-00217, Paper 9 at 2 (Director June 13, 2025); *Tesla, Inc. v. United States*, IPR2025-00341, Paper 12 at

² W&W’s citation to *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367 (Fed. Cir. 2025), is misplaced for this reason. DD Req. 17-18.

2 (Director June 13, 2025). There is no dispute that an institution decision will be rendered before trial. As that time, if the Board institutes, Petitioners’ stipulation removes all overlap between proceedings.

W&W misleadingly argues that “253 patents and published publications, 139 non-patent publications, and 11 products” are listed in Petitioners’ invalidity contentions and that Petitioners will raise *Kuboi* in the litigation as a “loophole.” DD Req. 17-18 (emphases removed). If instituted, grounds D5-D8 for the ’700 Patent (DD Req. 15-17) will have only *eight* total references, with seven being systems that cannot be raised in IPR. None are overlapping, or include, *Kuboi*.

E. Factor 5: The Parties Are the Same

The parties in the parallel litigation are the same, which recent decisions have also indicated is either neutral or only slightly favors denial. *See Innolux Corp. v. Phenix Longhorn LLC*, IPR2025-00043, Paper 10 at 13 (May 15, 2025).

F. Factor 6³: Strong Merits Show the Office Erred by Overlooking the Conventionality of the Alleged Point of Novelty

1. The Petition’s Strong Merits Weigh Against Denial

The Petition has strong merits and is needed to correct the Office’s material error. *See supra* § II. W&W does not identify any weakness in the Petition’s grounds, which favors not denying institution. *E.g., Samsung Elecs. Co. v. SiOnyx, LLC*,

³ W&W’s Factor 6 analysis refers to Section III.C. Petitioners address both here.

IPR2024-01431, Paper 21 at 17 (Apr. 10, 2025) (granting institution when “Patent Owner provides very little argument, on the merits ...”).

W&W’s arguments about Dr. Lebby’s testimony are conclusory and do not support denial. DD Req. 19. His declaration is determined by the length of the claims, not *Kuboi*. He provides extensive quotes and annotated figures from *Kuboi* in his analysis, none of which W&W challenges. He does not “fill in” gaps—there are none.

2. The Board Is Best Suited to Handle the Complex Technology Here

The ’700 Patent and other challenged patents present uniquely complicated facts that make the PTAB the best forum to decide their validity. The ’700 Patent and other challenged patents have specifications ranging from 80 to 200 pages describing complex semiconductor technology, and claim priority to extensive numbers of related applications. The priority chains of the ’543, ’871, ’948, ’700, and ’360 Patents include multiple continuation-in-part applications, making any priority analyses complex. The Board is best equipped to address the technology and any priority issues that arise from the complex webs of applications. *Tesla v. United States*, IPR2025-00341, Paper 12 at 2-3 (“complex and diverse litigation proceeding[s]” favor institution where “the Board is better suited” to review the patents); *Tesla v. Intell. Ventures II*, IPR2025-00217, Paper 9 at 2-3 (same).

W&W argues that a “battle of the experts is better resolved in the District Court Action.” DD Req. 20. Not true. Trial time is limited and shared with other complex issues like non-infringement and damages. These IPRs allow individualized, focused briefing for each patent to address nuanced technological differences. Parties invariably have competing experts in any post-grant proceeding and W&W’s argument that that weighs in favor of the district court cannot be true. Indeed, W&W essentially (and incorrectly) argues that post-grant proceedings should never proceed with competing experts. Ultimately, the Board is best suited to understand technological issues and probe questions at oral hearing for each patent.

V. CONCLUSION

Petitioners respectfully request that the Director decline to exercise discretion to deny institution and request referral of this Petition to the merits panel.

Date: September 24, 2025

Respectfully submitted,

/ Joshua L. Goldberg /
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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioners' Opposition to Patent Owner's Request for Discretionary Denial of Institution** was served on September 24, 2025, via email directed to counsel of record for the Patent Owner at the following:

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