UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

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

Case No. IPR2025-01069
U.S. Patent No. 10,313,077

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW OF INSTITUTION DECISION

APPLE 1127 Apple Inc. v. HBCU
IPR2026-00107

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I. Introduction

Patent Owner respectfully requests Director Review of the October 10, 2025 Decision Referring Petitions to the Board (Paper 11) and the December 10, 2025 Decision Granting Institution of *Inter Partes* Review (Paper 16). For the reasons stated below, Patent Owner believes that the Director erred in overlooking Patent Owner's strong settled expectations in the '077 and in concluding that Patent Owner's district court litigations were directed to a diverse range of subject matter. All of Patent Owner's patents challenged by Samsung cover inventions specifically about the format, structure, and information in Wi-Fi packets. Moreover, the Board misapprehended the record and improperly overlooked Petitioners inconsistent positions concerning indefiniteness between district court and this IPR. Patent Owner thus respectfully requests that the Director grant Director review and that he deny institution of *inter partes* review.

II. Legal Standard

Director review of a Board decision on institution is warranted when the request presents "(a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law." Director Review Process, Section 2.B (available at https://www.uspto.gov/patents/ptab/decisions/director-review-process, last

accessed March 26, 2025). The present request addresses erroneous findings of fact and law.

III. The Office Improperly Overlooked the Patent Owner's Settled Expectations in the '077 Patent

The decision on discretionary denial stated that "the challenged patents have not been in force for a significant period of time . . . , and, accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial as to these patents." Paper 11 at 3. However, the '077 patent issued on June 4, 2019. Ex. 1001 at 1. Accordingly, the patent had already been in force for six years before the IPR petition was filed and was in force for more than six and a half years when IPR was instituted. Under similar circumstances, the Director has consistently found that a patent owner had strong settled expectations in the validity of its patent, and nothing identified in the decision on discretionary denial was sufficient to justify disturbing these settled expectations.

IV. The Determination That the IPRs Concern a "Diverse Range of Subject Matter" Was Erroneous

In the decision referring the petition in this and other IPRs brought by Samsung to the Board, the Acting Chief Administrative Patent Judge correctly found that "it is unlikely that a final written decision in these proceedings will issue before the district court trial occurs, and there is insufficient evidence

the district court is likely to stay its proceeding even if the Board were to institute trial." Paper 11 at 2. Nonetheless, the IPRs were referred to the Board for three reasons: (1) a lack of settled expectations, (2) the purported "large number and wide scope of the patents asserted in the district court litigation," and (3) purported material error by the Office during prosecution. *Id.* at 3. Notably, neither the first nor the third factor applies to the '077 patent. As noted above, Patent Owner *does* have strong settled expectations in the '077. As to the third factor, while the decision identified purported errors during prosecution with respect to some of the patents challenged by Samsung, it did not identify any such errors in the prosecution of the '077 patent. *Id.* at 3–4. Accordingly, the second factor was the sole factor identified that could justify referring this IPR to the Board. Wilus respectfully submits that this factor was decided in error, based upon misleading representations by Samsung that Wilus was not afforded an opportunity to rebut.

Contrary to Samsung's arguments, the IPRs Samsung has brought against Wilus do not present the "diverse range of subject matter" at issue in *Tesla, Inc. v. Intellectual Ventures II LLC*, Case No. IPR2025-00217, Paper 9 (P.T.A.B. June 13, 2025), or *Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, Case No. IPR2025-00438, Paper 10 (P.T.A.B. July 17, 2025). In *Tesla*, the patents covered topics across a range including target recognition, vehicle

guidance, cameras, and wireless networking. *Tesla*, IPR2025-00217, Paper 8 at 6. These are fundamentally different technology areas, from different fields of art and covering distinct types of accused products. In *Shenzhen*, the patents ranged from remote control of a 3-D printer using video images, to heated build platforms for 3-D printers, to detection of 3-D printing material characteristics. *Shenzhen*, IPR2025-00438, Paper 9 at 8–9. Again, these patents are from different fields of endeavor: from computer vision on the one hand to mechanical engineering on the other.

The Wilus patents that Samsung is challenging, by contrast, all relate to features of the 802.11ax standard that improve efficiency and performance of wireless communications in congested spectrum, as Samsung's own briefing recognizes. *See* Paper 9 at 7–8. The related subject matter can be seen from the overlapping prior art in these petitions, including the various versions of 802.11 standards that are relied upon as purported prior art. For example, IPR2025-00934 asserts the draft 802.11ax_D1.0 standard, alone or in combination against all claims. (IPR2025-00934, Paper 2 at 32–60, Ex. 1004). IPR2025-00935 and -00936 each assert the Lee patent application directed to 802.11 WLANs, along with a proposed draft of the 802.11ax specification (IPR2025-00935, Paper 2 at 1–2, Ex. 1005 at [0002]-[0004], Ex. 1006; IPR2025-00936, Paper 2 at 1–2, Ex. 1005 at [0002]-[0004], Ex. 1006).

IPR2025-01043 and -01044 each assert the Zhou patent application directed to 802.11 WLANs. (IPR2025-01043, Paper 2 at 1–3, Ex. 1004 at [0014]; IPR2025-01044, Paper 2 at 1–3, Ex. 1004 at [0014]). IPR2025-00933 and -00988 each assert the Josiam patent application directed to 802.11ax WLANs. (IPR2025-00933, Paper 2 at 1–2, Ex. 1005 at [0003]; IPR2025-00988, Paper 2 at 1–3, Ex. 1014 at [0003]). Likewise, IPR2025-01069 asserts the Bharadwaj patent application directed to 802.11ax WLANs. (IPR2025-01069, Paper 2 at 1–2, Ex. 1006 at [0002]–[0005]).

The fact that all eight of these patents are alleged to be rendered obvious by versions of the 802.11ax standard or patents that are directed to improvements that very same standard refutes any argument that the situation here is comparable to those in *Tesla* or *Shenzhen*. If the mere assertion of patents from different families that are all directed to the same wireless communications standard is sufficient to meet the "diverse range of subject matter" factor from *Tesla* and *Shenzhen*, then the factor is almost meaningless. This finding from the discretionary denial decision should be reversed.

V. Institution Should Be Denied Due to Petitioner's Inconsistent Positions as to Indefiniteness Before the PTAB and in District Court

In district court litigation, Samsung contended that all claims of the '077 patent are indefinite. See Ex. 2018, at p. 3 (9/18/2025 claim construction

statement providing Samsung's positions on indefiniteness for the '077 patent claims). Samsung continued to maintain these positions, and so on November 4, Wilus filed its claim construction brief in district court responding to those indefiniteness positions. *See* Ex. 2019 (Patent Owner's opening claim construction brief). This was no small matter—Patent Owner used seven of its allotted 30 pages to address Samsung's indefiniteness arguments against the '077 patent. *See id.* at 9-15.

After the PTAB issued and simultaneously designated the *Revvo* and *Tesla* decisions on November 3 and November 5 respectively, Patent Owner requested authorization to file a supplemental brief to address the impact of Samsung's inconsistent claim construction positions. *See Tesla, Inc. v. Intellectual Ventures II LLC*, Case No. IPR2025-00340, Paper 18 at 4 (P.T.A.B. Nov. 5, 2025) (informative); *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, Case No. IPR2025-00632, Paper 20 at 4–5 (P.T.A.B. Nov. 3, 2025) (precedential).

Perhaps recognizing that it risked soon being penalized for its inconsistent claim construction positions, Samsung reversed course. On November 11, Samsung "withdrew" its "contentions as to indefiniteness for the claim terms of the '077 patent." Ex. 2020, at 1 (11/11/2025 email from Samsung's litigation counsel to Wilus's counsel). This was a transparent

attempt by Samsung to defuse the impact of its gamesmanship on the discretionary denial decision, after it already obtained material benefits in district court litigation in forcing Wilus to use nearly a third of its claim construction brief to address those withdrawn arguments.

In its reply to Wilus's supplemental brief on the inconsistent claim construction position issue, Samsung disingenuously suggests that its change of heart on indefiniteness was part of an ongoing process "to narrow the dispute" in district court, as opposed to a naked attempt to avoid being penalized by the Board. Paper 15 at 1–2. What Wilus pointed out in its supplemental brief—and what Samsung cannot deny—is that immediately prior to the designation of *Tesla* and *Revvo* its position in a formal filing to the district court was that every claim of the '077 patent is indefinite, a position that cannot be squared with its obviousness theories in this IPR. *See* Ex. 2018 at 3. Samsung seeks to be excused from this gamesmanship because in earlier preliminary exchanges between the parties in district court, it had proposed even more terms within the same claims were indefinite. Paper 15 at 1–2 (citing Ex. 2013, an August 27, 2025 email from Petitioner's district court counsel). But in both its August 27 email and its September 25 filing with the district court, Samsung's position was that every claim of the '077 patent was indefinite. It is in no way exculpatory that the August 27 email advanced more

reasons that the claims were indefinite than Samsung chose to pursue in its September 25 submission.

The relevant timeline for Samsung's shift in position is as follows:

- September 25 – in a joint filing to the district court, Samsung informed the court that it was asking the court to find that every claim of the '077 patent was indefinite (Ex. 2018 at 3)
- November 4 – Wilus submitted its opening claim construction brief, addressing Samsung's indefiniteness theories (Ex. 2019)
- November 10 – counsel for Wilus emailed the Board at 10:35 am, Eastern Time, requesting supplemental briefing in this and other IPRs concerning Samsung's indefiniteness positions, in view of *Revvo* and *Tesla*
- November 11 – district court counsel for Samsung emailed counsel for Wilus informing them that Samsung was withdrawing all of its indefiniteness contentions for the '077 patent (Ex. 2020)
- November 18 – Samsung filed its responsive claim construction brief in district court (Ex. 1126)

For Samsung to suggest that its decision to drop its indefiniteness theories one day after Wilus sought supplemental briefing on the issue was

simply part of a process of narrowing disputes, rather than a direct response to Wilus's briefing request is not credible and appears to be inconsistent with Samsung's obligations of candor to the Board. The logical times for Samsung to have narrowed claim construction issues in district court would have been prior to Wilus's November 4 opening brief or simultaneously with Samsung's November 18 responsive brief. There is no reason or benefit in the district court case to have withdrawn indefiniteness positions exactly halfway between the two claim construction briefs. The only plausible explanation for the timing of Samsung's withdrawal is that it was a response to the *Revvo* and *Tesla* decisions and to Wilus's November 10 email to the Board.

In its institution decision, the Board accepted Samsung's erroneous characterizations of its change in position, referring to the "parties hav[ing] narrowed the claim construction disputes." Paper 16 at 7. The Board also incorrectly concluded that "the record does not show inconsistent claim construction positions that warrant denial under PTAB precedent." *Id.* As explained above, the record clearly shows that Samsung formally took indefiniteness positions in filings to the district court that were inconsistent with its IPR petition. (Ex. 2018 at 3). The record also clearly shows that Samsung maintained such inconsistent positions until *after* the Director issued

and designated the decisions in *Tesla* and *Revvo*. (Ex. 2020). Under each of those decisions, the Petition should be denied institution.

VI. Conclusion

For the foregoing reasons, Wilus respectfully requests that the Director grant Director Review and deny institution of this IPR.

Dated: December 24, 2025 */Neil A. Rubin/*

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CERTIFICATE OF SERVICE

I hereby certify that "Patent Owner's Request for Director Review of Institution Decision" was served on December 24, 2025 by email sent to:

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