UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

RESONANT SYSTEMS, INC.,

Patent Owner.

IPR2023-00993

U.S. Patent No. 9,941,830

PETITIONERS' NOTICE OF MULTIPLE PETITIONS

Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. ("Petitioners") have requested *Inter Partes* Review ("IPR") of claims 1–9, 11, 14–17, and 19–20 of U.S. Patent No. 9,941,830 ("the '830 patent") in IPR2023-00993 and claims 1–20 of the '830 patent in IPR2023-01025. Petitioners have presented two materially distinct, non-cumulative petitions, with one addressing a break in the '830 priority chain, leading to a significantly later priority date for all '830 claims than the priority date Patent Owner ("PO") asserts. *See* IPR2023-00993 (the "Priority Petition") and IPR2023-01025 (the "Third Party Prior Art Petition"). Petitioners respectfully request institution of both petitions for the reasons detailed below.

I. Detailed Reasons for Multiple Petitions Against the '830 Patent.

The '830 patent purports to claim priority through a series of applications to Provisional Application No. 61/179,109 ("the '109 application"), filed May 18, 2009. Petitioners understand that Patent Owner ("PO") is asserting a priority date no later than the date of that provisional application in the co-pending district court litigation. *See* EX1029. Thus, Petitioners have presented challenges in the Third Party Prior Art Petition based on that priority date (or showing for certain claims why those claims are entitled to a later priority date).

On the other hand, the Priority Petition details that PO introduced new matter into the application leading to the '830 patent, which severed the potential for

priority benefit to any earlier application in the ’830 patent’s priority chain. Specifically, the application leading to the ’830 patent claimed, for the first time, a *vibration module* genus rather than the species *linear* vibration module to which all previous applications were directed. As explained in detail in the Priority Petition, the only support for this new matter is the originally-filed claims of the application leading to the ’830 patent. The Priority Petition demonstrates that the earliest effective filing date for claims 1–20 of the ’830 Patent is no earlier than June 13, 2016, and presents an anticipation ground based on that priority date.

The priority dispute between the parties justifies two petitions. The Patent Trial and Appeal Board’s Consolidated Trial Practice Guide expressly acknowledges that “a dispute about priority date requiring arguments under multiple prior art references” is a situation in which it is appropriate to file multiple petitions against the same patent. *See* Office Consolidated Trial Practice Guide, 84 Fed. Reg. 64280 (Nov. 20, 2019) (“TPG”). Although the TPG states that multiple petitions should be rare, the facts here justify institution of two petitions challenging the ’830 patent. *See, e.g., 10X Genomics, Inc. v. Bio-Rad Labs., Inc.*, IPR2020-00088, Paper 8, at 46-47 (PTAB April 27, 2020).

The Third Party Prior Art and Priority Petitions rely on completely different prior art references to address the different effective filing dates for the challenged claims. The Third Party Prior Art Petition relies on multiple references needed to

address means-plus-function constructions for "component" claim terms as well as potential PO arguments. The asserted references in the Third Party Prior Art Petition all qualify as prior art assuming PO's asserted priority date, other than two references which Petitioners show qualify as prior art based on a later priority date for claims 9, 14, 16, and 19.

The Priority Petition, in contrast, presents a ground of anticipation based on U.S. Patent App. Publication No. 2012/0133308 (the "'308 publication"), which is the publication of the application that led to parent patent U.S. Patent No. 8,860,337. The Priority Petition relies exclusively on PO's own prior art (a parent to the '830 patent with the same specification), removing the burden for PO and the Board to analyze additional prior art in a second petition.

II. Ranking of the Petitions

As set forth in the following table, Petitioners rank the Third Party Prior Art Petition higher than the Priority Petition. Petitioners believe, however, that instituting both petitions is warranted because of the dispute regarding priority benefit between the parties. Petitioners have also relied on PO's own prior art in the Priority Petition, limiting the burden imposed on PO to analyze unfamiliar art.

	Petition	Claims	Summary of Grounds
1	IPR2023-00993	1–9, 11, 14–17, 19–20	Obviousness grounds based on two primary references (Fukumoto and Ogusu) with combinations with other references to

			address specific dependent claims and/or potential claim construction issues
2	IPR2023-01025	1-20	Anticipation by the ’308 Publication

Date: June 14, 2023

Respectfully submitted,

/Jessica Kaiser/
Jessica Kaiser, Lead Counsel
Reg. No. 58,937

CERTIFICATE OF SERVICE

I certify that on June 14, 2023, I caused a true and correct copy of the foregoing PETITIONERS' NOTICE OF MULTIPLE PETITIONS to be served via overnight delivery on the Patent Owner at the following correspondence address of record as listed on PAIR:

Olympic Patent Works PLLC
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A courtesy copy was also sent via electronic mail to Patent Owner's litigation counsel listed below:

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