

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

**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL UNDER
THE MARCH 26, 2025 MEMORANDUM RE: INTERIM PROCESSES FOR
PTAB WORKLOAD MANAGEMENT**

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Memorandum by the Chief Administrative Patent Judge dated March 24, 2025 passim

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 8:24-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

I. INTRODUCTION

The Director should deny the Petition¹ because the *Fintiv*² factors, as well as several other factors explained in more detail below, overwhelmingly favor denying institution. The Memorandum by the Acting Director dated March 26, 2025, sets forth the “Interim Processes for PTAB Workload Management” (the “Workload Management Memorandum”), including the framework for discretionary denial of institution. Under that framework, the Director has statutory authority under 35 U.S.C. § 314(a) to consider discretionary factors enumerated in *Fintiv* and *Advanced Bionics*,³ as well as other relevant considerations, in its institution decision. Workload Management Memorandum at 2-3. Moreover, the Memorandum by the Chief Administrative Patent Judge dated March 24, 2025 (the “Guidance Memorandum”), explains that “the Board will apply the *Fintiv* factors when there is a parallel proceeding at the International Trade Commission.” Guidance Memorandum at 2.

¹ The Petition challenges claims 1-2, 10-11, 17-18, and 20-22 (the “Challenged Claims”) of U.S. Patent No. 8,717,101 (Ex. 1001, the “’101 patent”).

² *Apple v. Fintiv*, IPR2020-0019, Paper No. 11 (PTAB precedential).

³ *Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GmbH*, No. IPR2019-01469, Paper No. 9 (PTAB precedential).

Here, *all* of the *Fintiv* factors overwhelmingly support denial. The challenged '101 patent is currently asserted in an ongoing ITC investigation.⁴ No stay has been granted in the Parallel ITC Investigation, and the investigation has already progressed significantly. Petitioner and Patent Owner, both parties to the Parallel ITC Investigation, have each invested significant resources in that investigation. Trial begins on July 9, 2025, over 30 days before the institution deadline for this Petition. Ex. 2001 (Order No. 33 Regarding Hearing Date) at 3. Petitioner has, in the ITC, challenged the validity of the Challenged Claims based on the exact same prior art and arguments that Petitioner presented in the Petition. The final determination date in the ITC investigation is set for March 23, 2026, *nearly five months before* the statutory deadline for issuing a final written decision if this Petition is instituted. Ex. 2002 (Order No. 20 Regarding Case Schedule) at 7. Finally, the Petition does not present a “particularly strong” obviousness case that should impact the *Fintiv* analysis. To conserve Board and party resources and avoid potentially conflicting rulings, the Director should exercise its discretion and deny institution.

⁴ Certain Wireless Front-End Modules, Devices Containing the same, and Components Thereof, Inv. No. 337-TA-1413 (ITC) (July 17, 2024) (“Parallel ITC Investigation”).

The Director should also deny institution of the Petition under 35 U.S.C. § 325(d) because the Petition raises substantially the same arguments already addressed during prosecution of the '101 patent. Petitioner's arguments concerning the Ishimaru⁵ reference in the Petition are substantially the same as those the Examiner raised and ultimately dropped based on the Alon⁶ reference during prosecution of the '101 patent. Petitioner's attempt to reassert the same arguments already addressed during prosecution under the guise of nominally new references warrants denial under 35 U.S.C. § 325(d).

II. OVERVIEW OF THE '101 PATENT

The '101 patent relates to radio frequency ("RF") power amplifier systems and methods, including systems and methods that control the gain of the power amplifier. Ex. 1001 ('101 patent) at 1:15-24. In particular, the '101 patent explains that controlling gain is important because "amplifying the RF signal to an incorrect power level can cause a wireless device to transmit out of band." *Id.* at 1:27-30. One of the problems identified by the '101 patent is that the gain of the power amplifier can vary, and when the gain of a power amplifier varies, it can

⁵ Ex. 1004 (U.S. Patent Application Publication No. 2009/0212863 to Ishimaru ("Ishimaru")).

⁶ Ex. 2009 (U.S. Patent No. 7,869,775 to Alon ("Alon")).

cause the wireless device to transmit out of band. The '101 patent provides several examples of factors that can impact the gain variation of a power amplifier. The '101 patent explains, for example, that one factor that impacts gain variation is the difference in temperatures among components in the system. *Id.* at 9:38-40. As another example, the input power voltage “can vary depending on a charge of the device that the power amplifier” is used in. *Id.* at 9:40-43.

The '101 patent discloses and claims an invention for “improved power amplifier systems” and for “improving power amplifier biasing.” Ex. 1001 ('101 patent) at 1:31-33. In particular, the '101 patent discloses improved power amplifier biasing that “can be used to compensate for a gain variation of the power amplifier.” *Id.* at 9:43-46. An exemplary embodiment of the '101 patent describes a bias circuit that receives an enable signal and generates a bias signal for the power amplifier. The bias circuit generates a control current using the enable signal, mirrors the control current to generate a correction current, and generates the bias signal based at least in part on the correction current.

Figure 4, shown below, depicts details of an exemplary power amplifier disclosed by the '101 patent.

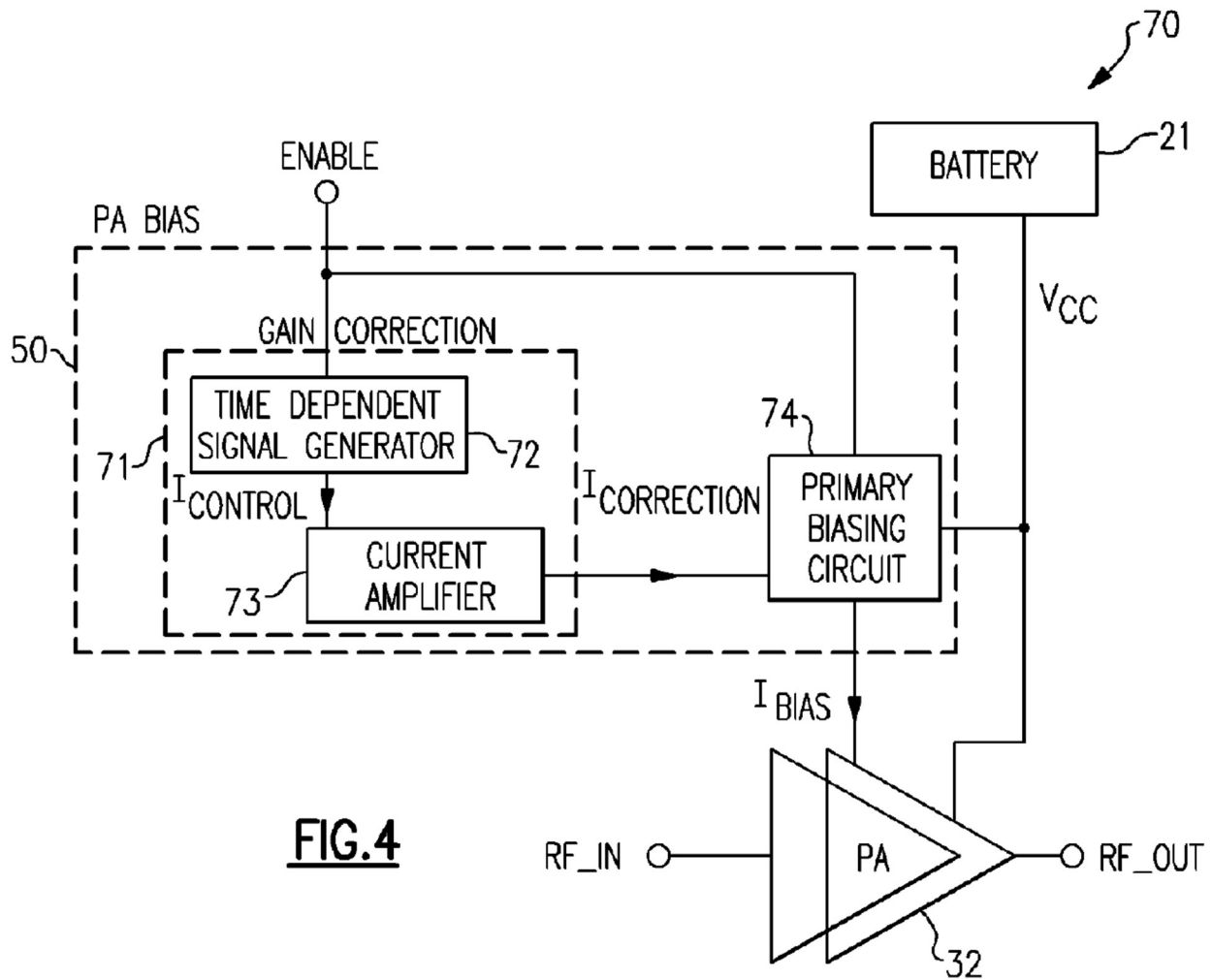


FIG. 4

Ex. 1001 ('101 patent) at Fig. 4.

As shown above, the power amplifier bias block 50 includes primary biasing circuit 74 and gain correction block 71. Ex. 1001 ('101 patent) at 9:13-15.

Control block 72 generates a control current I_{CONTROL} based on an enable signal.

Id. at 9:47-9:50. Control current I_{CONTROL} is provided to current amplifier 73 to generate a correction current $I_{\text{CORRECTION}}$. *Id.* at 9:50-53. The primary biasing

circuit 74 generates a bias current I_{BIAS} based on the correction current $I_{CORRECTION}$.

Id. at 10:8-13, Fig. 4.

Figure 5, shown below, depicts an exemplary circuit diagram of the power amplifier bias block 50 in Figure 4 of the '101 patent:

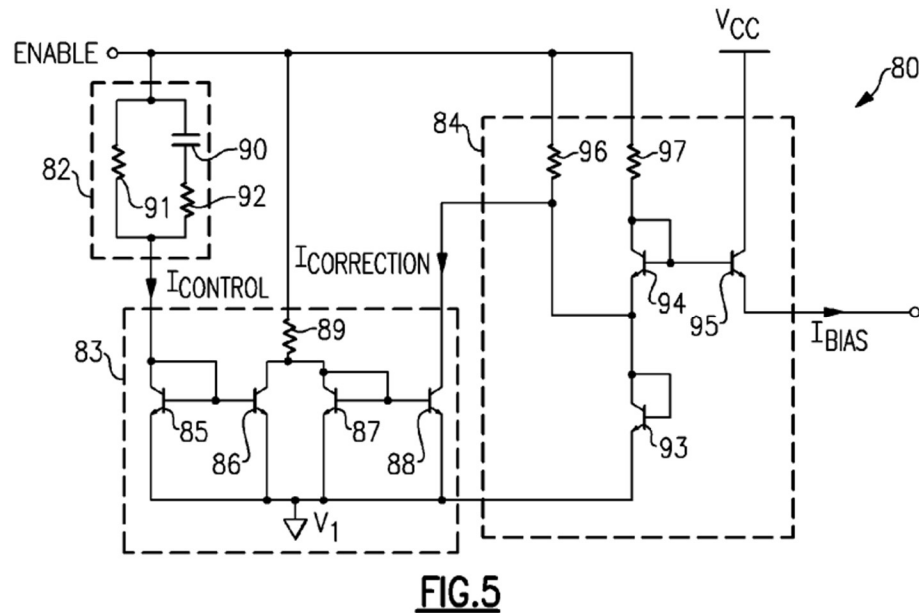


FIG.5

Ex. 1001 ('101 patent) at Fig. 5.

As shown above, the power amplifier bias block 80 includes “a resistor-capacitor (RC) network 82, a current mirror 83, and a primary bias circuit 84.” Ex. 1001 ('101 patent) at 10:18-21. To generate the bias current I_{BIAS} , the RC network 82 first uses the enable signal to generate the control current $I_{CONTROL}$. *Id.* at 10:37-41. Then, the current mirror 83 mirrors the control current $I_{CONTROL}$ to generate the correction current $I_{CORRECTION}$. *Id.* at 10:62-11: 1. The correction current $I_{CORRECTION}$ is provided to the primary bias circuit 84, which then uses the

correction current to generate a bias current I_{BIAS} for the power amplifier. *Id.* at 11:46-12:13.

III. OVERVIEW OF RELATED LITIGATION

Patent Owner and Petitioner have been parties to an ongoing district court litigation⁷ and Parallel ITC Investigation since May 2024. *See* Ex. 2003 (Dist. Ct. Cmpl.); Ex. 2004 (ITC Cmpl.). In each parallel litigation, Patent Owner has asserted the '101 patent against Petitioner. *See* Ex. 2003 (Dist. Ct. Cmpl.) at ¶¶ 52-68; Ex. 2004 (ITC Cmpl.) at ¶¶ 86-106. Petitioner has been on notice of the '101 patent since at least March 7, 2023, when Patent Owner sent Petitioner a letter informing Petitioner that it infringed the '101 patent. *See* Ex. 2003 (Dist. Ct. Cmpl.) at ¶ 62; Ex. 2004 (ITC Cmpl.) at ¶ 94. Despite knowing of Patent Owner's infringement allegations regarding the '101 patent since March 2023, Petitioner waited nearly two years to submit the Petition in January 2025.

While the Parallel District Court Litigation has been stayed pending the Parallel ITC Investigation,⁸ the Parallel ITC Investigation has progressed

⁷ *Skyworks Solutions, Inc. v. Kangxi Communication Technologies (Shanghai) Co., Ltd et al.*, Case No. 8:24-cv-00974-FWS-ADS (C.D. Cal. May 6, 2024) (“Parallel District Court Litigation”).

⁸ Ex. 2007 (Order regarding Stay).

significantly, and the parties have invested significant resources in that investigation. Fact discovery closed over two months ago. Ex. 2002 (Order No. 20 regarding Case Schedule) at 3. Petitioner has served voluminous invalidity contentions, to which Patent Owner responded. The parties are currently completing expert discovery. Patent Owner's expert in the Parallel ITC Investigation, Dr. David Ricketts, the same expert who submitted a declaration in support of the Petition, has submitted an expert report regarding validity issues for the '101 patent. *See* Ex. 2005 (Invalidity Expert Report of Dr. Ricketts). In Dr. Ricketts' ITC expert report, he presents the same obviousness arguments Petitioner makes in this Petition (Ishimaru alone and Ishimaru in view of Harrison⁹). *See. Id.* at 111-148. Dr. Ricketts' ITC expert report is nearly identical to his declaration in support of the Petition. *Compare* Ex. 1003 (Decl. of Dr. Ricketts), ¶¶ 93-168 with Ex. 2005 (Invalidity Expert Report of Dr. Ricketts) ¶¶ 255-341. Because the parties are litigating the same validity grounds in the Parallel ITC Investigation as raised by Petitioner in the Petition, there is ***complete overlap*** for invalidity issues between the Petition and the Parallel ITC Investigation.

⁹ Ex. 1006 (Excerpts of Linden T. Harrison, Current Sources and Voltage References, A Design Reference for Electronics Engineers (Elsevier 2005) (“Harrison”)).

Patent Owner has also invested significant resources responding to Petitioner's invalidity contentions and expert report in the Parallel ITC Investigation. Patent Owner submitted its own expert report demonstrating the validity of the Challenged Claims. *See* Ex. 2006 (Validity Report of Dr. Wentzloff). By the expected date of the institution decision (August 21, 2025), the parties will have *concluded* claim construction briefing, fact and expert discovery, pretrial briefing, *trial*, and post-trial briefing. *See* Ex. 2002 (Order No. 20 Regarding Case Schedule) at 5-8; *see also* Ex. 2001 (Order No. 33 Regarding Hearing Date). The administrative law judge in the Parallel ITC Investigation will decide the same validity issues presented in the Petition. For efficiency and to conserve government and party resources, the Director should exercise its discretion and deny institution.

IV. THE *FINTIV* FACTORS FAVOR DISCRETIONARY DENIAL

The purpose of the *Fintiv* analysis is to “take[] a holistic view of whether efficiency and the integrity of the system are best served by denying or instituting review.” *Fintiv*, Paper 11 at 6. *Fintiv* applies in the case of parallel ITC proceedings. Guidance Memorandum at 2 (clarifying that “the Board will apply the *Fintiv* factors when there is parallel proceeding at the [ITC]” because, “[a]s the *Fintiv* decision explains, although an ITC final invalidity determination does not have preclusive effect, it is difficult as a practical matter to assert patent claims that

the ITC has determined are invalid”). *Fintiv* identifies six factors for the Director to consider in deciding whether to exercise discretion to deny institution based on parallel proceedings involving the same patent. Those factors include:

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. Proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. Investment in the parallel proceeding by the court and the parties;
4. Overlap between issues raised in the petition and in the parallel proceeding;
5. Whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. Other circumstances that impact the Board's exercise of discretion, including the merits.

Fintiv, Paper 11 at 5-6. Here, because ***all six*** *Fintiv* factors favor discretionary denial, the Director should exercise its discretion to deny institution of the Petition.

A. Factor 1 Weighs Against Institution Because a Stay Has Not Been Granted in the Parallel ITC Investigation and There Is No Evidence that a Stay Would Be Granted if This IPR Petition Were Instituted

Petitioner has not requested a stay in the Parallel ITC Investigation. Even if the Petition were instituted, it is highly unlikely that the ITC would issue a stay at this late stage because trial is scheduled to begin on July 9, 2025. Ex. 2001 (Order No. 33 Regarding Hearing Date) at 3. Although the Parallel District Court Litigation is stayed under 28 U.S.C. § 1659 pending the Parallel ITC Investigation, this does not alter the analysis. Ex. 2007 (Order Regarding Stay). In this circumstance, *Fintiv* explains that the focus should be on “whether the patentability disputes before the ITC will resolve all or substantially all of the patentability disputes between the parties, regardless of the [District Court] stay.” *Fintiv* at 9. As explained in greater detail below, Petitioner presents *identical* invalidity grounds in the Parallel ITC Investigation as it does in this Petition. Thus, the ITC will resolve all of the patentability disputes between the parties.

The first factor thus weighs against institution. See *Eunsung Global Corp. v. Hydrafacial LLC*, IPR2024-01491, Paper 17 (“*Eunsung*”) at 11 (finding Factor 1 weighs in favor of discretionary denial when there is no evidence that ITC proceedings will be stayed despite stay of the parallel district court litigation).

B. Factor 2 Weighs Against Institution Because the Parallel ITC Investigation Has a Trial Date and Final Determination Date Scheduled Before the Projected Statutory Deadline for the Board's Final Written Decision

The Guidance Memorandum explains that “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.” Guidance Memorandum at 2. The Board is more likely to deny institution because “instituting an IPR ... where the ITC has set a target date for completing its investigation (i.e., the full Commission’s final determination) to occur earlier than the Board’s deadline to issue a final written decision in a challenge involving the same patent claims means that multiple tribunals may be adjudicating validity at the same time, which may increase duplication and expenses for the parties and the tribunals.” *Id.*; see also *SK Innov. Co., Ltd. v. LG Chem, Ltd.*, IPR2020-01240, Paper 15 (PTAB Jan. 12, 2021) at 16-17 (citing *Garmin Int’l, Inc. v. Koninklijke Philips N.V.*, IPR2020-00754, Paper 11 (PTAB Oct. 27, 2020) at 12; *Comcast Cable Commc’n, LLC v. Rovi Guides, Inc.*, IPR2020-00800, Paper 10 (PTAB October 22, 2020) at 12-13 (considering ITC’s final determination target date when considering *Fintiv* factor 2).

These are the exact circumstances here. Trial in the Parallel ITC Investigation is scheduled for July 9, 2025 and will conclude by July 16, 2025,

over one month before the institution deadline for this Petition. Ex. 2001 (Order No. 33 regarding Hearing Date) at 3. The full Commission is scheduled to reach its final determination on March 23, 2026, *nearly five months before* the final written decision deadline of August 21, 2026. Ex. 2002 (Order No. 20 Regarding Case Schedule) at 7.

Accordingly, the second factor also weighs against institution. *See Eunsung*, Paper 17 at 12 (finding Factor 2 weighs in favor of discretionary denial when, “despite the stay of the district court case, the ITC is scheduled to reach a final determination in December 2025, several months before our final written decision deadline of April 2026”).

C. Factor 3 Weighs Against Institution Because the Parties Will Have Invested Significant Effort in the Parallel ITC Investigation by the Time the Board's Institution Decision Is Due

This factor relates to the investment in the Parallel ITC Investigation by the ITC and the parties. *See Fintiv*, Paper 11 at 9. The Director should look at the amount of investment up to the date of the IPR institution decision. *Id.* Here, an institution decision is expected no later than August 21, 2025. With fact discovery closed and expert discovery almost concluded in the Parallel ITC Investigation, and with the ITC hearing scheduled to take place in July 2025, the parties will have invested substantial time and resources in the Parallel ITC Investigation before the institution decision. Indeed, at least each of the following tasks will have been

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completed with respect to validity of the Challenged Claims in the Parallel ITC

Investigation before the projected date of an institution decision:

1. Petitioner's Preliminary Invalidity Contentions (Oct. 22, 2024)
2. Patent Owner's Preliminary Validity Contentions (Nov. 8, 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. 12, 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 Invalidity Expert (to be scheduled before hearing)
12. Deposition of Validity Expert (to be schedule before hearing)
13. Completion of Expert Discovery (April 11, 2025)
14. Pre-Hearing Briefing on Validity (May 16, 2025)
15. ITC Hearing (July 9-16, 2025)
16. Post-Hearing Briefing on Validity (August 8, 2025)

See Ex. 2001 (Order No. 33 Regarding Hearing Date); Ex. 2002 (Order No. 20 Regarding Case Schedule).

With the ITC hearing scheduled before the institution decision, it is clear that the parties will have invested substantial resources in the Parallel ITC Investigation before the projected date of an institution decision. *See Eunsung*, Paper 17 at 12-13 (finding Factor 3 weighs in favor of discretionary denial where the parties have made substantial investments in view of trial scheduled before the institution decision); *Samsung Electronics Co., Ltd., v. Sionyx, LLC*, IPR2024-01431, Paper No. 21 (“*Samsung*”) at 14 (holding that Factor 3 favors the discretionary denial when the parties have already invested substantial resources and hearing is scheduled before the institution decision).

This factor also considers the Petitioner's lack of diligence in filing the Petition. Here, Petitioner was not diligent. Patent Owner originally asserted the '101 patent in the Parallel District Court Litigation on May 6, 2024, and in the Parallel ITC Investigation on July 16, 2024. *See* Ex. 2003 (Dist. Ct. Cmpl.); Ex. 2004 (ITC Cmpl.). Moreover, Petitioner has been on notice that it infringed the '101 patent since at least March 7, 2023, when Patent Owner sent Petitioner a notice letter. *See* Ex. 2003 (Dist. Ct. Cmpl.) at ¶ 62; Ex. 2004 (ITC Cmpl.) at ¶ 94. Yet, Petitioner waited until January 14, 2025, three months after Petitioner served its preliminary invalidity contentions in the Parallel ITC Investigation, nearly eight months after Patent Owner brought the Parallel District Court Litigation, and nearly two years after it first learned of Patent Owner's allegations that Petitioner

infringed the '101 patent. Petitioner was not diligent in bringing this Petition, which further weighs in favor of discretionary denial. *Cf. Eunsung*, Paper 17 at 13 (finding Factor 3 weighs in favor of discretionary denial “[a]lthough Petitioner was diligent in filing its Petition less than 3 months after the ITC investigation,” because “this diligence does not outweigh the substantial investment made in the ITC proceeding.”)

The third factor thus weighs against institution. *See Eunsung*, Paper 17 at 12-13 (finding Factor 3 weighs in favor of discretionary denial where the parties have made substantial investments in view of trial scheduled before the institution decision); *Samsung*, Paper No. 21 at 14 (holding that Factor 3 favors discretionary denial when the parties have already invested substantial resources and hearing is scheduled before the institution decision).

D. Factor 4 Weighs Against Institution Because There Is Substantial Overlap of Issues Between the Parallel ITC Investigation and the Petition

Petitioner presents in the Parallel ITC Investigation all of the same invalidity grounds stated in this Petition, and therefore, this factor favors denying institution. As *Fintiv* explained, when a petition “includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding,” “concerns of inefficiency and the possibility of conflicting decisions [are] particularly strong.” *Fintiv*, Paper 11 at 12. Here, as shown in the tables below, all

of the invalidity grounds raised by Petitioner in its Petition have also been asserted in the Parallel ITC Investigation:

Invalidity Contentions in Parallel ITC Investigation

Claims	Basis	References
<i>1-2, 10-11, 17-18, 21-22</i>	<i>Anticipation</i>	<i>Ishimaru</i>
<i>1-2, 10-11, 17-18, 20-22</i>	<i>Obvious</i>	<i>Ishimaru in view of Harrison</i>
<i>20</i>	<i>Obvious</i>	<i>Ishimaru</i>
20	Obvious	Ishimaru in view of Johnson
20	Obvious	Ishimaru in view of Harrison and Johnson

Ex. 2005 (Invalidity Expert Report of Dr. Ricketts) at ¶ 91; Ex. 2010 (Invalidity Chart for U.S. Patent No. 8,717,101 based on Ishimaru) at 1.

Grounds in this Petition

Claims	Basis	References
1-2, 10-11, 17-18, 20-22	Obvious	Ishimaru
1-2, 10-11, 17-18, 20-22	Obvious	Ishimaru in view of Harrison

Petition at 28-29. Moreover, Petitioner has not submitted a *Sotera* stipulation in connection with this Petition.¹⁰ Thus, substantial overlap exists between the Parallel ITC Investigation and the Petition. Indeed, many of the annotated figures in Dr. Rickett's Invalidity Report *are identical* to the annotated figures in the Petition. *See, e.g.*, Ex. 1003 (Decl. of Dr. Ricketts) at ¶¶ 93-168; Ex. 2005 (Invalidity Expert Report of Dr. Ricketts) at ¶¶ 255-341.

Petitioner prepared Dr. Ricketts' Invalidity Report contemporaneously with filing the present Petition. At the time Petitioner filed its Petition, it knew that there would be significant overlap between the arguments advanced in the Petition and the arguments made by Petitioner in the Parallel ITC Investigation. If Petitioner now decides to pivot and seek a *Sotera* stipulation, Petitioner's stipulation should be discounted.

¹⁰ A *Sotera* stipulation refers to a stipulation filed in the parallel proceeding that if IPR is instituted, then Petitioner will not pursue in the parallel proceeding the specific instituted grounds or any other ground that was raised or could have been reasonably raised in an IPR (i.e., any ground that could be raised under §§ 102 or 103 on the basis of prior art patents or printed publications). *Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 (PTAB precedential) at 18-19 ("*Sotera*").

First, Petitioner's stipulation would be too late to "mitigate[] any concerns of duplicative efforts between the [parallel proceeding] and the Board, as well as concerns of potentially conflicting decisions." *Sotera* at 19. As explained above with respect to *Fintiv* factor 3, the parties have already submitted contentions and expert reports on validity issues in the Parallel ITC Investigation, and by the time of the institution decision due August 21, 2025, the parties will have already held an ITC Hearing, including on validity issues, and filed their last briefs—the Post-Hearing Briefs—on validity issues in the Parallel ITC Investigation. As such, a *Sotera* stipulation would come far too late to ensure that the IPR proceeding is a "true alternative" to the Parallel ITC Investigation, as required for such a stipulation to weigh in favor of discretionary denial. *Id.*

Second, Petitioner's stipulation would also be procedurally too late for this IPR proceeding. Such a stipulation should have already been made to allow Patent

Owner an opportunity to consider and address the stipulation's scope and impact in this brief requesting discretionary denial.¹¹

The fourth factor thus weighs against institution.

¹¹ Even if Petitioner were to submit a *Sotera* stipulation, such a stipulation “will not be dispositive by itself” and instead should be considered “as part of [the Board’s] holistic analysis under *Fintiv*.” Guidance Memorandum at 2-3; *see also Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, -01206, -01207, -01208, Paper 19 (Director Review) 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”). Here, for all the reasons above, the other *Fintiv* factors weigh strongly in favor of discretionary denial.

E. Factor 5 Weighs Against Institution Because the Patent Owner and the Petitioner Are the Same Parties as in the Parallel ITC Investigation

Patent Owner is the complainant in the Parallel ITC Investigation and Petitioner is one of the respondents in the Parallel ITC Investigation. Thus, Patent Owner and Petitioner are the same parties as in the Parallel ITC Investigation.

Thus, the fifth factor weighs against institution. *See Samsung*, Paper No. 21 at 14 (finding that this factor favors discretionary denial when the parties are the same).

F. Factor 6 Weighs Against Institution Because the Merits of Petitioner's Challenge Are Weak

The Petition presents a weak obviousness case. The grounds in the Petition lack merit, and certainly do not rise to the level of appearing “particularly strong” for purposes of this *Fintiv* factor. *Fintiv*, Paper 11 at 14-15. The grounds raised in the Petition fall short of even raising a close call.

Here, the Petition fails to show that Ishimaru discloses a “the current amplifier including a current mirror” as required by the challenged claims. For this claim element, the Petition does not allege that Ishimaru discloses a current mirror. Petition at 47-51. Instead, the Petition points to Ishimaru's transistor 119 and argues that transistor 119 is a current mirror. *Id.* But Ishimaru does not disclose

that transistor 119 is a current mirror. *See id.* Indeed, Ishimaru makes no reference to a current mirror or mirroring current *anywhere* in its disclosure.

Instead, the Petition attempts to fill the gap of Ishimaru with the “State of the Art” and expert testimony. Petition at 48-51. In particular, the Petition reproduces Figures 6.1a and 6.2a from a reference called Gilbert, and argues Gilbert shows that a POSITA would understand that transistor 119 is a current mirror. *Id.* Gilbert, however, fails to show that transistor 119 in Ishimaru is a current mirror. Ex. 1012 (Gilbert) at 240, 243. Contrary to Petitioner’s argument, Gilbert states there are several practical “objections” to any “proposal” to use a single transistor as a current mirror, all of which are “true.” Ex. 1012 (Gilbert) at 242. For example, Gilbert explains: “[o]f course, the practical objection to this proposal is that the mirror ratio, M , is much higher than generally needed and *poorly-controlled*, being just the common-emitter current-gain, β , and not very linear.” *Id.* (emphasis added). Thus, Gilbert *teaches away* from using a single bipolar junction transistor as a current mirror. The Petition therefore does not present a “particularly strong” case on the merits.

In addition, the Patent Office considered the *identical circuit* disclosed in Ishimaru that is relied upon by Petitioner in the Petition during prosecution of the application that led to U.S. Patent No. 9,917,563, a continuation of the '101 patent, that similarly claims a circuit that mirrors a control current to generate a correction

current. *See* Ex. 2008 (Excerpts from File History for U.S. Patent No. 9,917,563) at 3-7 (Office Action dated Feb. 27, 2017). The Patent Office originally rejected the claims of the '563 patent over the identical circuit feature of Ishimaru (transistor 119) that Petitioner now alleges meets this claim element. *Id.* After the claims were amended to add the claim language “to mirror the control current to generate a correction current,” the Patent Office allowed the claims. Ex. 2008 (Excerpts from File History for U.S. Patent No. 9,917,563) at 13-22 (Response to Office Action dated May 16, 2017), 32-36 (Notice of Allowance). In the “reasons for allowance,” the Patent Office stated that the “prior art of record,” which includes Ishimaru, “considered individually or in combination, fails to fairly teach or suggest the claimed circuit comprising . . . ‘...and to mirror the control current to generate a correction current...’” structurally and functionally interconnected with other limitations in the manner as cited in the claim. *Id.* at 33-34 (Notice of Allowance at 2-3) (underlining in original). The Patent Office thus already found during prosecution of a family member of the '101 patent that the claimed mirroring is (1) **not** disclosed by Ishimaru, and (2) **not** obvious to a POSITA over the prior art of record, including Ishimaru. Because the grounds proposed by the Petition are weak, as evidenced by the Patent Office already rejecting them in a related patent application, this factor weighs against institution.

Further arguments regarding deficiencies in the Petition grounds will be the subject of Patent Owner's Preliminary Response, due May 21, 2025.

Moreover, even if the Petition were found to have "compelling merits" (and it does not), that "alone is not dispositive in making the assessment" under *Fintiv*, which instead calls for "a balanced assessment of all the relevant circumstances in the case." Guidance Memorandum at 3.

In sum, *all six Fintiv* factors weigh against institution. To conserve Board and party resources, and avoid potentially conflicting rulings, the Director should exercise its discretion and deny institution.

V. THE DIRECTOR SHOULD DENY THE PETITION UNDER 35 U.S.C. § 325(D)

The Director should also deny the Petition for the independent reason that under 35 U.S.C. § 325(d) substantially similar arguments were already considered by the Patent Office in the course of granting the '101 patent's claims. *See* Ex. 1002 ('101 Prosecution History) at 88-91 (Office Action dated August 2, 2013 at 2-5). As explained in further detail below, a rejection over U.S. Patent No. 7,869,775 to Alon ("Alon") was overcome during prosecution of the '101 patent. *Id.* at 99-106 (Amendment dated October 31, 2013 at 2-9). Alon's disclosure includes a single transistor that the Patent Office contended operates as a current amplifier, but not a current mirror. *Id.* at 88-90 (Office Action dated August 2, 2013 at 2-4).

The transistor in Alon is substantially similar to Ishimaru's transistor 119 that is relied upon by Petitioner. The Patent Office thus already considered and rejected substantially similar arguments to those being made in the Petition.

The Director "may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d). The Board has applied 35 U.S.C. § 325(d) using the following two-part framework:

- (1) whether the same or substantially similar art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and
- (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims. If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.

Advanced Bionics, Paper 6 at 8-9. This framework reflects the Office's "commitment to defer to previous Office evaluations of the evidence of record unless material error is shown." *Id.* at 9.

A. Substantially The Same Arguments Were Previously Presented To The Patent Office (*Advanced Bionics* Step 1)

The first part of the *Advanced Bionics* framework is satisfied because Petitioner's arguments are substantially the same as those traversed during prosecution of the application that led to the '101 patent.

The Patent Office already considered arguments that are substantially the same as those raised in the Petition, and found the claims patentable over them. The Petition alleges that Ishimaru discloses, or alternatively Ishimaru in view of Harrison teaches, “the current amplifier including a current mirror,” and “amplifying the control current using a current mirror of a current amplifier to generate a correction current,” as required by the Challenged Claims. Petition at 51 (“[T]ransistor 119 as connected in Ishimaru is a current mirror ...”), 65 (“To the extent Patent Owner argues that Ishimaru does not disclose a current mirror, Ishimaru in view Harrison discloses this limitation.”). As explained below, the Patent Office considered a circuit that is substantially the same as the circuit disclosed in Ishimaru that is relied upon by Petitioner in the Petition, rejected the claims over a similar feature (a transistor) that Petitioner alleges meets this claim element, and allowed the claims after they were amended to add this claim language—“the current amplifier including a current mirror” and “amplifying the control current using a current mirror of a current amplifier to generate a correction current”—stating in the “reasons for allowance” that this claim element, as “structurally and functionally interconnected” with the other elements as claimed, was not obvious over the prior art of record.

The Patent Office considered substantially the same arguments during prosecution of the '101 patent as Petitioner raises in its Petition. In a Non-Final

The Patent Office also indicated that dependent application claim 21—which depended from application claim 18—“would be allowable if rewritten in independent form[.]” Ex. 1002 ('101 Prosecution History) at 90 (Office Action dated Aug. 2, 2013 at 4). Application claim 21 additionally recited: “wherein amplifying the control current further includes amplifying the control current using a current mirror of the current amplifier.” *Id.* at 35 (Original Application at 28). The Patent Office thus found that Alon's device 204, which as shown above is a transistor, was not a current mirror as recited in application claim 21.

Responding to the rejection over Alon, Patent Owner amended application claim 1 to recite “the current amplifier including a current mirror,” and claim 18 to recite “amplifying the control current using a current mirror of a current amplifier to generate a correction current[.]” Ex. 1002 ('101 Prosecution History) at 99, 102 (Amendment dated October 31, 2013 at 2, 5). Patent Owner agreed with the Patent Office and argued that changing the claim language to recite a “current mirror” distinguished the invention claimed in the '101 patent from the prior art of record. *Id.* at 105-106 (Amendment dated October 31 2013 at 8-9). Patent Owner's statements during prosecution of the '101 patent refute the arguments raised in the Petition, specifically Petitioner's contention that a single transistor (such as Ishimaru's transistor 119) mirrors a control current to generate a correction current. Petition at 57-48 (“[T]ransistor 119 is a current amplifier including a current mirror

(gold) in that transistor 119 is configured to replicate (i.e. mirror) and scale (amplify the I_{CONTROL} (red arrow) to generate the $I_{\text{CORRECTION}}$ (gold arrow).”).

Further, the Patent Office agreed with Patent Owner, stating in the “reasons for allowance” that the prior art of record¹² “fails to fairly teach or suggest the claimed circuit comprising ... ‘...the current amplifier including a current mirror’ structurally and functionally interconnected with other limitations in the manner as cited in the claim.” Ex. 1002 (’101 Prosecution History) at 124 (Notice of Allowance at 2) (emphasis in original).

As such, the Patent Office already considered whether the Challenged Claims of the ’101 patent would have been obvious over a circuit substantially similar to Ishimaru, and found that a current mirror, as structurally and functionally interconnected with the other elements as claimed, was nonobvious. The first part of the *Advanced Bionics* framework is therefore satisfied. *See Gator Bio, Inc. v.*

¹² Petitioner relies on Harrison only for its alleged teaching of current mirrors (Petition at 65-78), but the prior art of record before the Patent Office included teachings of current mirrors. *See, e.g.,* Ex. 2009 (Alon) at 6:52-54 (“The transistor 274 and the transistor 282 form a current mirror such that the value of the current I_{ref} is proportional to the current I_{out} .”), Fig. 2. Harrison is therefore also cumulative of art considered during prosecution of the ’563 patent.

Sartorius Bioanalytical Instruments, Inc., No IPR2023-00215, Paper 19 at 17-19, 22 (denying institution where the challenges set forth in the Petition are based on the same or substantially the same prior art or arguments previously presented to the Office during patent examination).

**B. Petitioner Has Made No Showing Of Material Examiner Error
(*Advanced Bionics* Step 2)**

The second part of the *Advanced Bionics* framework is satisfied because Petitioner has not shown that the Patent Office erred in a manner material to patentability. *Advanced Bionics*, Paper 6 at 9; Petition at 80. For *Advanced Bionics* Step 2, the Petitioner must affirmatively demonstrate that the Patent Office committed material error in issuing the challenged patent. *See Advanced Bionics*, Paper 6 at 9 (“At bottom this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.”).

Petitioner identifies no error by the Patent Office, let alone a material error. The Board consistently exercises its discretion to deny institution in circumstances where a petitioner does not address whether the Patent Office materially erred. *See, e.g., Darfon Elecs. Corp. v. Michael Shipman*, IPR2022-01008, Paper 11 at 14 (exercising its discretion under 35 U.S.C. § 325(d) to not institute a petition because the art was substantially the same as art previously presented to the Patent

Office and petition did not explain any material error by the Patent Office);

Wolfspeed, Inc. v. The Trustees of Purdue Univ., IPR2022-00761, Paper 9 at 14-15 (same).

As explained above, the Petition presents substantially the same arguments previously presented during prosecution. Petitioner has also failed to demonstrate any material error by the Patent Office. The Director should therefore exercise its discretion and deny institution under 35 U.S.C. § 325(d). *Advanced Bionics*, Paper 6 at 7-9.

VI. ADDITIONAL FACTORS SET FORTH IN THE DIRECTOR MEMORANDUM SUPPORT DISCRETIONARY DENIAL

The Workload Management Memorandum also identifies additional discretionary considerations, including “[t]he extent of the petition’s reliance on expert testimony” and “[s]ettled expectations of the parties, such as the length of time the claims have been in force.” Workload Management Memorandum at 2. Here, institution should be denied under 35 U.S.C. § 314(a) because of the Petition’s improper reliance on expert testimony, as well as the settled expectations arising from the length of time that the ’101 patent claims have been in force.

First, the Petition here improperly relies on expert testimony in an attempt to fill in the gaps of the prior art, rather than interpreting what is expressly disclosed. The Petition does not identify any disclosure in Ishimaru that explains how

transistor 119 mirrors a control current to generate a correction current. Instead, the Petition relies on the alleged “State of the Art” and expert testimony to attempt to fill in the gaps based on impermissible hindsight, using the ’101 patent as a roadmap. Using an expert to fill gaps is improper. *See* 35 U.S.C. § 311(b) (“[a] petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and ***only on the basis of prior art consisting of patents or printed publications.***”). It is especially improper here, where the Patent Office during prosecution of a related patent already considered whether a skilled artisan would have found the claims obvious over the same prior art disclosures and concluded that they ***failed*** to disclose “a gain correction circuit configured to ... mirror the control current to generate a correction current.” Ex. 2008 (Excerpts from File History for U.S. Patent No. 9,917,563) at 33-34 (Notice of Allowance at 2-3).

For example, the Petition argues that “[c]onsistent with the discussion of current mirrors in the State of the Art section, transistor 119 as connected in *Ishimaru* is *configured to mirror...*” Petition at 48. The Petition further argues that “[w]hen connected as shown in *Ishimaru*, transistor 119 takes the general, three node form set out by Barrie Gilbert and Gray for a current mirror.” *Id.* The Petition then attempts to use Barrie Gilbert and Gray to explain how this transistor is allegedly a current mirror. *Id.* at 48-50.

The Petition's use of the "State of the Art" and Petitioner's expert testimony do not interpret Ishimaru, but impermissibly attempt to add disclosure to the prior art to meet missing claim limitations. For example, Petitioner uses only expert testimony in an attempt to rewrite Ishimaru to disclose a current mirror when Ishimaru makes no reference to a current mirror or mirroring current *anywhere* in its disclosure. This goes beyond interpreting the prior art and instead attempts to supply missing elements, which runs afoul of 35 U.S.C. § 311(b).

Second, the settled expectations of the parties favor discretionary denial. The claims of the '101 patent have been in force for over a decade (since 2014), and were allowed over substantially similar arguments the Petition now presents. Ex. 1001 ('101 patent) at cover page. Patent Owner (and the public) thus had a long-settled expectation that the '101 patent would not be challenged by these same arguments again. Moreover, Patent Owner gave Petitioner notice of infringement of the '101 patent in March 2023, over two years ago. *See* Ex. 2003 (Dist. Ct. Cmpl.) at ¶ 62; Ex. 2004 (ITC Cmpl.) at ¶ 94. Until Petitioner served its preliminary invalidity contentions on October 22, 2024, Petitioner never alleged that any claim in the '101 patent was invalid. Petitioner's silence only further confirms Patent Owner's (reasonable) long-standing expectation that the arguments Patent Owner had already overcome during prosecution would not be raised again. In short, the settled expectations of the parties weighs against institution.

These additional factors favor discretionary denial of the Petition.

VII. CONCLUSION

Institution of this Petition should be denied under 35 U.S.C. § 314(a) based on the totality of the circumstances. *All six Fintiv* factors weigh heavily against institution. Institution of this Petition should also be denied under 35 U.S.C. § 325(d) because substantially similar arguments were already made to the Patent Office during prosecution and overcome. Finally, in addition to the *Fintiv* factors, the discretionary considerations identified in the Workload Management also favor discretionary denial.

Dated: April 22, 2025

Respectfully submitted,

/Haixia Lin/

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CERTIFICATE OF COMPLIANCE

I hereby certify that the foregoing Patent Owner's Brief in Support for Discretionary Denial contains 6,886 words as measured by the word processing software used to prepare the document, in compliance with the Memorandum by the Acting Director dated March 26, 2025, titled "Interim Processes for PTAB Workload Management."

By: /Daniel S. Perry/
Daniel S. Perry
Reg. No. 70,709

CERTIFICATE OF SERVICE

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

- Patent Owner's Brief in Support of Discretionary Denial
- Certificate of Compliance Under 37 CFR §42.24(d)
- Patent Owner's Exhibit List
- Exhibits 2001-2010

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

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