

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

MANUFACTURING RESOURCES INTERNATIONAL, INC.
Patent Owner

U.S. Patent No. 9,173,322

Title: CONSTRICTED CONVECTION COOLING SYSTEM FOR AN
ELECTRONIC DISPLAY

Inter Partes Review No. IPR 2023-00220

PETITIONERS' MOTION TO STRIKE

Pursuant to 37 C.F.R. § 42.64(b)(1), Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (“Samsung”) hereby move to strike Exhibits 2055 and 2056 (collectively, “Exhibits”) filed with Patent Owner’s Manufacturing Resources International, Inc.’s (“MRI”) Sur-Reply (“Sur-Reply”). As explained below, MRI’s untimely filing of this evidence violates PTAB rules. Samsung respectfully requests the Board strike these Exhibits from the record.

I. Background

On January 30, 2024, MRI filed the Exhibits with its Sur-Reply to Petitioners’ Reply. *See* Paper 41 (Sur-Reply) at 4. Samsung requested that MRI withdraw these improperly filed Exhibits, but MRI refused. Samsung requested permission from the Board to file this Motion on February 6, 2024, and the Board granted leave to file this Motion on February 14, 2024.

II. Relevant Law

37 C.F.R. § 42.23(b) states that a “sur-reply may only respond to arguments raised in the corresponding reply and may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.” The PTAB Consolidated Trial Practice Guide (“CTPG”) similarly states that “[t]he sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.” CTPG (Nov. 2019) at 73–74. Under 37 C.F.R. § 42.7(a), the Board is authorized to “expunge any paper

directed to a proceeding . . . that is not authorized under this part or in a Board order or that is filed contrary to a Board order.”

III. MRI’s Sur-Reply Evidence Should be Stricken from the Record

MRI’s Exhibits should be expunged because MRI filed them in violation of PTAB rules, and there is no justification for MRI’s violation of the rules.

First, these Exhibits violate 37 C.F.R. § 42.23(b) and the CTPG. *See supra* § II. Exhibits 2055 and 2056 are MRI’s Commission briefs filed in related Inv. No. 337-TA-1331 (“ITC matter”). These Exhibits are not “deposition transcripts of the cross-examination of any reply witness” (*see* 37 C.F.R. § 42.23(b), CTPG at 73–74) and were thus “belatedly presented evidence that exceeds the proper scope of . . . sur-reply” (*see* CTPG at 80).

The Board has expunged improperly filed exhibits under these exact circumstances. In *Satco Prods., Inc. v. Seoul Semiconductor Co., Ltd.*, the Board granted petitioner’s motion to strike eight new sur-reply exhibits because such evidence was prohibited under 37 C.F.R. 42.23(b) and the CTPG. IPR2020-00836, Paper 45, 75–77 (PTAB Oct. 22, 2021) (“*Satco*”); *see also* *Lenovo Holding Co., Inc. v. Dodots Licensing Sols. LLC*, IPR2019-01278, Paper 37 at 31–33 (PTAB Jan. 19, 2021) (striking a declaration filed with sur-reply because it “constitute[d] new evidence”); *Clearone, Inc. v. Shure Acquisition Holdings, Inc.*, IPR2019-00683, Paper 66 at 3–5 (PTAB Apr. 20, 2020) (striking file histories and literature

filed with sur-reply). Contrary to MRI's assertions to the Board in its February 13 email, it would not be an "exceptional remedy" for the Board to strike the evidence at issue here. As the Board noted in *Satco*, such an argument is "misplaced" because "the [CTPG] states that 'striking the entirety or a portion of *a party's brief* is an exceptional remedy,' but not when "the motion is directed to the exhibits submitted with the Sur-reply only." *Satco* at 76–77. The same applies here.

Second, there are no extenuating circumstances that justify MRI's violation of PTAB rules. MRI could have sought permission from the Board to file these Exhibits, but chose not to. MRI argued in its February 13 email to the Board that "[t]he challenged exhibits are directly responsive to Petitioner's Reply." But section 42.23(b) acknowledges that a sur-reply should be responsive to the reply ("sur-reply may only respond to arguments raised in the corresponding reply") *without* permitting entry of evidence other than deposition transcripts. The Board should reject any attempt by MRI to justify its submission of such evidence.

Moreover, MRI's alleged justifications in its February 13 email to the Board are baseless. MRI argued that it submitted its ITC matter briefing (Exhibits 2055 and 2056) to "rebut Petitioner's incorrect suggestions regarding the evidentiary value of a challenged Initial Determination in the parties' ongoing ITC proceedings." But Samsung did not make any "incorrect suggestions." The Board may consider the Final Initial Determination "for any persuasive value it offers."

Comcast Cable Commc'ns, LLC v. Veveo, Inc., IPR2019-00239, Paper 50 at 17 (PTAB June 30, 2020). And MRI should not be permitted to incorporate the additional arguments from the ITC matter briefing into the record here.

Contrary to MRI's arguments, it would not be "in the interests of justice" for such evidence to be permitted in the record notwithstanding MRI's failure to comply with PTAB rules. MRI cited *Dell Inc. v. Accelaron, LLC*, 818 F.3d 1293 (Fed. Cir. 2016) in its February 13 email for the proposition that "the Board 'must allow a party . . . to submit rebuttal evidence . . . as may be required for a full and true disclosure of the facts.'" In *Dell*, however, the Federal Circuit faulted the Board for relying on evidence petitioner raised for the first time at oral argument, and dismissing patent owner's procedural objection at that time. *Id.* at 1301. MRI did not object to any portion of Samsung's Reply and has not been deprived of the opportunity to respond. Section 42.23(b) should apply here.

Samsung, therefore, respectfully requests that the Board strike Exhibits 2055 and 2056. If the Board determines not to strike these Exhibits, Samsung respectfully requests permission to submit its responsive briefing from the ITC matter to complete the record.

Date: February 22, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) the undersigned hereby certifies that
Petitioners' Motion to Strike was served upon the following addresses as listed in
Patent Owner's Mandatory Notices:

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