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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

APEX BEAM TECHNOLOGIES, LLC,
Patent Owner.

IPR2023-00598 (Patent 10,462,767 B2)
IPR2023-00601 (Patent 10,568,113 B2)
IPR2023-00602 (Patent 10,568,113 B2)[1]

Before JOHN D. HAMANN, SEAN P. O'HANLON, and
SCOTT RAEVSKY, *Administrative Patent Judges*.

RAEVSKY, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

[1] This Order applies to each of the above-captioned proceedings, and we exercise our discretion to issue one Order to be filed in each proceeding. The proceedings have not been consolidated, and the parties are not authorized to use this style heading in any subsequent papers.

I. INTRODUCTION

On August 3, 2023, the Board conducted a telephone conference with the parties to discuss Petitioner's request for authorization to file a reply to Patent Owner's Preliminary Response in each of the above-captioned proceedings. Judges Hamann, O'Hanlon, and Raevsky participated on behalf of the Board.

"A petitioner may seek leave to file a reply to the preliminary response" and "[a]ny such request must make a showing of good cause." 37 C.F.R. § 42.108(c) (2022).

Petitioner raised two requests for our authorization. First, Petitioner requests to file a *Sotera* stipulation in each of the above-captioned proceedings to address arguments in Patent Owner's Preliminary Response that we should exercise discretion under 35 U.S.C. § 314(a) to deny institution of the Petition based on parallel district court litigation. *See* Prelim. Resp. 27–34[2] (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*")); *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (declining to apply *Fintiv* to deny institution based on petitioner's stipulation not to pursue in the district court any ground that was raised or could have been reasonably raised in an IPR). Petitioner's second request is to submit in IPR2023-00601 and -00602 copies of Patent Owner's infringement contentions from related district court litigation and address related arguments in the Preliminary Response regarding the claimed "first time window" limitation.

[2] For convenience, citations here are to papers filed in IPR2023-00601. Similar papers have been filed in the other proceedings.

II. DISCUSSION

A. Sotera Stipulation

During the conference call, Petitioner requested authorization to file a one page Reply including a *Sotera* stipulation. Patent Owner responded that a *Sotera* stipulation is late, asserting that Petitioner should have filed any such stipulation with the Petition. Patent Owner cited no authority imposing a time limit for *Sotera* stipulations and conceded that it is within our discretion to permit Petitioner to file a stipulation. Petitioner argued that in *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01566, Paper 13 (PTAB Sept. 7, 2022) (precedential), the Director permitted filing a stipulation related to *Fintiv* prior to the Board's decision of whether to institute review.

We agree with Petitioner that we have discretion to permit filing a stipulation at this stage, prior to institution. We authorize Petitioner to file a one-page *Sotera* stipulation as an exhibit in each of the above-captioned cases. The exhibit should not include any argument.

B. Infringement Contentions and Related Arguments

Petitioner also requested authorization to submit in IPR2023-00601 and -00602 copies of Patent Owner's infringement contentions from related district court litigation and address related arguments in the Preliminary Response regarding the claimed "first time window" limitation. Petitioner argued that good cause supports this request because the Preliminary Response's arguments were unforeseeable, given that they directly contradict Patent Owner's infringement contentions. In particular, Petitioner argued that it relied on implicit claim construction positions in Patent Owner's infringement contentions to apply the prior art to the claims in its

Petition, but the Preliminary Response's arguments rely on an apparent construction that is different than Patent Owner's apparent construction in the infringement contentions. Petitioner conceded, however, that we need not construe any terms at this stage based on the infringement contentions. Rather, Petitioner argued that the infringement contentions should be made of record because they go to the credibility of Patent Owner's arguments.

Patent Owner argued that Petitioner made a strategic decision not to file the claim charts[3] from the infringement contentions with its Petition. Patent Owner also asserted that the infringement contentions are specific to a product and do not contain claim construction positions.

We determine that good cause does not exist for submitting the infringement contentions at this stage. As Petitioner conceded that we need not rely on the infringement contentions to construe any terms, we determine that the infringement contentions would not assist us in determining whether to institute *inter partes* review. Accordingly, we deny Petitioner's request to file a Reply or any exhibit including the infringement contentions.

III. ORDER

It is, therefore,

ORDERED that Petitioner may file a one-page *Sotera* stipulation as an exhibit in each of the above-captioned cases within one week of the entry of this Order; and

[3] Petitioner submitted a portion of Patent Owner's infringement contentions with its Petitions, without copies of the corresponding claim charts. *See* Ex. 1020 in both IPR2023-00601 and -00602.

FURTHER ORDERED that Petitioner's request to file in IPR2023-00601 and -00602 a reply to the Preliminary Response, including a copy of Patent Owner's infringement contentions, is *denied*.

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