

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KANGXI COMMUNICATION TECHNOLOGIES (SHANGHAI) CO., LTD.
Petitioner,

v.

SKYWORKS SOLUTIONS, INC.
Patent Owner.

Case No. IPR2025-00373
U.S. Patent No. 8,717,101

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Order No. 33 in Inv. No. 337-TA-1413 (Hearing Date)
2002	Order No. 20 in Inv. No. 337-TA-1413 (Scheduling Order)
2003	Complaint in 8:34-cv-00974-FWS-ADS (C.D.C.A)
2004	Complaint in Inv. No. 337-TA-1413
2005	Redacted Opening Expert Report of David Ricketts Regarding the Invalidity of U.S. Patent Nos. 8,717,101 and 9,917,563
2006	Redacted Rebuttal Expert Report of David Wentzloff Regarding the Validity of U.S. Patent Nos. 8,717,101 and 9,917,563
2007	Order Granting Defendants' Unopposed Motion for Automatic Stay Under 28 U.S.C. §1659(A)
2008	Excerpts from File History for U.S. Patent No. 9,917,563
2009	U.S. Patent No. 7,869,775 to Alon ("Alon")
2010	Amended Appendix A - Invalidity Contentions for U.S. Patent No. 8,717,101 based on Ishimaru
2011	U.S. Patent No. 8,692,619 to Wakita ("Wakita")
2012	U.S. Patent No. 9,917,563 ("563 patent")
2013	RESERVED
2014	RESERVED
2015	RESERVED
2016	Excerpts of Gray et al., Analysis and Design of Analog Integrated Circuits (5th ed. 2009)
2017	Excerpts of Roland E. Thomas et al., The Analysis & Design of Linear Circuits, (7th ed. 2012)
2018	ADI HMC7748 Datasheet
2019	RESERVED
2020	RESERVED
2021	RESERVED

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2022	Excerpts of Steven M. Kaplan, "Electrical and Electronics Engineering Dictionary" (2004)
2023	RESERVED
2024	RESERVED
2025	Excerpts of Behzad Razavi, Design of analog CMOS integrated circuits (2nd ed. 2015)

I. INTRODUCTION

The Director should affirm the Director's Decision Denying Institution of *Inter Partes* Review. Petitioner's realization late in the trial of the parallel proceeding¹ that its prior art theories should be withdrawn, if anything, only **confirms** the Director's findings that the *Fintiv* factors and Patent Owner's settled expectations overwhelmingly support denying institution. Petitioner's late withdrawal (1) cannot undo the substantial investment of judicial and party resources already made in the parallel proceeding, (2) does not prevent the potential for duplicative findings given Petitioner is still pursuing invalidity under other grounds in the parallel proceeding, (3) confirms the weakness of the Petition grounds given Petitioner elected to withdraw them in favor of other invalidity defenses, and (4) corroborates Patent Owner's settled expectations that its patent is novel and nonobvious.

II. THE *FINTIV* FACTORS FAVOR DISCRETIONARY DENIAL

Petitioner argues that, because it realized in the very last days of trial in the Parallel ITC Investigation—**after** fact and expert discovery had been completed, **after** the Administrative Law Judge (“ALJ”) had expended significant judicial

¹ Certain Wireless Front-End Modules, Devices Containing the same, and Components Thereof, Inv. No. 337-TA-1413 (ITC) (July 17, 2024) (“Parallel ITC Investigation”).

resources on these issues, including at *Markman* and in pre-hearing briefing, and *after* Skyworks had rested its case-in-chief—that its prior art invalidity grounds were no longer worth pursuing, that it is now somehow appropriate to consume *Board* resources conducting *inter partes* review of the same grounds that Petitioner had fully worked up and then abandoned before the ALJ. But Petitioner offers no valid justification for consuming yet *more* public resources on its weak prior art grounds. Indeed, as shown below, Petitioner fails to identify *any Fintiv* factor that no longer favors discretionary denial; nor could it do so.

A. *Fintiv* Factors 1, 2, and 5 remain unchanged, weighing in favor of discretionary denial

There have been no changes in the schedule for, nor the parties involved in, the Parallel ITC Investigation. As such, Petitioner's decision to abandon its prior art invalidity grounds late in the ITC trial has *no* impact on *Fintiv* factor 1 (whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted), factor 2 (proximity of the court's trial date to the Board's projected statutory deadline for a final written decision), or factor 5 (whether the petitioner and the defendant in the parallel proceeding are the same party).

B. *Fintiv* Factor 3 weighs in favor of discretionary denial

If anything, Petitioner's expenditure of substantial resources by pursuing its prior art invalidity grounds throughout fact discovery, expert discovery, *Markman*,

prehearing briefing, and the majority of the ITC trial, only to abandon those grounds *after* Skyworks rested its case-in-chief, *exacerbates* the concerns over conserving judicial and party resources that animate *Fintiv* factor 3. Petitioner informed Patent Owner of its abandonment on July 13, 2025, four days after the start of the hearing on July 9, 2025 and after having delivered an opening statement that featured its prior art invalidity grounds. In particular, by July 14, 2025, when Petitioner informed the ALJ of its abandonment, all of the following events (with correspondingly substantial investments of judicial and party resources) had already occurred:

1. Petitioner's Preliminary Invalidity Contentions (Oct. 22, 2024)
2. Patent Owner's Preliminary Validity Contentions (Nov. 9, 2024)
3. Patent Owner's Claim Construction Brief (Dec. 23, 2024)
4. Petitioner's Claim Construction Brief (Dec. 23, 2024)
5. Claim Construction Hearing (Jan. 23, 2025)
6. Petitioner's Final Invalidity Contentions (Feb. 19, 2025)
7. Patent Owner's Final Validity Contentions (Feb. 19, 2025)
8. Completion of Fact Discovery (Feb. 19, 2025)
9. Petitioner's Invalidity Expert Report (Feb. 28, 2025)
10. Patent Owner's Validity Expert Report (Mar. 21, 2025)
11. Deposition of Validity Expert (May 15, 2025)

12. Deposition of Invalidity Expert (May 16, 2025)
13. Patent Owner's Pre-Hearing Brief on Validity (June 6, 2025)
14. Petitioner's Pre-Hearing Brief on Invalidity (June 6, 2025)
15. More than half of ITC Hearing (July 9-11, 2025 and part of July 14)

As this summary demonstrates, the parties invested **substantial** resources on Petitioner's prior art invalidity grounds in the Parallel ITC Investigation. That Petitioner elected in the last days of the hearing, despite the substantial investment of judicial and party resources outlined above, that its prior art invalidity theories no longer merited pursuing does **nothing** to undo the sunk-costs that had by that point already been invested.

C. *Fintiv* Factor 4 weighs in favor of discretionary denial

Notably, Petitioner has not withdrawn all invalidity grounds from the Parallel ITC Investigation and is still pursuing invalidity under 35 U.S.C. § 112; as to both written description and enablement. As such, the ITC will still consider the issue of validity, despite Petitioner's withdrawal of prior art grounds, which is relevant to *Fintiv* factor 4 (the overlap between issues raised in the petition and in the Parallel ITC Investigation). *See Hulu, LLC v. Piranha Media Distribution, LLC*, IPR2024-01252, Paper 27 (PTAB Apr. 17, 2025) (informative) at 2-3 (denying institution for claims found invalid under 35 U.S.C. § 101, noting "the *Fintiv* framework emphasizes efficiency concerns").

Indeed, under analogous circumstances, the Director has previously ruled that a Petitioner's "new, broader stipulation" not to pursue any prior art invalidity grounds in a parallel proceeding was *not* "a proper basis for rehearing" of a Director decision. *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, -01206, -01207, -01208, Paper 23 (PTAB May 23, 2025) at 5. And, although Petitioner's last-minute decision to abandon its prior art invalidity grounds in the final days of the ITC trial will (like the stipulation in *Motorola*) preclude the ITC from reaching those grounds in its Final Determination, Petitioner's late maneuvering cannot erase the overlap of issues that existed throughout the ITC proceeding—during which Petitioner's grounds were fully developed up to and including the point at which Petitioner decided they no longer merited pursuing. Nor can Petitioner's maneuvering outweigh the substantial investments made in the Parallel ITC Investigation (factor 3), nor the considerations addressed in factors 1, 2, and 5 above—all of which weigh conclusively in favor of denial. *Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, -01206, -01207, -01208, Paper 19 (PTAB March 28, 2025) at 4 ("considering the *Fintiv* factors as a whole, the efficiency and integrity of the system are best served" by denying institution, noting that "although Petitioner's Sotera stipulation may mitigate some concern of duplication between the parallel proceeding and this proceeding, the stipulation

does not outweigh the substantial investment in the [parallel] proceeding or *Fintiv* factors 1, 2, and 5, which the Board found weighed in favor of denial”).

D. *Fintiv* Factor 6 weighs in favor of discretionary denial

Finally, Petitioner's abandonment of its prior art invalidity grounds in the last days of the ITC hearing *confirms* that Petitioner has failed to present a meritorious case of obviousness for all of the reasons demonstrated in Patent Owner's Request for Discretionary Denial. *See, e.g.*, Request at 20-22. The invalidity grounds that Petitioner pursued during the Parallel ITC Investigation, and all of the arguments that Petitioner advanced in those proceedings in support of those grounds, were identical to the grounds stated in its Petition. Petitioner's conclusion that these grounds no longer merited pursuing, after they had been fully worked up through fact discovery, expert discovery, prehearing briefing, and more (as outlined above), confirms that the merits of Petitioner's grounds are weak.

III. PATENT OWNER'S SETTLED EXPECTATIONS FAVOR DISCRETIONARY DENIAL

As the Director found, Patent Owner has strong settled expectations regarding the validity of the challenged patent. Decision Denying Institution at 2. Petitioner disagrees. *See, e.g.*, Request for Director Review of Discretionary Denial of Institution Decision at 13-15.

However, “actual notice of a patent or of possible infringement is not necessary to create settled expectations.” *Dabico Airport Solutions Inc. v. AXA Power Aps*, IPR2025-00408, Paper 21 (PTAB June 18, 2025) at 3. The challenged patent could have easily been found using the Patent Office’s automated search systems and publicly available resources on the Internet. *Id.* (citing 35 U.S.C. § 41(i)). Petitioner has been aware of and participated in the U.S. patent system almost from the moment of its founding in September 2014.² Moreover, as explained in IPR2025-00912, one of Petitioner’s two co-founders, Huan Zhao, testified at the hearing for the Parallel ITC Investigation that Petitioner has been aware of Patent Owner Skyworks as a market-leading competitor since its founding. IPR2025-00912, EX2002 at 902:24-903:1, 991:10-22. In fact, since its founding, Petitioner has made Skyworks and Skyworks’ products a focus of Petitioner’s business. *Id.* at 903:6-10. Despite Petitioner KCT’s awareness of and participation in the U.S. patent system, and its focus on Patent Owner Skyworks, Petitioner waited until long after the challenged patent issued to bring this proceeding.

² See KXComTech, *In September of 2014, Kangxi Communication Technologies (Shanghai) Co., Ltd. was founded in Shanghai* (Oct. 10, 2014), <https://kxcomtech.com/En/News/Company-Events/700.html>.

In fact, that Petitioner elected to withdraw its prior art invalidity challenge in the Parallel ITC Investigation only strengthens Patent Owner's expectations that its patent is novel and nonobvious.

IV. CONCLUSION

The Director should affirm the Director's Decision Denying Institution of *Inter Partes* Review. As set forth above, all six *Fintiv* factors and Patent Owner's settled expectations continue to weigh heavily against institution. Petitioner made a decision to no longer pursue its prior art invalidity defenses, despite the substantial investments made by both parties in disputing these defenses and the opportunity to have the ITC rule on them, and the efficiency and integrity of the system are best served by holding Petitioner to that decision.

Dated: August 22, 2025

Respectfully submitted,

/Haixia Lin/

Haixia Lin, Reg. No. 61,318

CERTIFICATE OF SERVICE

I hereby certify that on August 22, 2025, I caused a true and correct copy of the following materials:

- **Authorized Response to Director Review Request**

to be served via e-mail, as consented to by Petitioner, on the following attorneys of record:

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By: /Haixia Lin/

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