

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SHENZHEN QIANFENYI INTELLIGENT TECHNOLOGY CO., LTD.,  
(A.K.A. MAXEYE)  
Petitioner,

v.

WACOM CO. LTD.,  
Patent Owner.

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Case IPR2025-01596  
Patent 10,108,277

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**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL**

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**PATENT OWNER'S EXHIBIT LIST**

Exhibit No.	Description
2001	Second Amended Complaint, <i>Wacom, Co., Ltd. v. Shenzhen Qianfenyi Intelligent Technology Co., Ltd.</i> , Civ. No. 2:24-cv-702 (E.D. Tex. Oct. 27, 2025)
2002	Defendant's Preliminary Invalidity Contentions, <i>Wacom, Co., Ltd. v. Shenzhen Qianfenyi Intelligent Technology Co., Ltd.</i> , Civ. No. 2:24-cv-702 (E.D. Tex. Mar. 4, 2025)
2003	Agreed Docket Control Order, <i>Wacom, Co., Ltd. v. Shenzhen Qianfenyi Intelligent Technology Co., Ltd.</i> , Civ. No. 2:24-cv-702 (E.D. Tex. Feb. 6, 2025)
2004	U.S. District Courts - Federal Court Management Statistics– Comparison Within Circuit (June 30, 2025) (available at <a href="https://www.uscourts.gov/sites/default/files/document/fcms_na_distcomparison0630.2025.pdf">https://www.uscourts.gov/sites/default/files/document/fcms_na_distcomparison0630.2025.pdf</a> ) (annotated)
2005	Memorandum Order, <i>Headwater Research LLC v. Samsung Electronics Co., Ltd.</i> , Civ. No. 2:23-CV-00103 (Dec. 11, 2024)

## IPR2025-01596 Patent Owner's Request for Discretionary Denial

Pursuant to the Director's Memorandum issued on March 26, 2025, Patent Owner Wacom Co. Ltd. ("Patent Owner" or "Wacom") files this request and brief on discretionary denial, setting forth reasons why the Director should exercise discretion to deny the Petition for *inter partes* review ("IPR") of claims 1-5, 7-12, 14-18, and 20-24 of U.S. Patent No. 10,108,277 (the "'277 patent"), as requested by Shenzhen Qianfenyi Intelligent Technology Co., Ltd. (a.k.a Maxeye) ("Petitioner" or "Maxeye").

### **I. INTRODUCTION**

Petitioner waited more than a year after the initiation of the parallel district court litigation, and roughly five years after learning of Patent Owner's patent portfolio, to file this Petition. As a result of Petitioner's extensive and unexplained delay, the '277 patent is the subject of a parallel district court infringement proceeding that is already well underway, with trial scheduled for July 2026. In contrast, a final written decision in this proceeding would not be expected until April 2027, over nine months after the scheduled district court trial date. Indeed, an institution decision will not be due in this proceeding until April 8, 2026, less than three months before the district court's Final Pretrial Conference on June 1, 2026, and only four months before trial is scheduled to begin.

Therefore, the parties will litigate, and the district court will resolve the same validity issues Petitioner raises here (and more) long before an IPR final

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written decision could issue in this proceeding. Allowing the IPR to proceed would constitute an inefficient use of Office resources, a fact reinforced by Petitioner's delay in filing its parallel IPRs—several years after Petitioner was placed on notice of Patent Owner's portfolio and more than a year after Patent Owner initiated district court litigation. Also confirming the inefficiency of allowing this IPR to proceed is Petitioner's inconsistent positions on claim construction between the district court proceeding and here. Petitioner does not even alert the Board to its inconsistent claim construction positions, much less explain them away. Thus, discretionary denial here is appropriate.

Further, the '277 patent benefits from strong settled expectations given its seven-year existence, recognized commercial value, and Patent Owner's established licensing practices of standards-essential patents. The '277 patent, developed by and issued to Wacom, represents a valuable asset within the stylus technology industry and is a standards-essential patent. Since developing the '277 patent, Patent Owner has maintained an active licensing program and has consistently demonstrated its willingness to license its standards-essential patents. Coupled with the advanced state of the parallel district court litigation, the strong settled expectations for the '277 patent provide compelling reasons for the Director to discretionarily deny the Petition.

## II. ARGUMENT

The Petition should be denied in view of the fact that trial will occur in the parallel litigation involving Petitioner and Patent Owner well before a final written decision could issue in this IPR proceeding, and the strong settled expectations of the '277 patent.

### A. The Scheduled Trial Date and Advanced State of District Court Activities Weigh in Favor of Denial

Prior to raising the present dispute in district court, as early as 2020, Patent Owner approached Petitioner offering to license certain standards-essential stylus patents owned by Wacom. Ex2001, ¶¶16-27. Despite being made aware of Patent Owner's stylus patent portfolio in 2020, Petitioner did not begin to file its IPRs against Patent Owner's portfolio until late 2025, and Petitioner has now filed four such IPRs.<sup>1</sup> Even those IPRs were filed at nearly the last possible moment before Petitioner's statutory bar date. Patent Owner initiated district court action on August 28, 2024, and Petitioner became aware of that action at least by September 19, 2024. Due to service requirements to a Chinese company, service was not perfected until October 17, 2024, as Petitioner concedes. Pet., 2. Nevertheless,

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<sup>1</sup>Petitioner has filed validity challenges against Patent Owner in IPR2025-01495, IPR2025-01533, IPR2025-01556, and IPR2025-01596.

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Petitioner waited a full year after the filing of the district court action before it began filing its IPRs, and it completed its four filings on September 30, 2025.

The District Court trial is scheduled to commence on July 6, 2026. Ex2003. Due to Petitioner's delay, and the pace that courts in the United States can resolve disputes, trial in the parallel district court case is scheduled to occur many months before a final written decision could be expected in this proceeding, around April 8, 2027. This nine-month difference in timing is also consistent with the time-to-trial statistics for the Eastern District of Texas, which predict trial around September 2026 (a six-month difference). Ex2004 (annotated) (showing a 25.1 month time-to-trial for period ending June 30, 2025).

Indeed, even before the Board's April 8, 2026 deadline for deciding whether to institute this proceeding, the parties will have fully briefed claim construction to the District Court, the District Court will have conducted a Markman Hearing (on January 13, 2026), and the parties will have completed expert discovery, with Rebuttal Expert Witness reports due on March 9, 2026 and an expert discovery deadline of March 23, 2026. *See* Ex2003, 3-4. At that point, the parties will be scrambling to complete all necessary litigation activities leading up to the Final Pretrial Conference on June 1, 2026. Ex2003, 2. Even if the District Court's trial date shifts closer to the statistical trial date of September 2026, the parties and

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District Court will have invested significant effort in the litigation before the Board's Institution Decision issues.

Moreover, it would be unprecedented for the District Court for the Eastern District of Texas to stay a parallel case if an IPR were to be instituted here, because Petitioner has only challenged four of the seven patents involved in the parallel proceeding. The uniform practice in EDTX has been to proceed to trial when only a subset of patents involved in the case are the subject of parallel Patent Office proceedings, as is the case here. *See, e.g., Headwater Research LLC v. Samsung Electronics Co., Ltd.*, Civ. No. 2:23-CV-00103, slip. op. at 4 (Dec. 11, 2024) (“Here, the PTAB decided to deny institution on one of the IPRs for the ’733 patent and denied institution for the ’117 patent...As such, even an ultimate finding in favor of Samsung invalidating all claims of the patents in the instituted IPRs would leave material disputes for the Court to decide. This factor weighs against a stay.”) (submitted as Ex2005).

Other details support discretionary denial so that the resolution of the parties' dispute can play out fully and completely in District Court. For example, Petitioner's challenges in this IPR are based on 35 U.S.C. §103, and rely on the Yoshida, Ikeda, and Iguchi references. Petitioner has presented overlapping invalidity contentions in the parallel District Court proceeding. *See, e.g., Ex2002, 26-29* (pdf page) (citing Yoshida, Ikeda, and Iguchi). In addition, in District Court,

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Petitioner contends that claim 2 of the '277 patent “contradicts, rather than narrows, the claim from which it depends” (Ex2002, 36-37 (pdf page)) but makes no such contention, or even suggestion, here that the construction of the '277 patent in this IPR possesses these complications. Petitioner applies the prior art without noting any contradiction in claim 2, and without raising this issue to the Board. *See* Pet., 43-47, 83-85; *see also* Pet., 6 (“Petitioner is not conceding that each Challenged Claim satisfies all statutory requirements, nor is Petitioner waiving any arguments concerning claim scope or grounds that can only be raised in district court.”). These details further support discretionary denial. *See Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 (November 5, 2025) (informative) (a petitioner’s complaint that it could not argue indefiniteness in an IPR is insufficient to warrant a petitioner advancing inconsistent claim construction positions in district court and before the Board).

Thus, Petitioner’s inclusion of the same and other inconsistent invalidity theories in District Court as compared to this proceeding, along with the significantly earlier outcome of the parallel litigation, ensure that this IPR would be an inefficient use of Office resources. Not only will the District Court be able to address any additional issues Petitioner presents exclusively there, but if Petitioner succeeds in invalidating the '277 patent in district court litigation, then this IPR would not be needed. On the other hand, if Patent Owner is successful in

defending the '277 patent's validity in the parallel litigation, then that outcome should also be persuasive evidence to the Board that the same outcome should be reached here. Either way, an outcome in District Court is scheduled to occur well before a final decision would be reached in this IPR, and this timing weighs strongly in favor of discretionary denial.

**B. Strong Settled Expectations Favor Denial**

Also weighing in favor of discretionary denial, the '277 patent has strong settled expectations. The '277 patent is over seven (7) years old, having issued on Oct. 23, 2018. It was filed by, and issued to Patent Owner, Wacom (Ex1001), a practicing Japanese stylus manufacturer with a United States presence.

In addition, Patent Owner is a willing licensor of the standards-essential patents in its stylus patent portfolio. As noted above, prior to raising the present dispute in District Court, as early as 2020, Patent Owner approached Petitioner with an offer to license certain standards-essential patents in Patent Owner's patent portfolio, and specifically notified Petitioner about the '277 patent in a letter dated December 4, 2023. Ex2001, ¶¶16-27.

Thus, the commercial activities relating to inclusion as a standards-essential patent and activities relating to licensing of standards-essential patents in Patent Owner's stylus patent portfolio show that the '277 patent has a recognized value in the industry. Now, Maxeye, a Chinese corporation, seeks to invoke the power of

the Board in an attempt to maintain sales of imported Chinese goods into the United States without respecting the value of the '277 patent. The Director should decline Maxeye's invitation to upset the settled expectations of the '277 patent. As a matter of policy, the IPR system should not be employed by petitioners as a tool for hold outs to gain leverage in negotiations against a willing licensor of a standards-essential patent.

### III. CONCLUSION

When considered individually, the early scheduled trial date, the advanced stage of the co-pending litigation, and the strong settled expectations each weigh strongly in favor of discretionary denial and would be sufficient to warrant denial. However, when these factors are evaluated together, discretionary denial is extremely compelling and should be granted.

For the reasons presented above, Patent Owner respectfully asks that the Director exercise discretion to deny the Petition. No *inter partes* review should be instituted.

Dated: December 5, 2025

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**CERTIFICATE OF SERVICE**

I hereby certify that on this date, a true and correct copy of the foregoing document was served via email, by consent, to Petitioner by serving the correspondence email address of record as follows:

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