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Paper 21
Date: July 22, 2025

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.

HEADWATER RESEARCH LLC,
Patent Owner.

IPR2024-01396 (Patent 9,647,918 B2)
IPR2024-01407 (Patent 9,179,359 B2)[1]

Before MICHELLE N. ANKENBRAND,[2] *Senior Lead Administrative Patent Judge*, *performing the duties of Director Review Executive*.

ORDER
Granting Director Review, Vacating the Decisions Granting Institution, and Denying Institution of *Inter Partes* Review

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[1] This order applies to each to each of the above-listed proceedings. Unless otherwise indicated, all citations are to the record in IPR2024-01396.
[2] Coke Morgan Stewart, Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office, is recused and took no part in these decisions. The Acting Director delegated her authority as set forth in the Notice of Delegation entered in this case. *See* Paper 16.

GOOGLE EXHIBIT 1046
GOOGLE v. HEADWATER
IPR2026-00138

Headwater Research LLC ("Patent Owner") filed a request for Director Review of the Decision granting institution (Paper 13) in each of the above-captioned cases and Samsung Electronics Co. Ltd. ("Petitioner") filed an authorized response to each request. *See* Paper 15 ("DR Request"), Paper 17.

In each request, Patent Owner argues that the Board erred in its analysis of *Fintiv*[3] factors 1–4 and 6— whether the court in the parallel proceeding granted a stay or evidence exists that one may be granted, proximity of the trial date in the parallel proceeding to the projected deadline for a final written decision, investment in the parallel proceeding, overlap between issues raised in the petition and the parallel proceeding, and the strength of the petition's merits, respectively. *See* DR Request 1–15; IPR2024-01407 Paper 11, 1–15. In relevant part, Patent Owner argues that even if the Board's factor 6 analysis is correct regarding the strength of the petition's merits, the other factors taken as a whole supported discretionary denial. *See* DR Request 8.

Petitioner argues in response that it had requested a stay in the parallel proceeding, the trial date in the date in the parallel proceeding is speculative, no claim construction briefing in the parallel proceeding had taken place before the patent owner preliminary response, Petitioner had filed a *Sotera*[4] stipulation and does not plan to combine prior art at issue here with system art in the parallel proceeding if institution is maintained, and that the Board properly found the merits to be strong. *See* Paper 17, 1–5.

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[3] *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential).
[4] *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A).

In IPR2024-01396, the Board instituted trial, in part based on a finding that Petitioner had made a particularly strong showing on the merits. *See* Paper 13, 9. One administrative patent judge on the panel dissented, reasoning that the panel majority did not give sufficient weight to the trial date in the parallel proceeding being scheduled for approximately six months before the date of the final written decision. *Id.* at 1–2 (Howard, APJ, dissenting).

The dissent has the better position—the Board erred in its weighing of factor 2. The trial date in the parallel proceeding is set for approximately six months before the final written decision. Under *Fintiv*'s holistic assessment, the merits of the Petition here do not outweigh the other factors. An analysis of all the circumstances indicates that the efficiency and integrity of the system are best served by denying institution. Similarly, the trial date in the parallel proceeding on the patent challenged in IPR2024-01407 is set for approximately five months before the Board's final written decision. Thus, for the same reasons, the Board erred in its weighing of factor 2 and institution is denied.

Accordingly, it is:

ORDERED that Director Review is granted;

FURTHER ORDERED that the Board's Decisions granting institution of *inter partes* review (Paper 13; IPR2024-01407, Paper 9) are vacated; and

FURTHER ORDERED that the petitions are *denied*, and no trial is instituted.

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