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Subject: IPR2023-01091; IPR2023-01092; IPR2023-01093 - Request for Director Review
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The Honorable Kathi Vidal
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Dear Director Vidal:

Petitioner Samsung Electronics Co., Ltd. respectfully seeks Director Review of a Board panel's decisions to deny institution under *Fintiv* of three related IPRs (IPR2023-01091, -01092, -01093) challenging claims of U.S. Patent No. 11,201,500 ("'500 patent"), asserted by Patent Owner Mojo Mobility Inc. in the Eastern District of Texas. The Board's denial of institution, and its assessment of *Fintiv* factors 1-5, is irreconcilable with a decision by a different Board panel to reject a *Fintiv* challenge and institute review in another set of IPRs (IPR2023-01089 and IPR2023-01090) between the *same* parties, involving a related U.S. Patent No. 11,292,349 ("'349 patent"), asserted in the *same* district court litigation with the *same* projected trial date and the *same* procedural background, and the *same* stipulation offered by Petitioner that is slightly narrower than in *Sotera*. As the dissenting APJ in this case explained—in a criticism that echoes the reasoning of the Board panel in the '349 patent IPR—the panel majority here misapprehended the status of investments in the litigation, incorrectly discounted the non-overlapping claims created by Patent Owner's later narrowed infringement contentions, and improperly discounted Samsung's stipulation because it did not exactly mirror a *Sotera* stipulation. The two panels' treatment of the relevant *Fintiv* factors based on the same underlying litigation and the same essential facts—such as Samsung's *Sotera*-like stipulation—is in direct conflict with each other. The Director's intervention is needed to correct the Board's abuse of discretion in denying review in these proceedings, to restore consistency in the Board's *Fintiv* decisions, and to clarify the proper weight of *Sotera*-like stipulations.

A list of the issues for which Samsung seeks review is as follows:

1. The Board panel's abuse of discretion in finding that *Fintiv* factors 1-5 weigh against institution, in direct contrast to a different Board panel's assessment of the same *Fintiv* factors in instituting review in a proceeding involving the *same* parallel district court litigation and the *same Sotera*-like stipulation offered by Petitioner.
2. The important legal and policy issue of first impression regarding the proper weight to be accorded under *Fintiv* to a stipulation that is similar, but not identical, to a *Sotera* stipulation.

Accordingly, the Director should grant review for each of the three '500 patent IPRs, instruct the Board that discretionary denial under *Fintiv* is inappropriate, and remand the case for institution consideration consistent with the Director's decision. Petitioner has concurrently filed the attached requests for Director Review via P-TACTS in each of the above-identified IPR proceedings.

Regards,

Joseph Palys
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Counsel for Petitioner

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