

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

WILUS INSTITUTE OF STANDARDS AND TECHNOLOGY INC.,
Patent Owner

Case IPR2025-00933
U.S. Patent No. 11,470,595

PETITIONER'S REQUEST FOR REHEARING

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I. Introduction

In its Decision Denying Institution of *Inter Partes* Review (Paper 12, “Decision Denying Institution”), the Board found that “Petitioner takes alternative positions on claim construction before the Board and a district court, but fails to explain why alternative positions are warranted.” Paper 12, 6. In reaching this decision, the Board misapprehended Petitioner’s district court claim construction positions. In district court, Petitioner has unequivocally and irrevocably contended that no terms of U.S. Patent No. 11,470,595 (“the ’595 Patent”) are indefinite or require construction. With this position, Petitioner’s PTAB and district court claim constructions are perfectly aligned and, in fact, identical. Because Petitioner’s PTAB and district court claim constructions are consistent, the Board’s institution decision rested on misapprehension of an inconsistency that does not exist.

The Board also overlooked or misapprehended the preliminary nature of the evidence it relied upon in finding inconsistency. In reaching its decision, the Board did not review any claim construction filing made in district court. Instead, the Board based its decision exclusively on an email exchange between counsel related to “Defendants’ P.R. 4-1 Exchange of Proposed Terms.” Ex. 2015. The P.R. 4-1 deadline is merely a deadline to “Exchange Proposed Claim *Terms*” and comes before even the P.R. 4-2 deadline to “Exchange *Preliminary* Claim Constructions.” Ex. 2001, 5. Without doubt, the evidence relied on in the institution decision was not

Petitioner’s final position on claim construction; it came before preliminary claim constructions were even exchanged and did not have any explanation of why any claim term should be construed in any particular way. By denying institution based on preliminary—and ultimately, premature—evidence, the Board failed to consider Petitioner’s position on claim construction, overlooking or misapprehending the preliminary nature of the evidence on which it relied.

Indeed, had Petitioner provided an explanation of the potential indefiniteness argument it was considering, but did not advance, the Board would have seen that the potential argument was still consistent with the positions advanced in the Petition. As explained in § IV below, the potential indefiniteness argument—that is not being advanced—related only to the outer bounds of claim scope and did not prevent application of prior art to the claims of the ’595 Patent. In this regard, Petitioner always considered the claims of the ’595 Patent to be met by “the total bandwidth information” and the Petition consistently applied prior art to that feature.

Further, as explained in § V below, the Board’s failure to give Petitioner an opportunity to explain its positions on claim construction and the Board’s denial of Petitioner’s request to submit evidence of the actual claim construction filings from the co-pending district court litigation violates due process and fundamental principles of fairness. In *Revvo*, the Director recognized that his “decision *clarifies* how a petitioner should approach different claim construction positions and how the

Office will assess those positions” and authorized additional briefing from the parties to address the clarification. *Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.*, IPR2025-00632, Paper 20 at 5 (PTAB Nov. 3, 2025) (precedential) (emphasis added). In contrast to the approach taken by the Director, here, the Board issued an institution decision a mere *four* days after the *Revvo* decision and a mere *two* days after the *Tesla* decision. The institution decision also came more than *five weeks* before the Board’s deadline and was premised on a *preliminary email* exchanged while claim construction in the district court was in its infancy. By moving so quickly and failing to consider the full record of claim construction filings in district court, the Board deprived Petitioner of the opportunity to explain its positions on claim construction in light of the Director’s clarification, and prevented Petitioner from correcting the record with its actual claim construction positions. These actions were inconsistent with Board practice, as well as the Director’s guidance in *Revvo*, and should be corrected through vacatur of the denial of institution and consideration of Petitioner’s explanations/evidence.

Finally, as explained in § VI below, the Board misapprehended or overlooked the authority it had to reconsider issues of discretion. In the October 10, 2025 referral decision, the Director instructed the Board to issue “a decision on institution addressing the merits and other non-discretionary considerations.” Paper 11, 5. The Board’s decision was neither on the merits, nor on other non-discretionary

considerations. It was, instead, a decision on discretion that the Board lacked the authority to make.

For these reasons, Petitioner respectfully requests that the Board reconsider its institution decision and review the Petition on its merits.

II. The Board Misapprehended Petitioner's District Court Claim Construction Positions As Being Different From Its PTAB Claim Construction Positions — They Are Not

In the co-pending district court litigation, Petitioner filed its opening claim construction brief on November 18, 2025.¹ In that brief, Petitioner, unequivocally and irrevocably, took the position that no constructions were necessary for the '595 Patent. Petitioner did not argue indefiniteness for any term. Nor did Petitioner argue that any term required construction. For these reasons, Petitioner's claim construction position in district court is identical to its claim construction position here. Paper 2 (Petition), 3. To avoid any doubt, Petitioner stipulates that it will not argue indefiniteness for any term of the '595 Patent and will not pursue any formal constructions for the '595 Patent in co-pending litigation. Thus, Petitioner's claim construction positions before the district court and the PTAB are identical.

¹ Defendants' Responsive Claim Construction Brief (Doc. 188) in *Wilus Institute of Standards and Technology Inc. v. Samsung Electronics Co., Ltd. et al.*, No. 2:24-cv-00746 [Lead Case No. 2:24-cv-00752-JRG] (E.D.T.X. Nov. 18, 2025).

Notably, in *Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.*, the Director stated that “[t]he Board’s claim construction rules are designed to ensure that the Board correctly construes claims and to minimize inconsistency in claim construction between forums.” IPR2025-00632, Paper 20 at 4–5 (PTAB Nov. 3, 2025) (precedential); *see also Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 at 4–5 (PTAB Nov. 5, 2025) (informative). By discontinuing pursuit of any indefiniteness arguments before the district court, Petitioner has eliminated any risk of “inconsistency in claim construction between the forums” and thus “further[s] ... the Office’s goal of ‘providing greater predictability and certainty in the patent system.’” *See Revvo* at 4; *Tesla* at 4 (quoting *Revvo* at 4–5). The Director’s decisions in *Revvo* and *Tesla* are simply not relevant here because Petitioner’s claim construction positions in both proceedings are consistent and do not include indefiniteness. Because Petitioner’s claim construction positions in district court are consistent with the claim construction positions in the petition, there is no basis for denial under *Revvo/Tesla* and the Board should reverse its institution decision based on misapprehension of Petitioner’s district court claim construction positions.

III. The Board Misapprehended Or Overlooked The Preliminary Nature Of The Evidence Relied On In Denying Institution

As indicated by the schedule in Ex. 2001, at the time of the Board’s Decision on November 7, 2025, claim construction had only just begun. Indeed, Petitioner

had not yet submitted its brief on claim construction due on November 18, 2025.

In its Decision Denying Institution, the Board stated that “Petitioner takes alternative positions on claim construction before the Board and a district court.” ID, 6. However, the evidence on which the Board formed this conclusion was preliminary. In particular, the Board relied on Patent Owner’s citation to an email dated August 27, 2025, from Petitioner’s counsel to Patent Owner’s counsel, offering a preliminary identification of terms that Petitioner reserved the right to argue were “indefinite.” *Id.*, 7 (citing POPR, 10 (citing EX2015, 1)); EX2015, 1. That email identified four terms from the ’595 Patent:

- | |
|---|
| 11,470,595 |
| · “explicitly indicated” (claims 1, 7) |
| · “the total bandwidth information” (claim 7) |
| · “a center 26-tone resource unit” (claims 3, 9) |
| · “the center 26-tone resource unit” (claims 4, 10) |

EX2015, 1. As the email indicated, it related to “Defendants’ P.R. 4-1 Exchange of Proposed Terms.” Ex. 2015. The P.R. 4-1 deadline is merely to “Exchange Proposed Claim *Terms*” and comes before even the P.R. 4-2 deadline to “Exchange *Preliminary* Claim Constructions.” Ex. 2001, 5. Had the Board considered Petitioner’s P.R. 4-1 submission,² the Board would have seen that Petitioner

² Patent Owner elected not to submit the P.R. 4-1 submission and the Board denied Petitioner’s request to submit evidence clarifying the record with this Request.

“reserve[d] the right to modify the list” and “anticipate[d] that the parties may be able to narrow the list of terms and phrases to be construed.” Thus, the Board’s institution decision was not based on Petitioner’s district court claim constructions; it was based on a preliminary listing of proposed claim terms that was subject to change as the litigation progressed.

Indeed, the preliminary nature of the P.R. 4-1 submission and the corresponding email relied on by the Board is evident at least because, by the time the Board issued its Decision on November 7, 2025, Petitioner had already dropped all but one term from its list of proposed terms for construction.^dIn this regard, the claim construction process in district court evolved as intended with Petitioner’s preliminary list of terms identified in its P.R. 4-1 disclosure being narrowed.

In fact, as claim construction briefing progressed, Petitioner streamlined its claim constructions, eliminating from consideration all terms from the ’595 Patent.³ Given the fluid posture of the district court’s claim construction process, the Board relied on premature evidence in reaching its decision to deny institution. The Board should, thus, reconsider its institution decision and evaluate the actual claim constructions Petitioner ultimately advanced in district court. By overlooking or misapprehending the preliminary nature of the email evidence on which it based its

³ *Supra* note 1.

decision, the Board failed to consider Petitioner's claim construction positions in the district court. Petitioner simply requests the Board to review the actual claim construction filing in the district court to assess whether any inconsistency exists.

IV. The Indefiniteness Theory Petitioner Considered But Did Not Advance for “the Total Bandwidth Information” Was Consistent With the Petition

The Petition clearly stated that, for purposes of the IPR, “no formal claim constructions are necessary because ‘claim terms need only be construed to the extent necessary to resolve the controversy.’” Pet., 3 (quoting *Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011)). That statement was and remains true. Only claim 7 of the '595 Patent recites “the total bandwidth information.” The preliminary indefiniteness theory that Petitioner was considering related to a lack of antecedent basis for this term. That legal argument does not prevent application of prior art to the term.

Petitioner also was considering ambiguity in the outer bounds of the term “total.” However, the Petition's mapping of the prior art to the term is unequivocally within the bounds of the term, as informed by the '595 Patent.

Indeed, with respect to “the total bandwidth information,” the '595 Patent's specification offers as an example that “[t]he bandwidth field indicates the *total bandwidth* in which the corresponding PPDU is transmitted.” SAMSUNG-1001, 19:9-11 (emphasis added). “That is, the bandwidth field of the HE MU PPDU

consists of 3 bits and indicates one of 20 MHz, 40 MHz, 80 MHz, and 160 MHz (including 80+80 MHz)” *Id.*, 19:53-56.

The grounds presented in the Petition align with this description in the ’595 Patent. *See* Pet., 12–13, 53–55. For example, the Petition cites to Chen’s teaching that the “HE-SIG-A may carry an indication of the *total channel bandwidth available* in MU-MIMO mode (e.g, 20 MHz channel, 40 MHz channel or 80 MHz channel). Pet., 54 (emphasis altered) (quoting SAMSUNG-1008, [0061]). The applicant did not dispute that this disclosure provides “the total bandwidth information” element during prosecution. *See* Pet., 54 (citing SAMSUNG-1002, 68, 120). In fact, both the applicant and Examiner treated claim 1 (then pending claim 19), which recites only “bandwidth information,” as exemplary of claim 7 (then pending claim 25). *See, e.g.*, SAMSUNG-1002, 67-70, 55. Petitioner does the same. Pet., 4. Thus, the Petition’s mapping of the prior art is consistent with the ’595 Patent’s exemplary descriptions of the “total bandwidth information.”

V. The Board’s Failure to Allow Petitioner to Explain its Claim Construction Positions and Refusal to Consider the Claim Construction Filings in the District Court Was Unfair and Violates Due Process

The Board’s failure to give Petitioner an opportunity to explain its claim construction positions and the Board’s denial of Petitioner’s request to submit evidence of the actual claim construction filings from the co-pending district court litigation violate due process and fundamental principles of fairness. The *Revvo*

decision issued and was designated precedential on November 3, 2025, wherein the Director recognized that his “decision *clarifies* how a petitioner should approach different claim construction positions and how the Office will assess those positions” and authorized additional briefing from the parties to address the clarification. *Revvo* at 5 (emphasis added). The *Tesla* decision issued and was designated informative November 5, 2025. A mere *four* days after the *Revvo* decision and a mere *two* days after the *Tesla* decision, the Board issued its institution decision, leaving Petitioner practically no time to address the Director’s clarification.

Additionally, in contrast to the Director’s clarification in *Revvo* and receptiveness to “additional briefing,” here, the Board afforded Petitioner no such opportunity. *Revvo* at 5; *see id.*, Paper 22 at 2 (PTAB Nov. 18, 2025) (authorizing 12-page briefs). Indeed, consideration of developments in co-pending litigation after institution denial and later correction based on new evidence and arguments is not new. In *Advanced Micro Devices, Inc. et. al. v. Concurrent Ventures, LLC et. al.*, then-Acting Director Stewart granted Petitioner’s request for rehearing of the Decision granting Patent Owner’s request for discretionary denial after Petitioner contended that “significant developments have occurred since the Decision that warrant reconsideration.” IPR2025-00223, Paper 12 at 2–3 (PTAB Aug. 14, 2025). The original Decision was based on the district court trial date being scheduled after the projected final written decision deadline. However, since the denial, the district

court stayed all deadlines pending venue discovery and a motion to transfer venue, and also canceled the scheduled *Markman* hearing. Because of these new developments, then-Acting Director Stewart reconsidered and ultimately reversed her earlier decision. *Id.* The same remedy is appropriate here.

More, the institution decision issued more than *five weeks* before the Board's deadline and was premised on a *preliminary email* exchanged during early district court discussions concerning claim construction. The Board's deadline for issuing its Institution Decision was December 16, 2025. Given the district court's claim construction briefing schedule, with Petitioner's Responsive Claim Construction Brief due November 18, 2025, by issuing its Decision Denying Institution early and failing to consider the full record of claim construction filings in district court, the Board deprived Petitioner of the opportunity to explain its positions on claim construction in light of the Director's clarification and further prevented Petitioner from correcting the record with its actual claim construction positions. These actions were inconsistent with Board practice, as well as the Director's guidance in *Revvo*, and should be corrected through vacatur of the denial of institution.

VI. The Board Misapprehended or Overlooked Its Authority To Revisit Discretionary Considerations After The Director Resolved Discretion And Ordered The Board To Issue A Decision On The Merits And Non-Discretionary Considerations

In the referral decision of October 10, 2025 (Paper 11), the Director made a

decision that resolved discretionary denial in favor of institution. In that decision, the Director referred the petition to the Board to issue “a decision on institution addressing the merits and other non-discretionary considerations.” Paper 11, 5. With that action, the Director placed limits on the issues that the Board could consider in its institution decision. Those limits were clear and did not permit the Board to revisit discretionary denial. By denying institution on alleged claim construction inconsistency, the Board overlooked or misapprehended those limits.

Specifically, claim construction consistency is a consideration related to discretionary denial and the Board overstepped its bounds by denying institution on that basis. Indeed, claim construction consistency is not a statutory requirement set forth by Congress. Nor is it the subject of a USPTO rule. 37 C.F.R. § 42.104(b)(3) merely states that the Petitioner must state “[h]ow the challenged claim is to be construed.” The Petition here clearly met this requirement on page 3 by stating its position that “no formal claim constructions are necessary.” The rules do not require more, nor do they speak to consistency with constructions in co-pending litigation. In fact, the Director has made it clear that a petition can move forward when a petitioner takes inconsistent claim construction positions, if it accords with the Director’s discretion. *Revvo* at 5.

Recent decisions by the Director confirm that claim construction consistency is an issue confined to the Director’s discretion. For example, in IPR2025-01095,

IPR2025-01100, and IPR2025-01120, the Director considered discretion and decided to proceed with a review of the merits and non-discretionary considerations. IPR2025-01095, Paper 16. After that decision, the Patent Owner asked the Director to reconsider the decision on discretion based on the new precedent established by the *Revvo/Tesla* decisions. The Director obliged and considered the Patent Owner's arguments related to claim construction consistency made after the Director's initial decision on discretion. Upon reconsideration, the Director determined that discretionary denial was warranted based on the new arguments that Patent Owner raised related to the *Revvo/Tesla* decisions. IPR2025-01095, Paper 17. In the new decision, the Director made it clear that the *Revvo/Tesla* arguments relate to discretionary considerations and resulted in a discretionary denial. *Id.* (“Although previously referred, this case is now ***discretionarily*** denied in view of *Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.*, IPR2025-00632, Paper 20 (Squires Nov. 3, 2025) (precedential)”). Indeed, the Director grouped the *Revvo/Tesla* denials with other petitions denied “after review of ***discretionary*** considerations,” distinct from petitions to “be reviewed for ***merits and non-discretionary*** considerations” and petitions reviewed on “the merits.” *Id.*

If there was any doubt as to whether *Revvo/Tesla* relate to discretionary denial, the Office's website settles it. In its listing of precedential and informative decisions, the Office lists *Revvo* and *Tesla* as decisions pertaining to 35 U.S.C. § 314(a) with

other decisions clearly directed to discretion, such as those pertaining to *Fintiv*. See

<https://www.uspto.gov/patents/ptab/precedential-informative-decisions>.

▼ Institution, 35 U.S.C. § 314(a)

Precedential

- **Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.**, IPR2025-00632, Paper 20 (November 3, 2025) (designated: November 3, 2025) [AIA – a petitioner must explain why it takes different claim construction positions in the petition and in district court; merely adopting a patent owner’s district court claim construction is not sufficient] (*sua sponte* Director Review decision)
- **CommScope Techs. LLC. v. Dali Wireless, Inc.**, IPR2022-01242, Paper 23 (February 27, 2023) [AIA – ordering rehearing, vacating decision granting institution, and remanding proceeding to the Board; the Board must first address *Fintiv* factors 1-5, and should engage the compelling merits question only if that

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- **NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.**, Case IPR2018-00752, Paper 8 (September 12, 2018) [deny institution – prior art previously considered, co-pending district court proceeding nearing completion]
- **Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha** (§ II.B.4.i), Case IPR2016-01357 et al., Paper 19 (September 6, 2017) [discretionary factors re: multiple petitions]

Informative

- **Tesla, Inc. v. Intellectual Ventures II LLC**, IPR2025-00340, Paper 18 (November 5, 2025) (designated: November 5, 2025) [AIA – a petitioner’s explanation that it could not argue indefiniteness in an IPR is insufficient to show why different claim construction positions are warranted in district court and at the Board] (Director Review decision)

For these reasons, claim construction consistency pursuant to *Revvo/Tesla* is part of discretion, not the merits or other non-discretionary criteria that the Board was instructed to consider. Thus, the Board’s denial of institution under *Revvo/Tesla* was a reconsideration of discretion that was not authorized by the Director.

The proper procedural course should have been one where the Board decided the merits and non-discretionary considerations and left it to the Patent Owner to request the Director to reconsider his decision on discretion. Because the Board overlooked or misapprehended the limits placed on its review by the Director, the Board should vacate its decision on institution, consider the merits of the petition, and issue a new institution decision that is limited to the merits and non-discretionary

considerations. Patent Owner would not be prejudiced by that course of action because it is the one the Board should have taken in the first instance. Patent Owner also would still have the right to request Director Review of the decision on discretion, as was done in IPR2025-01095. More, in the Decision Referring the '595 Petition to the Board, Chief Judge Deshpande agreed that "Petitioner provides persuasive evidence that the Office erred in a manner material to the patentability of the challenged claims" in "overlooking the teachings of Noh." Paper 11, 3–4. By discretionarily denying institution, the Board denied the Office the opportunity to correct the Examiner's earlier material error.

For these reasons, which are independent of the merits of claim construction consistency and would absolve the Board from having to resolve those arguments, the Board should vacate its prior decision and issue a new decision on the merits.

VII. Conclusion

For the foregoing reasons, Petitioner respectfully requests that the Board grant Petitioner's request for rehearing and grant institution of *inter partes* review.

Respectfully submitted,

Dated December 8, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on December 8, 2025, a complete and entire copy of this Petitioner's Request for Rehearing was provided by email to the Patent Owner by serving the correspondence email address of record as follows:

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