

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

INTEL CORPORATION,
Petitioner,

v.

PROXENSE LLC,
Patent Owner.

IPR2025-00327 (Patent 9,265,043 B2)
IPR2025-00328 (Patent 8,219,129 B2)
IPR2025-00329 (Patent 8,457,672 B2)

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

DECISION

Granting Patent Owner's Request for Discretionary Denial and Denying
Institution of *Inter Partes* Review

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Proxense LLC (“Patent Owner”) filed a request for discretionary denial (Paper 7, “DD Req.”) in the above-captioned cases, and Intel Corporation (“Petitioner”) filed an opposition (Paper 9, “DD Opp.”).¹

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is appropriate in these proceedings. This determination is based on the totality of the evidence and arguments the parties have presented.

Some facts counsel against discretionary denial. For example, the parties recently notified the Office that there no longer is an underlying district court trial date. Ex. 3101.

However, the considerations favoring discretionary denial outweigh those that counsel against it. In particular, the challenged patents have been in force over nine years, creating settled expectations, and Petitioner does not provide any persuasive reasoning why an *inter partes* review is an appropriate use of Board resources. *Dabico Airport Solutions Inc. v. Axa Power Aps*, IPR2025-00408, Paper 21 at 2–3 (Acting Director Stewart June 18, 2025). There may be persuasive reasons why the Board should review challenged claims several years after their issuance date. For example, a significant change in law may have occurred since the patent issued, and a petitioner can explain how that change in law directly bears on the patentability of the challenged claims. As another example, a patent may have been in force for years but may not have been commercialized, asserted, marked, licensed, or otherwise applied in a petitioner’s particular

¹ Citations are to papers in IPR2025-00327. The parties filed similar papers in IPR2025-00328 and IPR2025-00329.

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technology space, if at all. These non-exclusive examples provide considerations that weigh against a patent owner's claim of settled expectations and bears on the Director's discretion. In the absence of any such information, however, such as in the present proceedings, the Office is disinclined to disturb the settled expectations of Patent Owner.

Although certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petition is denied under 35 U.S.C. § 314(a).

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is *granted*; and

FURTHER ORDERED that the Petition is *denied*.

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