

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' REQUEST FOR DIRECTOR REVIEW

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	ARGUMENT	2
A.	The DI Relied on Erroneous Findings of Facts and Conclusions of Law When Balancing the <i>Fintiv</i> Factors	2
1.	The DI Failed to Discuss Petitioners’ Broad Stipulation That Significantly Reduces the Overlap Between the District Court and the IPR.....	2
2.	The <i>Fintiv</i> Factors, When Properly Weighed, Warrant Referring the Petition for Consideration of the Merits.....	3
B.	The DI Goes Beyond the PTO’s Authority by Creating a New Time Bar.....	5
C.	The Decision Improperly Weighed Purported Settled Expectations over the USPTO’s Material Errors During Prosecution	7
III.	CONCLUSION.....	9

TABLE OF AUTHORITIES

	Page(s)
Federal Cases	
<i>Anthony Inc. v. ControlTec, LLC</i> , IPR2025-00559, Paper 12 (Director July 16, 2025).....	8
<i>Berkshire Hathaway Energy Co. v. Birchtech Corp.</i> , IPR2025-00274, Paper 23 (Director July 2, 2025).....	7
<i>Cambridge Indus. USA, Inc. v. Applied Optoelects., Inc.</i> , IPR2025-00434, Paper 11 (Director June 26, 2025)	7
<i>Celgene Corp. v. Peter</i> , 931 F.3d 1342 (Fed. Cir. 2019)	5, 6
<i>CommScope Techs. LLC v. Dali Wireless, Inc.</i> , IPR2022-01242, Paper 23 (Feb. 27, 2023)	3
<i>Eunsung Glob. Corp. v. HydraFacial LLC</i> , IPR2025-00445, Paper 14 (Director July 10, 2025).....	8
<i>Microsoft Corp. v. Partec Cluster Competence Ctr. GMBH</i> , IPR2025-00318, Paper 9 (Director June 12, 2025)	8
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (Dec. 1, 2020)	2, 3
<i>Tesla, Inc. v. Charge Fusion Techs., LLC</i> , IPR2025-00152, Paper 11 (Director June 12, 2025)	8
Federal Statutes	
5 U.S.C. § 706(2)(A).....	5, 6, 7
5 U.S.C. § 706(2)(C).....	7
35 U.S.C. § 311(c)(1).....	6

I. INTRODUCTION

The Director should vacate the decision denying institution (Paper 17, “DI”) by the Acting Chief Administrative Patent Judge and refer this IPR for consideration on the merits. The DI discretionarily denied the petition based on a finding that “it is unlikely that a final written decision in these proceedings will issue before the district court trial occurs.” DI at 2. But the DI improperly ignored evidence suggesting otherwise, including the trial judge’s schedule of and median time-to-trial statistics. Moreover, the DI did not even acknowledge, let alone consider, the broad stipulation that Petitioners provided that is even more comprehensive than the stipulation in *Sotera*. The *Fintiv* factors, when properly weighed, favor referral.

The DI also found that the challenged patent has “been in force for approximately six years, creating settled expectations for Patent Owner.” *Id.* But the DI (1) contradicts the Director who has previously found patents that have been in force for the same amount of time did not create settled expectations and (2) improperly elevated the patent’s age above all other considerations, effectively creating a *de facto* rule that the Board will not consider petitions for IPR of patents older than a certain age. These represent clear errors of law and abuse of discretion. Director Review is necessary to correct these errors and to provide guidance on the proper balance of factors in future cases.

II. ARGUMENT

A. The DI Relied on Erroneous Findings of Facts and Conclusions of Law When Balancing the *Fintiv* Factors

The DI denied institution based on ongoing parallel litigation between the parties and, in doing so, failed to properly credit Petitioners' broad stipulation that minimizes overlap between the district court and the IPR. This led to an improper balancing of the *Fintiv* factors. Properly weighed, the *Fintiv* factors favor referral.

1. The DI Failed to Discuss Petitioners' Broad Stipulation That Significantly Reduces the Overlap Between the District Court and the IPR

Under binding precedent, *Fintiv* factor four “weighs strongly in favor of not exercising discretion to deny institution” where a petitioner stipulates not to raise any ground raised or that reasonably could have been raised in the parallel proceeding if the Board institutes IPR. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (Dec. 1, 2020) (Precedential as to § II.A) (“*Sotera*”). Petitioners provided that stipulation and more, also agreeing to give up any grounds that include references named in the petition's grounds and “any patent or printed publication that is cited in the petition as evidence of features of any devices that are used as primary or secondary references in any invalidity combination.” Paper 9 at 1-2. While the DI states that it considered “the parties' arguments and the record,” it failed to discuss Petitioners' stipulation that eliminates overlap between issues raised in the petition and in the parallel proceeding. DI at 2;

Paper 9. In view of this stipulation, *Fintiv* factor four weighs even more strongly in favor of institution than it did in *Sotera*. See *Sotera* at 18-19.

2. The *Fintiv* Factors, When Properly Weighed, Warrant Referring the Petition for Consideration of the Merits

Weighing the *Fintiv* factors together, the Director should vacate the DI and decline to discretionarily deny institution. At a minimum, *Fintiv* factors three and six weigh against denial, and factor four weighs strongly against denial. Only *Fintiv* factors two and five potentially favor denial, and at most, only slightly. Petitioners' broad stipulation, diligence in filing the petition, and strong merits mean this IPR should be referred for an institution decision.

The DI did not properly explain how it weighed the *Fintiv* factors. Aside from the errors regarding *Fintiv* factor four addressed above, the DI did not address the other factors. But this is not the required "reasoning sufficient to allow the parties to challenge" a finding that the *Fintiv* factors favor denial and "sufficient to allow for review of the Board's decision." *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 5 (Feb. 27, 2023) (Precedential).

That leaves only the DI's finding about trial. The DI references the scheduled trial date but does not address the evidence that Judge Gilstrap has several matters scheduled to start trial on the same day (eight different trials as of September 2025). Ex. 1079. The DI found that "time-to-trial statistics suggest trial could begin between

August 2026 and early December 2026.” DI at 2 (citations omitted). But quoting that entire span is incorrect. Both the official time-to-trial statistics and data on the presiding judge show that the current August 2026 trial date will slip, on average, by about four months, making the trial date about the same as the final written decision date.¹ Paper 11 at 14-15 (citations omitted). The evidence thus indicates that the trial date is unlikely to hold, diminishing the weight given to factor two.

Weighed together, the *Fintiv* factors weigh against discretionary denial. The evidence shows uncertainty about whether trial will move forward as scheduled. In contrast, the litigation has a long way to go and a lot of work remaining before the parties reach trial, and Petitioners’ broad stipulation confirms that institution will significantly reduce overlap. The Director should let the petition proceed to a determination on the merits.

¹ Indeed, as Petitioners explained in opposition to W&W’s discretionary denial request, the Board issues institution decisions about two weeks (on average) before the deadline, eliminating any expected difference between trial and the last possible FWD date. Paper 11 at 15 (citing Ex. 1082). If the Board also issues the FWD early, it would precede the median time-to-trial date. *Id.*

B. The DI Goes Beyond the PTO’s Authority by Creating a New Time Bar

The DI’s finding of settled expectations because the challenged patent has been in force for six years creates a de facto time-based bar. This time-based bar is “not in accordance with law” and cannot provide an APA-compliant basis for denying institution. 5 U.S.C. § 706(2)(A). In *Celgene Corp. v. Peter*, the Federal Circuit—at the PTO’s behest—explicitly rejected a patentee’s contention that it had an expectation that its pre-AIA patents would not be subject to IPR, a proceeding that did not exist when its patents issued. 931 F.3d 1342, 1357-63 (Fed. Cir. 2019). As the Federal Circuit explained, “the expectation that patent owners have had for nearly four decades” is “that patents are open to PTO reconsideration and possible cancelation.” *Id.* at 1361-62. The *Celgene* patent owner knew its patents were subject to potential reconsideration by the PTO during the patents’ term, so it had no reasonable expectations to the contrary.

Just as the *Celgene* patent owner lacked an expectation that its patent would not be subject to IPR, so too did W&Wsens. The DI’s finding of settled expectations conflicts with *Celgene*,² and such an unlawful finding cannot be the basis for

² The DI further noted that “Patent Owner provides evidence demonstrating Petitioner was aware of the challenged patents as early as 2020.” DI at 2 (citations

denying institution. 5 U.S.C. § 706(2)(A). Notably, principles of judicial estoppel preclude the PTO from arguing otherwise, as it was the PTO that successfully convinced the Federal Circuit to find that the *Celgene* patentee lacked an expectation of immunity from IPR. *See Celgene*, 931 F.3d at 1358 (“[T]he PTO argues that Celgene’s takings claim fails because patents have been subject to reconsideration and cancellation by the USPTO in administrative proceedings for nearly four decades, and Celgene’s own patent[s were] issued subject to this administrative revocation authority.” (quotation omitted)).

The DI’s reliance on alleged “settled expectations” also exceeds the PTO’s authority under the AIA, which explicitly sets forth only one issue-date-based limit on when a patent can be challenged in an IPR: that an IPR cannot be filed within the first nine months after the AIA patent was granted. 35 U.S.C. § 311(c)(1). Congress knew how to limit what patents are subject to IPR based on their issuance date, and Congress’s decision to bar IPRs only during the first nine months of a patent’s term means that Congress did not intend to impose any other term-based restrictions on

omitted). But the DI’s finding of settled expectations is unlawful irrespective of this finding because alleged knowledge of the patent cannot reasonably be said to alone undermine Patent Owner’s “expectation ... that patents are open to PTO reconsideration and possible cancelation.” *Celgene*, 931 F.3d at 1361-62.

IPRs. The DI's reliance on a Patent Owner's (non-existent) "settled expectations" as a basis for denying institution effectively immunizes an entire generation of patents that Congress intended to be subject to IPR. The decision improperly exceeds the PTO's statutory authority and is arbitrary and capricious. 5 U.S.C. § 706(2)(A), (C).

Finally, the DI's finding of settled expectations directly contradicts prior decisions from the Director. In the decision, the Acting Chief Administrative Patent Judge found that the '700 Patent has "been in force for approximately six years, creating settled expectations for Patent Owner"—"further favor[ing] discretionary denial." DI at 2. While being in force for 6 years and 2 days is "approximately six years," the Acting Chief Administrative Patent Judge failed to follow the Director's guidance in *Cambridge Indus. USA, Inc. v. Applied Optoelects., Inc.*, IPR2025-00434, Paper 11 at 2-3 (Director June 26, 2025), and *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23 at 2-3 (Director July 2, 2025), where the Director found that the patent owners "ha[d] not developed strong settled expectations that favor discretionary denial" when the challenged patents-at-issue had been in force for 6 years and 22 days and 5 years and 11 months, respectively.

C. The Decision Improperly Weighed Purported Settled Expectations over the USPTO's Material Errors During Prosecution

Whatever weight the patent's age and related expectations deserve (none in Petitioner's view), the DI still should have declined to discretionarily deny in light

of the material errors committed during prosecution of the patent. Paper 11 at 2-3.

The Director has consistently found that material error during examination outweighs all other factors. *See Microsoft Corp. v. Partec Cluster Competence Ctr. GMBH*, IPR2025-00318, Paper 9 at 3 (Director June 12, 2025) (finding “it is an appropriate use of Office resources to review the potential error,” and reasoning this error required review, even though the parties had a trial date “preced[ing] the date projected for a Board final written decision”); *Eunsung Glob. Corp. v. HydraFacial LLC*, IPR2025-00445, Paper 14 at 2-3 (Director July 10, 2025) (finding “Petitioner provides persuasive reasoning” that denial is not appropriate “due to a material error in examination,” even though the challenged patent “issued in 2017, and this would ordinarily favor denying institution”); *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11 at 2 (Director June 12, 2025) (referring and finding the “[p]etitioner provides persuasive evidence that the Office erred in a manner material to the patentability of the challenged claims by overlooking the teachings of [a prosecution reference]”); *Anthony Inc. v. ControlTec, LLC*, IPR2025-00559, Paper 12 at 2 (Director July 16, 2025) (referring and finding showing of material error favored referring to panel for both seventeen and eighteen-year-old patents).

Petitioners’ brief in opposition to the request for discretionary denial explained how the Patent Office materially erred when allowing the ’700 Patent because the issued claims (1) are substantively the same as claims already rejected

during the prosecution of its parent patent and (2) omit the limitation that allowed the parent patent to achieve allowance. *See* Paper 11 at 2-3. This case presents similar material errors to those the Director has found warrant referral. Regardless of whether the other factors would typically weigh in favor of denial, the material errors committed during prosecution suggest that the challenged claims should not have been granted in the first place. Therefore, the material errors warrant referral.

III. CONCLUSION

For the foregoing reasons, Petitioners respectfully request that the Director vacate the DI and refer the petition for consideration on the merits.

Date: November 17, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioners' Request for Director Review** was served on November 17, 2025, via email directed to counsel of record for the Patent Owner at the following:

Date: November 17, 2025

Respectfully submitted,

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