

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONEPLUS TECHNOLOGY (SHENZHEN) CO., LTD.

Petitioner

v.

PANTECH CORPORATION

Patent Owner

IPR2025-00637

U.S. PATENT 9,763,283

PETITIONER'S REQUEST FOR DIRECTOR REVIEW

LIST OF EXHIBITS

Exhibit	Description
EX1001	U.S. Patent No. 9,763,283 to Jung <i>et al.</i>
EX1002	Prosecution History of U.S. Patent No. 9,763,283
EX1003	Declaration of Dr. Robert Akl
EX1004	U.S. Patent No. 10,631,222 to Dudda <i>et al.</i>
EX1005	U.S. Provisional Application No. 61/754,322 in the name of Dudda <i>et al.</i>
EX1006	International Patent Application Publication No. 2014/110813 in the name of Lin <i>et al.</i>
EX1007	U.S. Patent Application Publication No. 2011/0134774 in the name of Pelletier <i>et al.</i>
EX1008	“LTE; Evolved Universal Terrestrial Radio Access (E-UTRA); Physical Layer Procedures (3GPP TS 36.213 version 11.0.0 Release 11),” ETSI TS 136 213 V11.0.0 (2012-10), available at https://www.etsi.org/deliver/etsi_ts/136200_136299/136213/11.00.00_60/ts_136213v110000p.pdf
EX1009	“LTE; Evolved Universal Terrestrial Radio Access (E-UTRA) and Evolved Universal Terrestrial Radio Access Network (E-UTRAN); Overall Description; Stage 2 (3GPP TS 36.300 version 11.3.0 Release 11),” ETSI TS 136 300 V11.3.0 (2012-11), available at https://www.etsi.org/deliver/etsi_ts/136300_136399/136300/11.03.00_60/ts_136300v110300p.pdf
EX1010	“LTE; Evolved Universal Terrestrial Radio Access (E-UTRA); Medium Access Control (MAC) Protocol Specification (3GPP TS 36.321 version 11.0.0 Release 11),” ETSI TS 136 321 V11.0.0 (2012-10), available at https://www.etsi.org/deliver/etsi_ts/136300_136399/136321/11.00.00_60/ts_136321v110000p.pdf
EX1011	E. Dahlman <i>et al.</i> , “4G LTE/LTE Advanced for Mobile Broadband,” 1st ed. Elsevier, 2011
EX1012	U.S. Patent No. 9,814,075 to Kim <i>et al.</i>
EX1013	U.S. Patent Application Publication No. 2012/0281548 in the name of Lin <i>et al.</i>
EX1014	U.S. Patent Application Publication No. 2013/0028069 in the name of Pelletier <i>et al.</i>

Exhibit	Description
EX1015	U.S. Patent No. 9,118,452 to Park <i>et al.</i>
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EX1017	A. Atayero, <i>et al.</i> , “3GPP Long Term Evolution: Architecture, Protocols and Interfaces,” International Journal of Information and Communication Technology Research, Volume 1, No. 7, November 2011
EX1018	Declaration of Zhe Wang
EX1019	Declaration of Jia Hui Jiang
EX1020	Correspondence with Patent Owner dated May 22, 2025
EX1021	<i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:24-cv-00038-RWS-JBB (E.D. Tex.), Dkt. No. 1, Complaint for Patent Infringement
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EX1024	“Albright Worried Multipatent Trials Ask Too Much Of Jurors,” Law360 (Dec. 18, 2020), at https://www.law360.com/articles/1337976/albrightworriedmultipatent-trials-ask-too-much-of-jurors
EX1025	<i>Sonos Inc. v. D&M Holdings, Inc.</i> , 1:14-cv-01330-WCB (D. Del.), Dkt. No. 418, Discovery Dispute Letter Brief
EX1026	<i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:24-cv-00038-RWS-JBB (E.D. Tex.), Plaintiff’s Patent Infringement Contentions
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Exhibit	Description
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EX1031	<i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:22-cv-00069-RWS (E.D. Tex.), Dkt. No. 259, Verdict Form
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EX1033	<i>Pantech Corp. et al. v. Oneplus Tech. (Shenzhen) Co., Ltd.</i> , 5:22-cv-00069-RWS (E.D. Tex.), Dkt. No. 502-1, Redacted Version of Court's Order (Dkt. No. 498)
EX1034	<i>Pantech Corp. v. OnePlus Tech. (Shenzhen) Co., Ltd.</i> , 5:24-cv-00038-RWS-JBB, (E.D. Tex.), Dkt. No. 85, Order
EX1035	<i>Pantech Corp. v. OnePlus Tech. (Shenzhen) Co., Ltd.</i> , 5:24-cv-00038-RWS-JBB, (E.D. Tex.), Dkt. No. 86, Third Amended Docket Control Order

All emphases in quotations are added unless otherwise noted.

Petitioner respectfully requests that the Director vacate the Decision Granting Patent Owner’s Request for Discretionary Denial of *Inter Partes* Review (“IPR”) of U.S. Patent No. 9,763,283 (the “’283 Patent”) (Paper 17, “DD Decision”) and refer this proceeding to the Board for consideration.

A. Changed Circumstances Warrant Referral to the Board

Since the DD Decision, a related IPR (IPR2025-00763, the “’763 IPR”) filed by Petitioner against U.S. Patent No. 11,212,838—one of the patents asserted in the same parallel district court litigation¹ as the ’283 Patent—has been referred to the Board for consideration of the merits and non-discretionary factors because Patent Owner did *not* seek discretionary denial. *See OnePlus Technology (Shenzhen) Co., Ltd. v. Pantech Corp. et al.*, IPR2025-00763, Paper 4, (August 18, 2025).

In addition to the ’763 IPR, two other related IPRs (IPR2025-00762 and IPR2025-00756) are also likely to be referred to the Board. These two IPRs challenge two additional patents asserted in the same parallel litigation: U.S. Patent Nos. 10,863,573 and 10,764,803. EX1021, 4; EX1026, 3-4. Both patents have been in force for less than five years, *not* creating strong settled expectations. The final written decisions (FWDs) of these two IPRs will likely be issued before the district

¹ *Pantech Corp. et al. v. OnePlus Tech. (Shenzhen) Co., Ltd.*, No. 5:24-cv-00038-RWS-JBB (E.D. Tex.) (“*Pantech IP*”). EX1021, 4; EX1026, 2-3.

court trial, as the Director has found in this proceeding. *See* DD Decision, 2. Accordingly, these two IPRs are likely to be referred to the Board as well, potentially resulting in at least three asserted patents being adjudicated by the Board.

This development materially changes the circumstances. Referring the instant IPR to the Board alongside the '763 IPR promotes efficiency and consistency by allowing the Board to address the patentability of all patents asserted in the same parallel litigation in a single forum. Piecemeal adjudication in two separate forums risks inconsistent outcomes and unnecessary duplication of effort.

This approach is consistent with *Advanced Micro Devices, Inc. et al. v. Concurrent Ventures, LLC et al.*, IPR2025-00478, in which the Director found that referring a challenged patent to the Board was an efficient use of Board resources when another patent involved in the same parallel district proceeding had already been referred to the Board, *despite the challenged patent having been in force for over ten years, creating strong settled expectations for the patent owner. See Advanced Micro Devices, Inc. et al. v. Concurrent Ventures, LLC et al.*, IPR2025-00478, Paper 10 at 2-3 (Director July 31, 2025) (“AMD”).

The change in circumstances by itself now tips the balance in favor of referral and warrants granting this Request. *See Arm Ltd. et al. v. Daedalus Prime LLC*, IPR2025-00207, Paper 14, at 2-3 (Director, August 6, 2025) (“Arm”)

(vacating a prior discretionary denial decision based on a *single* intervening change in circumstances).

B. Petitioner Provided Persuasive Evidence Supporting Board Review

The DD Decision denied referral primarily based on purported “strong settled expectations” for Patent Owner. DD Decision, 2. **The new fact that the related ’763 IPR has been referred to the Board, combined with the earlier FWD date and a material examiner error, further tips the balance of factors in favor of referral now.** *See Arm*, Paper 14, at 2-3.

The DD Decision acknowledged that some factors weighed against discretionary denial, including that the FWD here will likely be issued *before* the district court trial. DD Decision, 2.

In addition, in addressing Patent Owner’s argument under 35 U.S.C. § 325(d), Petitioner demonstrated that the examiner committed a material error affecting the patentability of the challenged claims by failing to find and appreciate that Dudda², Lin³, and Pelletier⁴ each independently disclose the allowable features of the claims related to the PUCCH Limitation. DD Opp., 7-13, 25-27, 35-37; *see Eunsung Global*

² US10,631,222, issued April 21, 2020 (EX1004).

³ WO2014/110813, published July 24, 2014 (EX1006).

⁴ US2011/0134774, published June 6, 2011 (EX1007).

Corp. v. HydraFacial LLC, IPR2025-00445, Paper 14 at 2-3 (Director, July 10, 2025) (finding discretionary denial unwarranted *despite the patent having issued in 2017* because the examiner overlooked prior art that appeared to disclose the allowable features of the claims); *Anthony Inc. v. Controltec LLC*, IPR2025-00559, Paper 9 at 2 (Director, July 16, 2025) (finding discretionary denial unwarranted *despite the patent having being in force for about 17 and 18 years* because the examiner overlooked a new prior art reference).

The new mix of factors in this IPR now makes it closely parallel to the recent *Phelan* decision where the Director found that discretionary denial is *not* appropriate on balance when (i) the FWD will likely be issued before the district court trial, and (ii) the related patent asserted in the same parallel litigation has been reviewed by the Board, demonstrating a reasonable likelihood of unpatentability—even though the challenged patent there has been in force for longer than the '283 Patent here. *See Mercedes-Benz Group AG v. The Phelan Group, LLC*, IPR2025-00758, Paper 8 at 2 (Director, August 14, 2025) (“*Phelan*”) (citing *Mercedes-Benz Group AG v. The Phelan Group, LLC*, IPR2025-00413, Paper 13 at 2 (Director, June 25, 2025)). Likewise, here (i) the projected FWD date precedes the district court trial, (ii) the related '763 IPR has already been referred to the Board, and (iii) the evidence supports a material examiner error, raising serious patentability issues.

Referral here, in view of the change of circumstances, would also

“maintain consistency with Discretionary Decisions that the Director has already issued,” such as *Arm, AMD, Phelan, Eunsung, and Anthony Inc. See Interim Director Discretionary Process, Sec. I.A.*⁵

C. Retroactive Application of the Process Memorandum Violates Due Process and the APA

The instant IPR was filed on March 18, 2025—before issuance of the *Interim Processes for PTAB Workload Management* (“Process Memo”), which introduced the “settled expectations of the parties” as a new discretionary denial factor for the first time. The Process Memo’s retroactive application prejudices Petitioner as it imposes new legal consequences on Petitioner’s past filing decision, which was made without knowledge of the new process and new factor. *See Landgraf v. USI Film Prods.*, 511 U.S. 244, 269–70 (1994) (explaining that retroactivity is defined by “whether the new provision attaches new legal consequences to events completed before its enactment”).

Congress has not authorized the USPTO to promulgate retroactive rules. *See* 35 U.S.C. §§ 2(b)(2), 316(a); *Tafas v. Dudas*, 511 F. Supp. 2d 652, 666 (E.D. Va. 2007) (PTO lacks authority to promulgate retroactive rules absent express authorization). Retroactive application also violates due process because Petitioner

⁵ <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>.

lacked “fair warning” that its decision to file on March 18, 2025 would later be subject to and adjudicated under a newly introduced process and factor. *See Mexichem Fluor, Inc. v. EPA*, 866 F.3d 451, 462 (D.C. Cir. 2017).

The Process Memo’s retroactive effect further violates the Administrative Procedure Act (“APA”) because it (i) did not undergo notice-and-comment rulemaking, and (ii) operates as an arbitrary and capricious retroactive rule. *See* 5 U.S.C. §§ 553(b), 706(2)(A).

For the reasons set forth above, Petitioner respectfully requests that the Director grant this Request for Director Review, vacate the DD Decision, and refer this IPR to the Board for an institution decision.

Respectfully submitted,

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CERTIFICATION UNDER 37 C.F.R. § 42.24

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Request for Director Review complies with the 15-page limit exclusive of the parts exempted as provided in 37 C.F.R. § 42.24(a).

/Zhiwei Zou/
Zhiwei (Wayne) Zou
Registration No. 66,041
Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **Petitioner's Request for Director Review** were served on August 26, 2025, via email, as agreed to by counsel of record for the Patent Owner, at the following.

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Dated: August 26, 2025

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