

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 No. IPR2025-00935
U.S. Patent No. 11,129,163

**PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW OF
INSTITUTION DECISION**

TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	LEGAL STANDARD	1
III.	GROUND 1A-1D: BOARD ERRONEOUSLY DISREGARDED PROSECUTION STATEMENTS IN FINDING THAT LEE RENDERED OBVIOUS THE INDEPENDENT CLAIMS	1
IV.	GROUND 2A-2C: BOARD ERRONEOUSLY FAILED TO CONSIDER PATENT OWNER’S ARGUMENTS	3
V.	CONCLUSION	4

I. Introduction

Patent Owner respectfully requests Director Review of the November 6, 2025 Decision Granting Institution of *Inter Partes* Review (Paper 13). For the reasons stated below, Patent Owner believes the Director erred by disregarding statements made in prosecution and failed to consider arguments made in the Patent Owner's Preliminary Response.

II. Legal Standard

Director review of a Board decision on institution is warranted when the request presents "(a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law." Director Review Process, Section 2.B (available at <https://www.uspto.gov/patents/ptab/decisions/director-review-process>, last accessed March 26, 2025). This request addresses both erroneous findings of fact and errors of law.

III. Grounds 1A-1D: Board Erroneously Disregarded Prosecution Statements in Finding that Lee Rendered Obvious the Independent Claims

The Institution Decision erred in equating Lee's not performing a CCA change with the claims' "not to use BSS color" in element [1.4]. ID at 11. The prosecution history already demonstrated that not performing a color-dependent operation is not the equivalent of not using the BSS color. During

the prosecution, the independent claims initially recited “not to perform an operation based on a Basic Service Set (BSS) color.” Ex. 1002 at 257. The examiner rejected this element under Noh. Noh discloses not setting an Intra-BSS (NAV) if the BSS color signaled is different from the BSS color of the receiving STA. Ex. 1002 at 188. Similar to a CCA change, setting Intra-BSS NAV is also “an operation based on the BSS color.” To distinguish Noh, the claims were amended to “not to use a Basic Service Set (BSS) color” instead of “not to perform an operation based on a Basic Service Set (BSS) color.” Ex. 1002 at 171, 177. The examiner then agreed that Noh does not teach the newly amended “not to use Basic Service Set (BSS) color.” Ex. 1002 at 142. This file history shows that not performing a color-based operation does not disclose “not to use a BSS color.”

Here, Lee discloses that CCA level change is *not performed*. Ex. 1005 at Abstract; ID at 11. Lee's disclosure of no CCA level change irrespective of the information in the coloring bit, which the Institution Decision relied on, is a non sequitur. Since CCA level change is a color-based operation, it is not surprising that this non-performance is without regard to the BSS color values (since the color value is irrelevant if the color-based operation is not performed to begin with). Similar to Noh, which Patent Owner overcame with

the amendment, here Lee's non-performance of a color-based operation does not satisfy the requirement of "not to use a BSS color."

IV. Grounds 2A-2C: Board Erroneously Failed to Consider Patent Owner's Arguments

As to Choudhury, the Institution Decision erred because it failed to consider in its brief analysis the argument made by Patent Owner that Choudhury's 1 bit does not disclose the claimed "signaling information indicates that an operation based on the BSS color is not allowed." POPR at 13-15. Choudhury's 1 bit indicates whether the device is a lower-power device. POPR at 13-14. It does not indicate "an operation based on the BSS color is not allowed."

The Institution Decision also erred in finding that the element "not to use a BSS color when an operation based on the BSS color is not allowed" still encompasses using BSS color to determine if a receiving station is in a particular BSS. ID at 12 ("it is not entirely clear that comparing a BSS color value to determining if a receiving station is in that BSS prohibited by the claim's recitation 'not to use' a BSS color."). This determination runs directly afoul of the claim language, which says "not to use a BSS color." Moreover, neither the Petitioner nor the Institution Decision provided any support for the proposition that comparing whether a data unit is in the same BSS would meet

Patent Owner's Request for Director Review of Institution Decision
IPR2025-00935 (U.S. Patent No. 11,129,163)

the claim element of “an operation based on the BSS color is not allowed,”
which seems to be what the Institution Decision is mapping.

V. Conclusion

For the foregoing reasons, Wilus respectfully requests that the Director
grant Director Review and deny institution of this IPR.

Dated: November 20, 2025

/Neil A. Rubin/

Reza Mirzaie (Reg. No. 69,138)
Neil A. Rubin (Reg. No. 67,030)
Philip X. Wang (Reg. No. 74,621)
Linjun Xu (Reg. No. 73,887)
RUSS AUGUST & KABAT
12424 Wilshire Boulevard, 12th Floor
Los Angeles, CA 90025
Telephone: 310-826-7474
Email: rmirzaie@raklaw.com
Email: nrubin@raklaw.com
Email: pwang@raklaw.com
Email: lxu@raklaw.com

Attorneys for Patent Owner,
WILUS INSTITUTE OF
STANDARDS AND TECHNOLOGY
INC.

Patent Owner's Request for Director Review of Institution Decision
IPR2025-00935 (U.S. Patent No. 11,129,163)

CERTIFICATE OF SERVICE

I hereby certify that "Patent Owner's Request for Director Review of Institution Decision" was served on November 20, 2025 by email sent to:

W. Karl Renner
Jeremy J. Monaldo
FISH & RICHARDSON PC
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
Telephone: 202-783-5070
Email: renner@fr.com
Email: jjm@fr.com
Email: IPR39843-0196IP1@fr.com
Email: PTABInbound@fr.com

Dated: November 20, 2025

/Neil A. Rubin/