

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.

Case IPR2023-00602
U.S. Patent No. 10,568,113

**PETITIONER'S NOTICE RANKING PETITIONS
FOR *INTER PARTES* REVIEW OF U.S. 10,568,113**

I. INTRODUCTION

Petitioner is filing two concurrent Petitions (IPR2023-00601 and IPR2023-00602) challenging the validity of claims 1-20 of U.S. Patent No. 10,568,113 (“the ’113 patent”). Pursuant to the Board’s November 2019 Consolidated Trial Practice Guide (“TPG”), Petitioner submits this paper to “identify: (1) a ranking of the Petitions in the order in which it wishes the Board to consider the merits . . . , and (2) a succinct explanation of the differences between the Petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions” TPG, 60.

II. RANKING OF THE PETITIONS

Although Petitioner believes that both Petitions are meritorious and justified, Petitioner requests that the Board consider the Petitions in the following order:

Rank	Petition	Primary Reference
1	IPR2023-00601	<i>Xia</i>
2	IPR2023-00602	<i>Liu</i>

III. MATERIAL DIFFERENCES BETWEEN THE PETITIONS

The two petitions are materially different. For example, the petitions rely on different prior art references with different priority dates, which may result in a dispute regarding whether the references qualify as prior art. The ’113 patent claims priority to a Chinese Application filed August 11, 2017, while *Xia* claims

priority to its provisional filing date of August 10, 2017, and *Liu* claims priority to its provisional filing date of June 16, 2017. To the extent that Patent Owner challenges the priority of *Xia* and/or contends that a prior art exception under 35 U.S.C. 102(b) applies in an attempt to remove *Xia* as prior art, Petitioner presents the *Liu* Petition.

Further, the obviousness grounds also contain material differences. Although each set of references discloses every claim element, they do not present the same theories of obviousness or use identical language. In particular, where one of the grounds challenging claims 1-20 in the *Xia* Petition may be a single reference obviousness ground, the *Liu* Petition asserts a combination of *Liu* and *Jover* to render obvious claim limitation [1e]. Accordingly, the petitions have different starting points and different rationales as to why the challenged claims are obvious.

IV. THE BOARD SHOULD EXERCISE ITS DISCRETION TO INSTITUTE BOTH PETITIONS

The Board has recognized “that there may be circumstances in which more than one petition may be necessary.” TPG, 59. One of the examples provided by the Board for justifying the institution of multiple petitions is a “dispute about priority date.” *Id.* Here, Petitioner contends that *Xia* qualifies as prior art due to its provisional filing date of August 10, 2017. But in the event that Patent Owner attempts to challenge the priority date of *Xia* and/or contends that a prior art

exception under 35 U.S.C. 102(b) applies to remove *Xia* as prior art, the *Liu* Petition provides arguments based on *Liu*, which has a priority date almost two months earlier than *Xia*. And because no tribunal has decided the prior art status of *Xia*, both petitions are necessary to address the possible outcomes.

In view of the material differences shown above, the Board should exercise its discretion to institute both Petitions. Both Petitions are necessary to show the breadth of prior art that reads on the overly broad claims. The Petitions are not redundant, duplicative, or substantially similar, and this is not a situation in which it would be reasonable to include all challenges in a single petition, as both petitions challenge twenty claims (1-20). Moreover, each Petition provides a strong showing of unpatentability. Instituting on only one Petition would give Patent Owner an unfair advantage, allowing Patent Owner to strategically *not* address the prior art status of *Xia* before institution, but then address it once *Liu* is no longer available to Petitioner (as a result of the *Liu* petition being denied) despite *Liu* being an earlier prior art reference.

Finally, this is not a situation where Petitioner has filed many IPR petitions against one patent or is asserting dozens of independent grounds. Rather, Petitioner has filed only two petitions, each based on a single primary reference. For the reasons stated above, the potential dispute about the priority date and prior art

status of *Xia* together with the different disclosure and earlier priority date of *Liu* is sufficient to justify institution of two petitions against the '113 patent.

V. CONCLUSION

This case satisfies the Board's example justification for filing two petitions. Specifically, the petitions depend on the Board's ultimate findings on the priority dates of the two primary references, *Xia* and *Liu*, and their prior art status relative to the '113 patent. Even with the two petitions, Petitioner has raised only two grounds of unpatentability. These two grounds will not unduly burden the Board or the parties. The Board should institute trial for both IPR2023-00601 and IPR2023-00602.

Dated: February 28, 2023

By: /Joshua L. Goldberg/
Joshua L. Goldberg, Lead Counsel
Reg. No. 59,369

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), the undersigned certifies that on February 28, 2023, a copy of the foregoing Petitioner's Notice of Ranking Petitions was served by FedEx Priority Overnight on the correspondence address of record indicated in the Patent Office's Patent Center website for U.S. Patent No. 10,568,113:

Jialin Zhong
Zhong Law, LLC
51 JFK Parkway
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A courtesy copy of the foregoing was also served by FedEx Priority Overnight on the address listed on the same law firm's website (<https://zhong-law.com/>):

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Date: February 28, 2023

By: /William Esper/
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