

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.
Petitioner

v.

DAEDALUS PRIME LLC
Patent Owner

Patent No. 10,727,183

**PETITIONER'S NOTICE
REGARDING MULTIPLE PETITIONS**

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I. INTRODUCTION

Petitioner is concurrently filing two petitions challenging the claims of U.S. Patent No. 10,727,183 (“the ’183 patent”) (Ex. 1001). “To aid the Board in determining” why “more than one petition is necessary,” Petitioner provides the information below. *See* PTAB Consolidated Trial Practice Guide (“TPG”) (November 2019) at 59-60. As explained below, the Board should institute both petitions.

II. RANKING

While both petitions are meritorious and justified as explained below, Petitioner requests that the Board consider the petitions in the following order:

Rank	Petition	Challenged Claims	Grounds
1	Petition 1	1-25	<u>Ground 1</u> : Claims 1-25 anticipated by Boyanov ’569
2	Petition 2	1-25	<u>Ground 1</u> : Claims 1-25 obvious over Fukunaga and Park <u>Ground 2</u> : Claim 10 obvious over Fukunaga, Park, and Chan <u>Ground 3</u> : Claims 20-23 obvious over Fukunaga, Park, and Song <u>Ground 4</u> : Claims 1-9 and 11-17 anticipated by Kawahara <u>Ground 5</u> : Claim 10 obvious over Kawahara and Chan

Rank	Petition	Challenged Claims	Grounds
			<u>Ground 6</u>: Claim 10 obvious over Kawahara and Fukunaga <u>Ground 7</u>: Claims 18-25 obvious over Kawahara and Park <u>Ground 8</u>: Claims 20-23 obvious over Kawahara, Park, and Song

III. MATERIAL DIFFERENCES AND REASONS FOR INSTITUTION

As the Board has recognized, “there may be circumstances in which more than one petition may be necessary.” *See* PTAB Consolidated TPG at 59-60. This is such a circumstance. Petition 1 relies on severing the priority chain of the ’183 patent and demonstrates that claims 1-25 of the ’183 patent are not entitled to priority to any of the earlier-filed ’506 application, ’613 application, ’899 application, or ’453 PCT application. Therefore, the ’183 patent is not entitled to an effective filing date any earlier than September 3, 2019, which is the filing date of ’086 application from which the ’183 patent issued. Because the ’183 patent is not entitled to earlier priority, Boyanov ’569, which was published February 1, 2018, (more than a year before September 3, 2019), is prior art to the ’183 patent. Boyanov ’569 claims priority to the same ’453 PCT application as the ’183 patent, has virtually the same disclosure as the ’183 patent, and includes claims 1-17 that are nearly identical to claims 1-17 of the ’183 patent. As such, the Board may expect to expend relatively

less resources addressing the grounds raised in Petition 1. Petition 1 includes a section demonstrating that the '183 patent is not entitled to priority to the earlier-filed applications, thereby limiting the space available for showing disclosure of the claimed features in the prior art.

Petition 2 relies on Fukunaga, Kawahara, Park, Chan, and Song, whose prior art status does not depend on the challenge to the priority chain raised by Petition 1. As demonstrated in Petition 2, even if the '183 patent were entitled to claim priority to the earlier-filed applications, the claimed features are still anticipated or obvious in view of the prior art. Petition 2 includes two primary references, Fukunaga and Kawahara, where the Fukunaga grounds address the claims under their plain meaning while the Kawahara grounds address the claims in a manner consistent with Patent Owner's assertions in litigation with respect to the scope of certain claim features. Thus, the need for two petitions is further justified given Petitioner is addressing potential alternative claim construction positions.

Petitioner had to separate grounds into two petitions in order to ensure the grounds associated with each challenged claim contained the necessary specificity as to how the prior art meets the recited limitations within the word limit applicable to IPR petitions. Given that it is Petitioner's burden to establish unpatentability of the challenged claims, the level of detail included in the petitions is appropriate, and the Board should not penalize Petitioner for doing so by exercising its discretion

under 35 U.S.C. § 314 to deny either petition on account of the grounds being presented across two petitions.

Institution of both petitions is further warranted because, despite the material differences noted above, Petitioner strived to minimize issues for the parties and the Board where possible. As noted above, Petition 1 hinges on the priority challenge, and the Board should not be required to expend significant resources beyond resolving that challenge in order to determine patentability in view of Boyanov '569. Thus, institution of both petitions would not implicate concerns regarding the Board's time and resources required if trial is instituted in both petitions. Petitioner would also not be opposed to the Board consolidating the two proceedings upon institution.

Moreover, both the Administrative Procedures Act and due process weigh against denying institution of either petition based on the Board's discretion. Indeed, the two petitions here do not constitute an abuse of process because, as discussed above, only Petition 1 relies on breaking the priority chain and the petitions do not overlap in terms of the asserted prior art. Thus, both petitions are justified.

IV. CONCLUSION

For the reasons given above, the Board should institute both petitions.

Respectfully submitted,

Dated: February 3, 2023

By: /Naveen Modi/
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CERTIFICATE OF SERVICE

I hereby certify that on February 3, 2023, I caused a true and correct copy of the foregoing Petitioner's Notice Regarding Multiple Petitions to be served via express mail on the Patent Owner at the following correspondence address of record:

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