UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

DODOTS LICENSING SOLUTIONS LLC,
Patent Owner

Case IPR2023-00621
U.S. Patent No. 8,020,083 B1

PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION PURSUANT TO 37 C.F.R. § 42.123(a)

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I. Introduction.

Patent Owner opposes Petitioner's Motion to Submit Supplemental Information pursuant to 37 C.F.R. §42.123(a). Specifically, though Petitioner claims that it is seeking to submit a *supplemental* Schmidt declaration that supposedly provides "clarification from Dr. Schmidt regarding the claim construction standard that he relied upon in his providing his opinion," in reality, it is an amended and new declaration that seeks to bolster deficiencies in its Petition. Motion at 1. Petitioner tries to do far more with Dr. Schmidt's purported supplemental declaration—not only does Dr. Schmidt state in a conclusory manner that he used the *Phillips* standard to construe the challenged claims, his supplemental declaration also makes substantive changes to Petitioner's invalidity arguments by modifying citations, adding new citations, omitting figures, and, in the process, altering certain invalidity arguments. Allowing Petitioner to make such after-the-fact changes to its arguments is improper and prejudicial to the Patent Owner. As a result, this Board should deny the Petitioner's request to file this supplemental declaration.

II. Samsung's motion fails under 37 CFR § 42.123(a).

Samsung moves to submit a revised Schmidt declaration as supplemental information under 37 C.F.R. § 42.123(a), which in relevant part provides, "the supplemental information must be relevant to a claim for which a trial has

been instituted." In other words, any supplemental information must be relevant to a claim as opposed to a ground for which trial has been instituted. This distinction was drawn by the Federal Circuit in *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435 (Fed. Cir. 2015) where the petitioner sought to submit a supplemental declaration that changed the grounds for which trial was instituted. The Federal Circuit, in affirming the PTAB's denial of Redline's request, found that 37 C.F.R. 42.123(a) "does not offer a routine avenue for bolstering deficiencies in a petition raised by a patent owner in a Preliminary Response . . . [and that Petitioner] should not expect a 'wait and see' opportunity to supplement a petition after initial comments or argument have been laid out." *Id*. This is exactly what Samsung is attempting here.

Samsung moves to submit a supplemental declaration from Dr. Schmidt to purportedly provide clarification regarding the claim construction standard that he used when opining on the validity of the challenged claims. Mot. at 1. But a closer review of the supplemental declaration reveals that Samsung is attempting to do more—namely, Samsung is trying to clean up and bolster deficiencies in its invalidity positions after seeing DoDots' POPR and Preliminary Sur-Reply. For example, though paragraph 54 in Dr. Schmidt's original declaration cites to a single paragraph (paragraph 29) to support an argument, the Supplemental Declaration cites to Section I.C.2. Likewise, in paragraph 63 of his original

declaration, Dr. Schmidt argues without any citation that a "POSITA would have recognized that script files are style-focused data structures . . . ." But in his supplemental declaration, Dr. Schmidt cites to the entirety of Section III.A to support this same opinion. Further, Dr. Schmidt's declaration was amended in paragraph 74 to modify the argument to refer to "both Grounds 1A and 1B." The changes Samsung made "relate[] to a ground[s] for which the trial was instituted, rather than only to a claim of the patent, for which the trial was instituted." *Redline Detection*, 811 F.3d at 448. In fact, what is troubling, is that in its motion papers, Samsung does not even mention to the Board or to Patent Owner the various changes made to Schmidt's declaration. Samsung only discusses the issue regarding Schmidt's use of the BRI standard. Patent Owner only learned of the various revisions to Schmidt's declaration by running a compare. But changing citations to evidence supporting an entire ground and changing claim construction standards for both grounds affecting all claims post-institution are not supplements to evidence.

Samsung's changes attempt to revise the grounds on which trial is instituted. Section 42.123(a) and the Federal Circuit's decision in *Redline* prohibit this. For this reason, Samsung's motion fails to meet the threshold requirement under 42.123(a) and should be denied.

III. Petitioner improperly brought this motion under 37 CFR § 42.123(a) rather than under 37 CFR § 42.104(c).

Petitioner has repeatedly argued that the error made in Dr. Schmidt's original declaration was merely a typographical error. If taken as true, there is only one way for a party to correct typographical errors under the rules governing an IPR proceeding—i.e., under 37 C.F.R. § 42.104(c). Given this singular way to correct typographical errors (which are by definition minor in nature), this provision understandably provides that the grant of a motion under this provision "does not change the filing date of the petition." 37 C.F.R. § 42.104(c). Here, the Petitioner did not file a § 42.104(c) motion. Instead, the Petitioner seeks to introduce its revised declaration as supplemental information under 37 C.F.R. §42.123(a). And this is improper for at least two reasons.

First, Petitioner fails to meet its burden by providing any support for its position that typographical errors in expert declarations can be corrected using §42.123(a). In fact, the rules governing IPR proceedings do not provide any authority to correct typographical errors under §42.123(a), and the Petitioner has not provided any legal support for this position. Samsung's failure to carry its burden in this regard should lead to a denial of its motion.

Second, a motion pursuant to §42.104(c) is the only way for a petitioner to make changes to documents it submits with its IPR petition, while preserving the

filing date of that petition. But §42.123 does *not* make any such allowance. Therefore, given the presumption that "Congress acts intentionally and purposefully in the disparate inclusion or exclusion" of regulatory/statutory language, it is proper to conclude that §42.123 does not contemplate preserving the filing date when documents submitted with the petition are changed in the middle of the IPR proceeding. *Redline Detection*, 811 F. 3d at 444. In other words, submitting a new expert declaration pursuant to §42.123, which changes the claim construction standard used in the petition along with several revised citations to evidence, should change the petition filing date. Accordingly, Samsung's use of §42.123(a) to revise the papers supporting the original IPR Petition under the guise of submitting supplemental information is improper and also time barred for being beyond the one year deadline for seeking an IPR.

IV. Petitioner's motion and actions fail to address the four factor test under both 37 C.F.R § 42.64(b)(2) and 37 C.F.R § 42.123(a).

The Board in *Ivantis, Inc. v. Glaukos Corp.*, IPR2018-01180 Paper 14 at 9 (PTAB Dec. 6, 2018) set forth the following non-exclusive factors in determining whether to exercise discretion and allow correction due to clerical or typographical errors: "(1) the nature of the error, and whether the party requesting relief provides adequate explanation for how the error occurred, including how the error was discovered; (2) the length of time elapsed between learning of the error and

bringing the error to our attention; (3) prejudice to the other party, if any, by allowing the proposed corrections; and (4) whether the proposed corrections have any impact on the proceeding."[1]

In its motion, Petitioner fails to address any of these four factors in its motion.[2]

1. *The nature of the error, and whether the party requesting relief provides adequate explanation for how the error occurred, including how the error was discovered.*

Under 27 C.F.R. § 42.20(c) Petitioner, as the moving party, has the sole burden of proof to establish with facts and evidence the relief it requests. Here Samsung fails to meet this burden.

In his Supplemental Declaration, Dr. Schmidt fails to provide an adequate explanation for how the error occurred or why he made the same error on three separate declarations that he submitted. Instead, Samsung's expert merely avers that it was a typographical error and that he, "understand(s) that all claim terms in

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[1] Though *Ivantis* involved 42.104(c), the Federal Circuit's instructions in *Redline* that § 42.123 should not be "read to the exclusion of the remaining [37 C.F.R.] subsections," warrant using a similar test to determine correction of typographical errors if the Petitioner (erroneously) relies upon §42.123 for submission of a revised document. *Redline Detection,* 811 F. 3d at 445.

[2] Samsung's motion characterizes the relief it seeks as fixing a typographical error in its expert declaration. Submission of supplemental declarations for fixing typographical errors are considered under the four-factor test. *See Sweegren, Inc., vs. Pure Circle SDN BHD and Purecircle USA Inc.,* PGR2020-00070 Paper 9 at 4 (PTAB Sept. 22, 2020).

an IPR should be construed according to the *Phillips* standard, not the broadest reasonable construction standard." Suppl. Decl. para. 2. Notably, Dr. Schmidt does not even mention that he maintained this understanding at the time of his original declaration. Again, Schmidt does not explain any of the facts leading up to and underlying his purported typographical error. In all, Samsung fails to provide any information required by this factor in its "do-over" supplemental declaration.

2. *The length of time elapsed between learning of the error and bringing the error to the Board's attention.*

Samsung willfully chose to delay its request to the Board by nearly a month after institution of the IPR. Samsung offers no explanation as to the delay and (falsely) claims that Patent Owner is not substantially prejudiced by this delay. There is no reason why Samsung could not have provided the Supplemental Declaration of Dr. Schmidt at an earlier time and properly moved under §42.104(c). Instead, Samsung unjustifiably and inexplicably waited nearly a month post-Institution to submit so-called supplemental declaration and, thereby, shortened the time that DoDots has to respond to this new information.

3. *Prejudice to the other party, if any, by allowing the proposed corrections.*

Petitioner has offered no explanation as to why the various changes Samsung made to Schmidt's declaration do not prejudice the Patent Owner. Petitioner's motion does not even acknowledge the various changes in the

supplemental declaration and, instead, Samsung maintains that it is only seeking to correct the "typographical error" to the expert's claim construction standard. Specifically, as noted above, Dr. Schmidt's supplemental declaration not only "corrects" the claim construction standard used in his declaration, but he also necessarily introduces new arguments and evidence by adding new citations. For example, citation changes were made in paragraphs 50, 54, 63, 157, 163, and 194 and an entirely new citation was added to paragraph 156. The citation at the end of paragraph 50 was changed from "SAMSUNG-1001, 5:41-44; *see* paragraph 28, *above*" to "SAMSUNG-1001, 5:41-44; Section I.C.1, *above.*" Additionally, Schmidt's supplemental declaration amends paragraph 74 by modifying the argument to refer to, "both Grounds 1A and 1B." (page 47). Obviously, Patent Owner has never had an opportunity to respond to these new arguments. This is the very definition of prejudice.

4. *Whether the proposed corrections have any impact on the proceeding*.

Samsung's proposed changes to the Schmidt declaration and the manner in which they are being submitted have an adverse impact on the proceedings. It is well known that the petitioner, "has the burden from the onset to show with particularity why the patent it challenges is unpatentable." *Harmonic Inc. v. Avid Tech., Inc*., 815 F.3d 1356, 1363 (Fed. Cir. 2016). This burden of persuasion never

shifts to the patent owner. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc*., 800 F.3d 1375, 1378 (Fed. Cir. 2015). But Samsung's actions to date have caused the burden to improperly shift to DoDots. Specifically, after Samsung's delay and various improper procedural maneuverings and submissions, DoDots will now need to show that Dr. Schmidt did not make a typographical error, when as per the rules governing IPRs, Samsung was required from the get-go under §104(c) to prove with a showing of facts and evidence that its expert made a typographical error. This improper burden shifting in and of itself results in this proceeding becoming prejudicial to DoDots. In addition, Samsung's failure to provide the necessary evidence at any stage during this proceeding to show that Dr. Schmidt made a typographical error, along with its decision to move to correct a purported typographical error under the incorrect CFR provision (§123 as opposed to §104(c)) further compounds the confusion that Samsung has brought to this proceeding.

Indeed, admitting Schmidt's new declaration will also require Patent Owner to respond to two different sets of evidence and grounds. And the new declaration with new evidence and new grounds cannot be admitted more than one year after Samsung was served with the complaint in the district court action on or about June 2 2022. Even the USPTO FAQ states, regarding clerical or typographical errors, that "[a] substitution of new analysis for the analysis provided in the

original petition is not an acceptable correction."

See https://www.uspto.gov/patents/ptab/trials/aia-trials-faq. Therefore, Samsung's motion should be denied.

V. Petitioner's motion fails to differentiate between supplemental evidence under 37 C.F.R § 42.64(b)(2) and supplemental information under 37 C.F.R. § 42.123(a).

Petitioner admits that it served Dr. Schmidt's supplemental declaration in response to DoDots' evidentiary objections. Mot. at 2. This, however, is an improper response to evidentiary objections. Serving supplemental evidence under 37 C.F.R § 42.64(b)(2) in response to evidentiary objections is offered solely to support *admissibility* of the originally-filed evidence, as opposed to amending and changing supporting arguments on the merits (as Samsung does here). *See Handi Quilter, Inc. v. Bernina Int'l AG,* IPR2013-00364, Paper 30 at 2 (PTAB June 12, 2014). Samsung's supplemental expert declaration, which changes the claim construction standard used by Samsung and makes new invalidity arguments based on revisions to citations, is an argument on the merits. As a result, Samsung's service of a supplemental declaration in response to an evidentiary objection is wholly improper.

Dated: November 29, 2023 Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION PURSUANT TO 37 C.F.R. § 42.123(a) was served electronically via email on November 29, 2023, on the following counsel of record for Petitioner:

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