

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

---

**AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST**

**TABLE OF CONTENTS**

I. Introduction.....1

II. Patent Owner’s Allegations are Moot and Do Not Warrant Director Review2

**A.** Timeline of This Proceeding and Petitioner’s District Court Filings ...2

**B.** Patent Owner’s Arguments Are Based Only on Pre-Institution District Court Filings and Are Contrary to Petitioner’s Confirmation of Adherence to Its *Fintiv* Stipulation .....4

III. Conclusion .....5

## I. Introduction

Patent Owner's Request for Director Review ("the Request") of the Decision Granting Institution of *Inter Partes* Review ("the Institution Decision") (Paper 15) fails to establish any abuse of discretion, important issues of law or policy, erroneous findings of material fact, or erroneous conclusions of law and should thus be denied. Director Review Process, Section 2.B, *available at* <https://www.uspto.gov/patents/ptab/decisions/director-review-process>.

Patent Owner's Request argues that Petitioner's district court filings are inconsistent with Petitioner's *Fintiv* stipulation (Ex. 1023) that represented that, "if the PTAB institutes review in this proceeding, Samsung with not pursue in District Court litigation combinations of the prior art asserted in this proceeding with unpublished system prior art (or any other type of prior art)." *See* Request, 2. The only basis for Patent Owner's argument, however, is Petitioner's filings that occurred *pre-institution*. Since institution, Petitioner has only confirmed, more specifically, to Patent Owner and to the Board that it "will not pursue, in the district court litigation, (1) the Bharadwaj 129 prior art reference that is the primary reference in grounds 2A-2D in IPR2025-00988, (2) the Josiam reference that is the primary reference for grounds 1A and 1B in IPR2025-00933, or (3) any other prior art used in an invalidity ground in either IPR."

As such, Patent Owner's Request is moot and irrelevant to Petitioner's stipulation compliance. Patent Owner's accusation that Petitioner "br[oke] those promises" "to the PTAB regarding their future conduct in the co-pending District Court litigation" is baseless, and none of Petitioner's actions merit any conclusion that there was an "erroneous finding[] of material fact" or and any matter presenting an "important issue[] of law or policy." *See* Request, 7. Therefore, Patent Owner's Request should be denied.

## **II. Patent Owner's Allegations are Moot and Do Not Warrant Director Review**

### **A. Timeline of This Proceeding and Petitioner's District Court Filings**

At the time of filing its Petition on May 13, 2025, Petitioner stipulated that, "if the PTAB institutes review in this proceeding, Samsung will not pursue in District Court litigation the specific grounds asserted in inter partes review in this proceeding, or any other ground that could have been reasonably raised in this proceeding (i.e., any ground that could have been raised under §§ 102 or 103 on the basis of prior art patents or printed publications)," and that, "if the PTAB institutes review in this proceeding, Samsung will not pursue in District Court litigation combinations of the prior art asserted in this proceeding with unpublished system prior art (or any other type of prior art)." Ex. 1023. On October 10, 2025, Then-Acting Chief Administrative Patent Judge Deshpande issued a decision referring the instant Petition to

the Board. Paper 11, 5. On November 7, 2025, the Board issued its decision denying institution. Paper 12, 7. On December 8, 2025, Petitioner filed a Request for Rehearing, respectfully requesting the Board to reconsider its institution decision. Paper 13. The Board granted Petitioner's rehearing request on December 31, 2025, vacating the decision denying institution and indicating that "a decision on whether to institute *inter partes* review will be entered in due course." Paper 14, 6.

During that time, the co-pending district court litigation continued, with claim construction, fact discovery, and expert discovery ongoing. Because the Board had not instituted *inter partes* review of the instant Petition, Samsung presented invalidity positions, unaffected by the *Fintiv* stipulation because the conditional event (institution) had not triggered any limitation to Samsung's invalidity options. For instance, Samsung's Secondary Election of Prior Art, filed *pre-institution* on January 6, 2026, included, among the prior art comprising invalidity grounds for U.S. Patent No. 10,687,281, U.S. Patent Publication No. 2016/0330300A1 ("Josiam"), which is the primary reference for grounds 1A and 1B in the instant Proceeding. Ex. 2016, 1-2. In another example, Samsung filed the Corrected Expert Report of Harry Bims on January 30, 2026, *pre-institution*, which included various invalidity grounds. *See* Request, 3-4.

The next month, on February 9, 2026, the Board issued its decision granting institution of the instant Proceeding. Paper 15, 31-32.

**B. Patent Owner's Arguments Are Based Only on Pre-Institution District Court Filings and Are Contrary to Petitioner's Confirmation of Adherence to Its *Fintiv* Stipulation**

The sole bases for Patent Owner's Request are documents that Petitioner filed before the Board's February 9 Institution Decision. *See* Request, 3-6 (citing to Samsung's expert report filed January 30, 2026 and to Samsung's January 6, 2026 prior art submission). Patent Owner cites to nothing that Samsung offered *post-institution* where Samsung affirmatively maintains any invalidity ground that includes prior art asserted in this proceeding. *See id.* Rather, as Patent Owner admits in its Request, Petitioner has instead *confirmed the opposite*:

Shortly before Patent Owner filed this Request, IPR counsel for Petitioner emailed Patent Owner and the Board stating that Samsung would not "pursue", in District Court combinations of prior art for that include "any [] prior art used in an invalidity ground" in either the -00988 or this -00933 IPRs. *See* 2/23/26 email from Monaldo to Director\_PTABDecision\_Review@uspto.gov (1:17 p.m. Pacific Time).

Request, 1 n.1.

Thus, Patent Owner's accusations that Petitioner is "swapping" prior art references between the '281 and '595 Patents and assertions that Petitioner's conduct

contradicts its earlier representation are plainly baseless and further rendered moot by Petitioner's February 23, 2026 email to the Board and to Patent Owner. *See* Request, 5-6. Therefore, Patent Owner has no valid basis for requesting Director Review of the Institution Decision as there is no abuse of discretion, important issue of law or policy, erroneous finding of material fact, or erroneous conclusion of law.

### **III. Conclusion**

Patent Owner's Request for Director Review of the Institution Decision should be denied. The Director should permit the instituted IPR in this proceeding to proceed.

Respectfully submitted,

Dated March 3, 2026

/Jeremy J. Monaldo/

W. Karl Renner, Reg. No. 41,265  
Jeremy J. Monaldo, Reg. No. 58,680  
Jennifer J. Huang, Reg. No. 64,297  
Fish & Richardson P.C.  
60 South Sixth Street, Suite 3200  
Minneapolis, MN 55402  
T: 202-783-5070  
F: 877-769-7945

*Attorneys for Petitioner*

**CERTIFICATE OF SERVICE**

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on March 3, 2026, a complete and entire copy of this Authorized Response to Director Review Request was provided by email to the Patent Owner by serving the correspondence email address of record as follows:

Reza Mirzaie  
Neil A. Rubin  
Philip X. Wang  
Linjun Xu  
RUSS, AUGUST & KABAT  
12424 Wilshire Boulevard, 12th Floor  
Los Angeles, CA 90025

Email: [rak\\_wilus@raklaw.com](mailto:rak_wilus@raklaw.com)  
[rmirzaie@raklaw.com](mailto:rmirzaie@raklaw.com)  
[nrubin@raklaw.com](mailto:nrubin@raklaw.com)  
[pwang@raklaw.com](mailto:pwang@raklaw.com)  
[lxu@raklaw.com](mailto:lxu@raklaw.com)

          /Diana Bradley/            
Diana Bradley  
Fish & Richardson P.C.  
60 South Sixth Street, Suite 3200  
Minneapolis, MN 55402  
[bradley@fr.com](mailto:bradley@fr.com)