

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

Case IPR2023-00220

Patent 9,173,322

**PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION TO
STRIKE AND, IN THE ALTERNATIVE, TO MAINTAIN EXHIBITS 2055,
2056 IN THE RECORD UNDER 37 C.F.R. § 42.5**

I. INTRODUCTION

The Board should deny Petitioner’s Motion to Strike Patent Owner’s Exhibits 2055 and 2056 (Paper 47). Patent Owner has used these exhibits, which are publicly available documents from the parties’ parallel ITC proceeding, only to respond to new arguments made in the Reply Brief relating to those same ITC proceedings. Striking the exhibits would deny the Board access to the complete record.

Alternatively, the Board should exercise its wide discretion under 37 C.F.R. § 42.5 to maintain these exhibits in the proceeding as a matter of procedural fairness because the exhibits are directly responsive to arguments first raised in Petitioner’s Reply, the authenticity of their contents is beyond dispute, and consideration of them is in the interests of justice.

II. RELEVANT LAW

Under the APA, the Board “must allow ‘a party . . . to submit rebuttal evidence . . . as may be required for a full and true disclosure of the facts.’” *Dell Inc. v. Acceleron, LLC*, 818 F.3d 1293, 1301 (Fed. Cir. 2016).

Although 37 CFR § 42.23 places limits on “new evidence” that may accompany a sur-reply, 37 C.F.R. § 42.5(b) provides “[t]he Board may waive or suspend a requirement of parts 1, 41, and 42 and may place conditions on the waiver.” Thus, the Board has discretion to suspend § 42.23(b) to permit Patent Owner’s probative rebuttal evidence. 37 C.F.R. 42.5(c)(2) further provides “[a] late

action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.” “In deciding whether the interests of justice support considering the merits of a late filing, [the Board examines] the prejudice that would result from considering or not considering the merits.” *Hengdian Grp. DMEGC Magnetics Co., Ltd. v. Gitachi Metals, Ltd.*, IPR2017-01312, Paper 14 at 4.

III. ARGUMENT

The Board has previously denied motions to strike sur-reply exhibits that were not deposition transcripts of the cross-examination of any reply witness where the exhibits “address the argument and evidence newly presented in the Reply.” *Paragon 28 v. Wright Med. Tech.*, IPR2019-00895, Paper 44, 18 (PTAB Sept. 23, 2020); *see also Atlas Copco Tools and Assembly Systems LLC et al., v. Wildcat Licensing WI LLC*, IPR2020-00891, Paper 56, 79-81 (PTAB Nov. 1, 2021) (admitting publicly available patent documents with sur-reply for “good cause”).

Exhibits 2055 and 2056 are public records that support valid sur-reply arguments triggered by new arguments in the Petitioner’s Reply. The Petitioner, already familiar with each exhibit at the time of their Reply, faces no unfair advantage by their inclusion in the record.

Petitioner’s Reply relies heavily on the ALJ’s Initial Determination (“ID”) in the parties’ parallel ITC proceedings (Ex. 1040). *See* Paper 30 at 1-2, 4, 6-8, 11, 14-

15, 18, 20-24. Exhibits 2055, 2056 are challenges to the ID, which did not exist at the time of Patent Owner's Response. While the ID has been made final by the ITC, Petitioner, who is party to the ITC proceedings, was aware of both the interlocutory nature of the ALJ's decision, and the challenges made to it, but did not make this clear to the Board. There is no prejudice to Petitioner posed by Patent Owner notifying the Board of these challenges to the ID, which Patent Owner may appeal. *See* Paper 38 at 1-2.

Petitioner's motion does not establish any prejudice resulting from admitting any of these public records as exhibits, or cite any prior Board decision granting a motion to strike on these facts. In contrast, Patent Owner would be unable to fully respond to Petitioner's arguments without these exhibits. Thus, the exhibits should remain in the record pursuant to 37 C.F.R. § 42.5(b) and (c)(2).

Should the Board nevertheless strike the challenged exhibits, it should take judicial notice of their contents to avoid unjustly favoring Petitioners. Taking judicial notice of the public records provided as Exhibits 2055 and 2056 would resolve the alleged violation of 37 CFR § 42.23 and moot Petitioners' claims of prejudice based on the alleged violation.

The Federal Circuit has expressly held the Board "may take notice of facts beyond the record which . . . are capable of such instant and unquestionable demonstration as to defy dispute." *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970).

It is well-established that judicial notice may be taken of public agency proceedings such as Exs. 2055 and 2056. *See Function Media, LLC v. Google, Inc.*, 708 F. 3d 1310, 1316, n.4 (Fed. Cir. 2013).

Dated: February 29, 2024

Respectfully submitted,

/John C. Alemanni /

John C. Alemanni

Reg. No. 47,384

Kilpatrick Townsend & Stockton LLP

4208 Six Forks Road, Suite 1400

Raleigh, NC 27609

jalemanni@kilpatricktownsend.com

Tel: (919) 420-1724

Fax: (919) 420-1800

Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the date below a copy of this **PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION TO STRIKE AND, IN THE ALTERNATIVE, TO MAINTAIN EXHIBITS 2055, 2056 IN THE RECORD UNDER 37 C.F.R. § 42.5** was served on Petitioners by filing through the P-TACTS System and by electronic delivery via email to the following:

Sanjeet Dutta – sdutta@goodwinlaw.com
Douglas J. Kline – dkline@goodwinlaw.com
Srikanth Reddy – sreddy@goodwinlaw.com
Naomi L. Birbach – nbirbach@goodwinlaw.com

Dated: February 29, 2024

/ John C. Alemanni /

John C. Alemanni

Reg. No. 47,384

Counsel for Patent Owner