

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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KANGXI COMMUNICATION TECHNOLOGIES (SHANGHAI) CO., LTD.

Petitioner,

v.

SKYWORKS SOLUTIONS, INC.

Patent Owner.

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*Inter Partes* Review No. 2025-00373

U.S. Patent 8,717,101

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**PETITIONER'S REQUEST FOR DIRECTOR REVIEW OF THE  
DISCRETIONARY DENIAL OF INSTITUTION DECISION  
UNDER 37 C.F.R. § 42.75**

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1001	U.S. Patent 8,717,101 (“the ’101 Patent”)
1002	Prosecution History for U.S. Patent 9,917,101
1003	Declaration of Dr. David Ricketts
1004	U.S. Patent Publication 2009/0212863 (“ <i>Ishimaru</i> ”)
1005	U.S. Patent Publication 2004/0232982 (“ <i>Ichitsubo</i> ”)
1006	Excerpts of Linden T. Harrison, Current Sources and Voltage References, A Design Reference for Electronics Engineers (Elsevier 2005) (“ <i>Harrison</i> ”)
1007	U.S. Patent Publication 2011/0025422 (“ <i>Marra</i> ”)
1008	Johnson, “Silicon-Germanium BiCMOS HBT Technology for Wireless Power Amplifier Applications,” IEEE J. Solid State Circuits, Vol. 39, No. 10 (Oct. 2004) (“ <i>Johnson</i> ”)
1009	Excerpts of Laplante, Comprehensive Dictionary of Electrical Engineering (2d Ed. 2005) (“ <i>Laplante</i> ”)
1010	U.S. Patent Publication No. 2011/0128078 (“ <i>Doherty</i> ”)
1011	Christopher Bowick, “What’s in an RF Front End,” EE Times (Feb. 4, 2008) available at: <a href="https://www.eetimes.com/whats-in-an-rf-front-end/">https://www.eetimes.com/whats-in-an-rf-front-end/</a> (last accessed December 12, 2024) (“ <i>Bowick</i> ”)
1012	Barrie Gilbert, “Bipolar Current Mirrors”, Chapter 6 in Tomazou <i>et al.</i> , Analog IC Design: The Current Mode Approach (Reprinted 2008) (“ <i>Gilbert</i> ”)
1013	Excerpts of Gray <i>et al.</i> , Analysis and Design of Analog Integrated Circuits (5 <sup>th</sup> Ed. 2009) (“ <i>Gray</i> ”)
1014	Excerpts of Grebene, Bipolar and MOS Analog Integrated Circuit Design (2003) (“ <i>Grebene</i> ”)
1015	Excerpts of Illingworth, Dictionary of Electronics (3d Ed. 1998)
1016	Declaration of June Ann Munford

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1017	TriQuint Semiconductor, Application Note TVS Protection and Bias Sequencing for HBT Amplifiers, p. 1 (June 2009) (“ <i>TriQuint</i> ”)
1018	Certified Translation of Japanese Patent Application Publication No. JP 2009-283991 (“ <i>Akagi</i> ”)
1019	U.S. Patent No. 6,831,517 (“ <i>Hedberg</i> ”)
1020	Joint Claim Construction Chart in ITC Inv. No. 337-TA-1413
1021	VintageTek biography, Barrie Gilbert, available at <a href="https://vintagetek.org/barrie-gilbert/">https://vintagetek.org/barrie-gilbert/</a> (“ <i>Gilbert Biography</i> ”)
1022	<i>Diels</i> , Single-Package Integration of RF Blocks for a 5 GHz WLAN Application, IEEE Transactions On Advanced Packaging, Vol. 24, No. 3, (August 2001) (“ <i>Diels</i> ”)
1023	<i>Scherz</i> , Practical Electronics for Inventors (2000) ( <i>Sherz</i> )
1024	<i>Horowitz</i> , Elementary Electricity and Electronics, Component by Component, (1986) (“ <i>Horowitz</i> ”)
1025	<i>YanJun</i> , “A 2.4-GHz SiGe HBT power amplifier with bias current controlling circuit”, Chinese Institute of Electronics, Journal of Semiconductors, Vol. 30, No. 5, (May 2009), (“ <i>YanJun</i> ”)
1026	Patent Owner’s Markman Briefs in ITC Inv. No. 337-TA-1413
1027	Petitioner’s Markman Briefs in ITC Inv. No. 337-TA-1413
1028	Commission Investigative Staff’s Markman Briefs in ITC Inv. No. 337-TA-1413
1029	U.S. Patent 9,917,563 (“the ’563 Patent”)
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## I. Introduction

Petitioner Kangxi Communication Technologies (Shanghai) Co., Ltd. (“Petitioner”) respectfully requests Director Review of the discretionary denial announced in the Decision Denying Institution of *Inter Partes* Review (Paper 10, July 16, 2025) (“Decision”) of U.S. Patent 8,717,101 (“the ’101 Patent”), vacate the Decision, and refer the Petition to the Board for institution on the merits in the ordinary course. The Decision was based on two reasons: *first*, under *Fintiv* because at the time of the discretionary denial briefing a common invalidity ground was being pursued in a parallel proceeding before the International Trade Commission (ITC)<sup>1</sup>; and *second*, under the new policy of “settled expectations” because “the challenged patents have been in force for more than 7 and 14 years [SIC].” Decision, 2.<sup>2,3</sup> Review and vacatur of the Decision is warranted in view of

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<sup>1</sup> *Certain Wireless Front-End Modules, Devices Containing the Same, and Components Thereof*, Inv. No. 337-TA-1413 (ITC) (the “Parallel ITC Proceeding”)

<sup>2</sup> The Decision was entered in IPR2025-00372 and IPR2025-00373.

<sup>3</sup> The ’563 Patent (challenged in IPR-2025-00372) issued March 13, 2018, and the ’101 Patent issued on May 6, 2014, and thus were in force for less than 7 years and less than 11 years, respectively, when the respective IPR Petitions were filed on January 14, 2025.

(i) Petitioner’s withdrawal of prior art invalidity from the ITC proceeding constituting a material change in the circumstances underlying the Decision; (ii) the constitutional violations of Petitioner’s rights caused by the retroactive application of the two new policies that were the foundation of the denial (applying *Fintiv* to ITC cases; and “settled expectations”), which are each significant changes in policy that Petitioner could not have foreseen; and (iii) the violation of Petitioner’s constitutional rights caused by the arbitrary and capricious implementation and application of the “settled expectations” doctrine.

**II. Petitioner’s Withdrawal of Prior Art Invalidity as an Issue from the Parallel ITC Proceeding Constitutes a Material Change in Circumstances Warranting Director Review**

Review and vacatur of the Decision is warranted in that it was decided in part on *Fintiv*, but Petitioner withdrew the defense of prior art invalidity from the Parallel ITC Proceeding. The defense was not presented at the evidentiary hearing at the ITC. The ITC will not be making any findings under 35 U.S.C. §102 or §103. The change in circumstance is material to *Fintiv* and thus warrants Director Review.

More specifically, during the evidentiary hearing in the Parallel ITC

Proceeding, Petitioner withdrew its prior-art-based invalidity defenses.<sup>4</sup> Petitioner did so before it put on its case-in-chief. The ITC will not be addressing whether the claims of the '101 Patent are invalid as obvious under 35 U.S.C. § 103, nor will it be deciding, of course, the specific Grounds in the Petition.<sup>5</sup>

The Decision issued on July 16, 2025, three (3) days after the Petitioner had withdrawn its prior art invalidity defense. At the time the Decision issued, Petitioner was preparing a submission to the Director to inform the Office of the withdrawal. That is material to the Decision, as one of the stated bases for denying institution was the existence of the Parallel ITC Proceeding and finding that “it is unlikely that final written decisions in these [PTAB] proceedings will issue before

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<sup>4</sup> After having withdrawn various pieces of prior art earlier, Petitioner informed Patent Owner on July 13, 2025, and the presiding Administrative Law Judge (“ALJ”) on July 14, 2025, that it was completely withdrawing prior art invalidity as a defense for practical reasons. The parties actively streamlined the issues in the ITC proceeding over the course of July, with Patent Owner dropping its infringement allegations against half of the accused products and multiple patent claims just before the evidentiary hearing, dropping an infringement theory at the hearing, and dropping more asserted claims post-hearing.

<sup>5</sup> *Ishimaru* (Ground 1); *Ishimaru* in view of *Harrison* (Ground 2).

the final determination [by the ITC].” Paper 10, at 2. Given that there is a remaining litigation, but that case is stayed until the ITC case is final (including any appeals), the stayed case will not go to trial until September 2028 (if no ITC appeals), *almost two years after* the Final Written Decision deadline in the IPR (August 2026). Because of this material change of circumstances, *inter partes review* is an appropriate use of Board resources.<sup>6</sup>

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<sup>6</sup> As noted in the Petition (Paper 2 at 79-80), the co-pending C.D. California district court case (“C.D. Cal. case”) will remain stayed “until the determination of the [ITC] becomes final” (*i.e.* after “all appeals are exhausted”). *In re Princo Corp.*, 486 F.3d 1365, 1369 (Fed. Cir. 2007). Based on the schedule of the ITC Proceeding (Paper 7 at 13), the C.D. Cal. case would be stayed until May 2026 at the earliest (if the ITC finds no violation and Patent Owner does not appeal). Based on statistical data, the C.D. Cal. case would not go to trial until September 2028, and much later if the ITC final decision is appealed. *See* [https://www.uscourts.gov/sites/default/files/document/fcms\\_na\\_distprofile0331.2025.pdf](https://www.uscourts.gov/sites/default/files/document/fcms_na_distprofile0331.2025.pdf) at 68 (median time to trial in C.D. California was 27.8 months as of 3-31-2025); <https://www.cafc.uscourts.gov/wp-content/uploads/reports-stats/FY2024/MedianDispositionTime-Merits.pdf> (median time to Fed. Cir. disposition of ITC decision was 24.5 months in FY2024).

**III. The Decision’s Retroactive Application of New Policies — the February 28, 2025 Recission of the Vidal Memo, the March 24, 2025 Guidance on the USPTO’s Recission of the Vidal Memo and the March 26, 2025 Interim Processes for PTAB Workload Management — Violated Petitioner’s Constitutional Rights**

The Decision’s retroactive application of new policies violated its constitutional rights, including at least the due process and takings clauses. The Due Process Clause of the Fifth Amendment to the U.S. Constitution is a critical component in the development of arbitrary and capricious review. It mandates that the government cannot deprive individuals of life, liberty, or property without due process of law. This clause has been interpreted to require that agency actions be not only lawful but also reasonable and not arbitrary. *County of Sacramento v. Lewis*, 523 U.S. 833 (1998) (“The very essence of due process is protection against arbitrary government action.”).

**A. The Patent Office Violated Due Process in Retroactively Applying its New Policy Applying *Fintiv* to Parallel ITC Proceedings**

**1. The Patent Office’s Operative Guidance when Petitioner Filed the IPR Petition**

Under Office policy when Petitioner prepared, filed, and paid for the IPR petition, *Fintiv* categorically did not apply to ITC proceedings. Specifically, in the June 21, 2022 memorandum titled “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” issued by Director Vidal (the “Vidal Memo”), the stated policy of the Office was that the

PTAB unequivocally “will **not** discretionarily deny petitions based on applying *Fintiv* to a parallel ITC proceeding.” Vidal Memo at 6-7 (emphasis added).

Petitioner reasonably relied on the Vidal Memo in pursuing an IPR of the ’101 Patent on January 14, 2025. Petition, Paper 2, at 79.

**2. The Patent Office Then Rescinded and Reversed the Operative Policy, and Retroactively Applied its New Policy**

On February 28, 2025 — six weeks after Petitioner filed the IPR petition and many months after Petitioner set out on its IPR strategy —, the Office rescinded the Vidal Memo. On March 24, 2025, the Chief Judge of the PTAB issued the Guidance on USPTO’s rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” Memorandum (“Boalick Memo”), and stated that the Boalick Memo “applies to any case in which the Board has not issued an institution decision.” Boalick Memo at 2. The Boalick Memo announced a 180-degree reversal of the Vidal Memo’s policy as to parallel ITC proceedings. *Compare:*

- Boalick Memo at 2: “the Board **will** apply the *Fintiv* factors when there is a parallel proceeding at the [ITC]” and “the Board is more likely to deny institution where the ITC’s projected final determination date is earlier than the Board’s deadline to issue a final written decision.” *Id.* (emphasis added); *with*

- Vidal Memo at 5-7: “For the foregoing reasons ... [t]he PTAB **will not** discretionarily deny petitions based on applying *Fintiv* to a parallel ITC proceeding.” (emphasis added).

Then, on March 26, 2025, the Director issued the Interim Processes for PTAB Workload Management (“Stewart Memo”), stating that “[t]he processes described herein will be implemented in IPR and PGR proceedings where the deadline for the patent owner to file a preliminary response has not yet passed.” Stewart Memo at 3. The Office violated constitutional due process by retroactively applying the Boalick and Stewart Memos to the IPR petition here.

### **3. Petitioner Relied on the Vidal Memo in Deciding to File an IPR Petition Challenging the ’101 Patent**

Petitioner filed its petition challenging the ’101 Patent on January 14, 2025. Later, on March 24, 2025 and then on March 26, 2025, the Office decided to retroactively apply the Boalick Memo and the Stewart Memo to IPRs pending before the February 28, 2025 rescission date of the Vidal Memo, which changed the process, including a complete reversal of the Office’s policy relating to parallel ITC proceedings, and harmed Petitioner based on its reliance on the Vidal Memo’s operative policy when it filed its IPR petition.

Before the change, the Board consistently followed the Vidal Memo:

The plain language of the *Fintiv* factors ... does **not** apply to parallel U.S. International Trade Commission (ITC) proceedings, as the ITC

lacks authority to invalidate a patent and the ITC's invalidity rulings are not binding on the Office or on district courts ... For the foregoing reasons, the PTAB **no longer** discretionarily denies petitions based on applying *Fintiv* to a parallel ITC proceeding. This memorandum memorializes that practice. The PTAB will **not** discretionarily deny petitions based on applying *Fintiv* to a parallel ITC proceeding.

Vidal Memo at 2-3, 6-7 (emphasis added).

Petitioner's reliance on the Vidal Memo informed not only the timing of its IPR challenge, but the decision to incur the significant resources to pursue an IPR, particularly in view of the abbreviated timeline of ITC proceedings. Petitioner expended precious resources, including counsel and government monetary fees, and the time, effort, and energy in mounting its defense against Patent Owner's assertions. Petitioner's reliance was during a period in which Petitioner needed to make important decisions about how to use its resources in the face of the resource-intense, fast-paced ITC proceeding, with potentially far-reaching consequences. There was no reasonable ability for Petitioner to have foreseen the new doctrine, and applying the new doctrine retroactively unfairly wasted Petitioner's resources and prejudiced its defense of Patent Owner's infringement allegations. As such, Petitioner's reliance interest in the agency's guidance is the kind of reliance interest deemed property for due process purposes because it is a legitimate claim to entitlement, not a mere unilateral expectation. *Cf. The Bd. of*

*Regents of State Colleges v. Roth*, 408 U.S. 564, 577 (1972). Indeed, Petitioner was entitled to not have its investment in reasonable reliance on the agency guidance arbitrarily wiped out by the Office, and certainly not while the Office pocketed the substantial government fees paid. The retroactive policy reversal amounts to a particularly harsh oppressive, arbitrary and irrational agency action. In contrast, “[e]lementary considerations of fairness dictate that individuals should have an opportunity to know what the law is and to conform their conduct accordingly.” *Landgraf v. USI Film Products*, 511 U.S. 244 (1994).

**B. The Patent Office Violated Due Process in Retroactively Applying its New Doctrine of “Settled Expectations”**

The Office also violated due process by retroactively applying a novel “settled expectations” doctrine announced after Petitioner filed its IPR Petition. Specifically, the second basis of the Decision was that “the challenged patents have been in force for more than 7 and 14 years [SIC]<sup>7</sup>, respectively, creating strong settled expectations, and Petitioner does not provide any persuasive reasoning why an *inter partes* review is an appropriate use of the Board resources under these circumstances.” Decision at 2. The Stewart Memo vaguely announced the “settled expectations” doctrine. Stewart Memo at 2.

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<sup>7</sup> Less than 7 years, and less than 11 years. *See* footnote 3.

But when Petitioner decided to invest its resources in its IPR strategy, there was no such “settled expectations” doctrine. The doctrine cannot be found in any statute, rule, notice or policy. Indeed, statute sets up the opposite expectation. *See, e.g.*, 35 U.S.C. §311(c) (precluding IPRs filed prior to 9 months after grant but allowing them thereafter); 35 U.S.C. §315(b) (precluding IPRs filed more than 1 year after suit but allowing them thereafter); 35 U.S.C. § 282 (no time-dependent change to the presumption of validity). If Petitioner had known that there was a rule that older patents were ineligible for *inter partes* review, Petitioner would not have invested in the procedure provided by U.S. statute. Thus, the retroactive new doctrine violates at least constitutional due process.

#### **IV. The Office’s Implementation and Application of the New Doctrine of “Settled Expectations” Violates Petitioner’s Constitutional Rights**

##### **A. The Procedures Implementing the New “Settled Expectations” Doctrine Violate Petitioner’s Constitutional Rights**

The Decision relies on the new “settled expectations” doctrine, but the procedures that the Office followed in announcing and implementing the doctrine violate Petitioner’s due process rights. The doctrine was announced in the Stewart Memo, which merely listed as one new “factor” for discretionary denials would be the “settled expectations of the parties” and referencing “the length of time the claims have been in force.” Stewart Memo at 2. As revealed by the Decision (which evaluated nothing but the age of the patents), the Stuart Memo appears to

have effectively created a vague rule (law?) that some older patents are ineligible for *inter partes* review. The announcement and implementation of the doctrine was arbitrary action in violation of Petitioner's constitutional rights for at least the following reasons, in addition to the retroactivity discussed above:

*First*, the doctrine was announced without guidance as to what it meant, or what "length of time" is too long. Whose expectations? Subjective or objective? What circumstances would lead to exercise of discretion? The Stewart Memo does not provide any standards to be used by the Office in determining what constitutes the "settled expectations of the parties", briefly positing the open-ended statement referencing "the length of time the claims have been in force." *Id.* The memo cites no law, case or legislative history to fill in the gap. *Id.* The vagueness precluded Petitioner from understanding the doctrine and ordering its affairs accordingly. Guidance is particularly critical here where the "expectation" of a party is a subjective inquiry being decided as a matter of agency "discretion." That leads very quickly to an arbitrary application of facts due to the absence of clear guidelines establishing objective considerations, as is apparent in the Decision, violating Petitioners constitutional rights to due process.

*Second*, the new doctrine goes beyond any statutory authority given to the Office. As reflected in the Decision, the doctrine appears to effectively legislate a new time limit on the availability of *inter partes* reviews. But this conflicts with

the statutory presumption of validity that does not change with time (35 U.S.C. § 282), and conflicts with statutes allowing IPRs of such patents throughout their life (35 U.S.C. §311(c) and 35 U.S.C. §315(b)). While the Office is given some discretion to deny institution, here, the Decision confirms that the doctrine is being used to exclude entire categories of patents from review based on a new time limit. That exercise of discretion extends well beyond any statutory authority grant — as is apparent from the actual statutes reasonably relied upon by Petitioner — denying Petitioner due process under the U.S. Constitution.

*Third*, the new sweeping doctrine was announced informally by memorandum, without notice and rule-making that would have given Petitioner notice of the new policy, allowed Petitioner an opportunity to have been heard, and allowed Petitioner an opportunity to conduct itself accordingly. Implementing such a sweeping new doctrine in this manner by way of a memorandum (even if it had not been retroactive) amounts to arbitrary action, violating Petitioner’s constitutional rights.

**B. The Decision’s Lack of Reasoning and Evidence in Applying the New Doctrine of “Settled Expectations” Violates Petitioner’s Constitutional Rights**

In this case, the Decision’s lack of reasoning, findings of fact, and evidence in applying discretion under the new doctrine violates Petitioner’s constitutional rights, including due process. Here, the Decision only references the age of the

challenged Patent. It does not discuss any of the factors that might pertain to a “settled expectations” doctrine or why that is a reasoned basis for denying review. Petitioner has no ability to effectively seek review of the Decision, as Petitioner does not understand the basis for it.

The Decision did not address that Patent Owner waited until March 2023 to bring the ’101 Patent to the attention of Petitioner.<sup>8</sup> PO Request, Paper 7, at 33. The Decision does not explain why Petitioner’s invalidity contentions served in October 2024 did not demonstrate its expectations of invalidity. *Id.* The Decision does not discuss that there is no evidence that Petitioner had any awareness whatsoever of the existence of the ’101 Patent or its alleged applicability to Petitioner before March 2023, demonstrating Petitioner had no “expectation” that the patent was relevant to it, much less *valid*. The Decision does not discuss or explain under the facts of this case why the age of the ’101 Patent<sup>9</sup> would reasonably establish Petitioner’s “settled expectation” as to its validity. The same goes for the Patent Owner. The Decision does not substantiate Patent Owner’s

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<sup>8</sup> There is no evidence of Patent Owner having given any other party notice of the patent, or that it was part of any proceeding or post-grant challenge in any forum.

<sup>9</sup> Issued less than 11 years before the petition was filed. *See* footnote 3.

purported “expectation” with any evidence or careful reasoning, and does not discuss the lack of evidence of the ’101 Patent having ever been commercialized,<sup>10</sup> marked, or licensed,<sup>11</sup> or asserted, defended, or tested in any prior proceeding. Absent any guidelines, rationale or evidence, the mere length of time that the ’101 Patent was pending when the IPR was filed – less than 11 years – cannot reasonably be relied upon to establish the subjective expectation of any party.

The lack of a decision showing reasoning substantiated with evidence is especially problematic given the *retroactive* application of the new doctrine. Indeed, the record demonstrates that, at the time that the Petitioner filed the IPR for the ’101 Patent, the settled expectation of the parties is that many patents issued by a patent office do not survive scrutiny by an interested party in a post-grant proceeding. That is the basis for having *inter partes* reviews in the first place. . The doctrine is inconsistent with ground already covered by Congress. *See* 35

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<sup>10</sup> Although Patent Owner alleges before the ITC that it practices the patent, the Commission Investigative Staff and Petitioner dispute that Patent Owner carried its burden to prove that jurisdictional requirement of the ITC.

<sup>11</sup> Patent Owner did not allege that it marked or licensed the patent, or put forth evidence of secondary considerations of non-obviousness in the POPR (Paper 8, May 21, 2025) or PO Request (Paper 7, April 22, 2025).

U.S.C. § 282, 35 U.S.C. §311(c), and 35 U.S.C. §315(b). The expectations of the parties, as indicated by the Vidal Memo and the time-limits proscribed by statutes discussed above, was that the Office would not discretionarily deny institution based on the Parallel ITC Proceeding, nor the mere age of the challenged patent. Discretionary denial is thus the opposite of the settled expectations of the parties, but instead is arbitrary agency action in violation of Petitioner’s constitutional rights.

Moreover, the Decision did not discuss, as noted in the Petition (Paper 2, January 14, 2025) and in Petitioner’s Opposition to Patent Owner’s Request for Discretionary Denial of Institution (Paper 9, May 22, 2025), that the Petition demonstrates (i) strong merits for invalidity that have not been previously considered by the Office (and have not and will not be considered by the ITC), and (ii) that the grounds and references of the Petition were not before the Office during prosecution. There is no reasonable inference which can support that the parties had a settled expectation that the Challenged Claims were valid, and the Decision’s finding as to “settled expectation of the parties” is arbitrary.

## **V. Conclusion**

For the foregoing reasons, Petitioner respectfully requests that the Director grant this request for Director Review.

Date: August 15, 2025

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), the undersigned certifies that a copy of the foregoing Petitioner's Request for Director Review of the Decision Denying Institution of *Inter Partes* Review of U.S. Patent No. 8,717,101 was served by electronic means to counsel of record in the present IPR.

Date: August 15, 2025

By: /John M. Baird/  
John M. Baird, Lead Counsel  
USPTO Reg. No. 57,585