

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. AND
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

POWER2B INC.,
Patent Owner.

IPR2021-01190 (Patent 10,156,931 B2)¹
IPR2021-01220 (Patent 8,610,675 B2)
IPR2021-01239 (Patent 8,624,850 B2)
IPR2021-01257 (Patent 9,317,170 B2)
IPR2021-01266 (Patent 9,569,093 B2)

Before BARBARA A. PARVIS, SHEILA F. McSHANE, and
JOHN D. HAMANN, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 U.S.C. § 42.5

¹ We exercise our discretion to issue a single Order, to be filed in each case. The parties are not authorized to use this caption for subsequent papers.

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On November 4, 2021, the Board received an email from Petitioner requesting leave to file a preliminary reply in each of the above identified proceedings to address claim construction rulings from a related district court litigation and to respond to certain of Patent Owner's arguments related to discretionary denial under 35 U.S.C. § 325(d). Patent Owner opposes the request.

A conference call was held on November 10, 2021. Petitioner asserts that additional claim construction briefing is required because the District Court in related litigation, *Power2B, Inc. v. Samsung Electronics Co., Ltd.*, Case No. 6:20-cv-01183-ADA (W.D. Tex.), recently conducted a claim construction hearing and issued a claim construction order. Petitioner argues that the District Court found one challenged patent invalid for indefiniteness and broadly construed claim terms in other patents. Petitioner requests additional briefing to explain why the petitions are not affected by the claim constructions, including providing legal support that *inter partes* review should be granted for the case where the patent was found invalid in a district court claim construction order. Patent Owner argues that additional briefing is not required because there are no resulting changes to the assertions made in the papers as they stand as a result of the District Court claim constructions, including Patent Owner's arguments on the merits.

Petitioner also requests that additional briefing be permitted on issues related to discretionary denial under § 325(d). Petitioner asserts, for example, that Patent Owner made arguments based on alleged cumulative prior art from the file histories of patents not at issue which cover similar

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subject matter. Petitioner argues that Patent Owner had taken differing positions on the relationship of the patents that are the basis of the § 325(d) assertions. Patent Owner alleges that Petitioner was aware of the patents that are the basis of the arguments, and Petitioner should have previously addressed the related § 325(d) issues in the Petition.

37 C.F.R. § 42.108(c) states that a petitioner “may seek leave to file a reply to the preliminary response” and that “[a]ny such request must make a showing of good cause.” We determine that good cause exists for additional briefing related to claim construction because at the time the Petition was filed the District Court had not yet ruled on claim construction issues. We also find that good cause exists for additional briefing on § 325(d) because some of the issues that Patent Owner raised in its preliminary responses could not have been reasonably anticipated by Petitioner at the time of the filing of the petitions.

Therefore, we authorize Petitioner to file a preliminary reply in each case limited to addressing the potential effects of the District Court’s claim constructions, as well as Patent Owner’s § 325 (d) arguments in the Preliminary Response. We also authorize Patent Owner to file a preliminary sur-reply in each case limited to responding to Petitioner’s reply. The preliminary replies and preliminary sur-replies will each be limited to five pages. The deadlines for filing the preliminary replies and preliminary sur-replies are set forth in the Order below.

Additionally, in response to a Board question, Petitioner stated that the letters containing stipulations that were filed in the respective cases

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relating to § 314(a) issues are correct. *See e.g.*, IPR2021-01220, Ex. 1022. Petitioner further stated that the stipulations do not preclude other bases of invalidity being pursued at the District Court, such as anticipation based on a primary prior art reference, when the stipulation only identifies obviousness as a basis that will not be pursued. *See id.*

Petitioner also inquired as to how the newly-issued District Court claim construction order should be filed. Petitioner is advised that the order should be filed as an exhibit in each of the respective cases.

Accordingly, it is:

ORDERED that Petitioner is authorized to file preliminary replies in each case of no more than five pages limited to addressing the potential effects of the District Court's claim construction and Patent Owner's § 325(d) arguments in the Preliminary Response;

FURTHER ORDERED that Patent Owner is authorized to file preliminary sur-replies of no more than five pages limited to addressing the arguments and assertions in Petitioner's preliminary replies; and

FURTHER ORDERED that Petitioner's preliminary replies are due one week from the date of this Order, and Patent Owner's preliminary sur-replies are due one week from the filing of Petitioner's preliminary replies.

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