

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

RESONANT SYSTEMS, INC.,
Patent Owner.

IPR2023-00993
Patent 9,941,830 B2

Before JAMES J. MAYBERRY, STEVEN M. AMUNDSON, and
MICHAEL T. CYGAN, *Administrative Patent Judges*.

CYGAN, *Administrative Patent Judge*.

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

Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively “Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–9, 11, 14–17, 19, and 20 in U.S. Patent No. 9,941,830 B2 (Ex. 1001, “the ’830 patent”) under 35 U.S.C. §§ 311–319. Paper 3 (“Pet.”). Resonant Systems, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 11 (“Prelim. Resp.”).

In the Preliminary Response, Patent Owner argues that we should exercise our discretion under § 314(a) to deny institution for two independent reasons. *See* Prelim. Resp. 9–24; 35 U.S.C. § 314(a) (2018). First, Patent Owner asserts that the “Petition presents an exceptionally large number of grounds that are not justified by issues that are particular to the challenged claims or to the prior art.” *Id.* at 9. According to Patent Owner, “[t]hese voluminous and excessive grounds will impose an unreasonable burden both on the patent owner and on the Board to address.” *Id.*; *see id.* at 9–16.

Second, based on *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”), Patent Owner asserts that the Board should exercise discretion to deny institution in view of parallel litigation, i.e., *Resonant Systems, Inc. v. Samsung Electronics Co., Ltd. et al.*, No. 2:22-cv-00423, in the Eastern District of Texas. *See* Prelim. Resp. 17–25.

On November 1, 2023, Petitioner’s counsel emailed the Board to request authorization to:

- (1) submit a stipulation like the stipulation in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020); and

- (2) file a preliminary reply to address Patent Owner's arguments that (i) the Petition "raises voluminous and excessive grounds without justification" and (ii) the Board should exercise discretion based on *Fintiv* to deny institution in view of parallel litigation.

Ex. 3001. Patent Owner indicated that it will not oppose a one-page reply to allow Petitioners to provide their revised stipulation, so long as Petitioners would not oppose a one-page sur-reply by Patent Owner. *Id.* Patent Owner opposes any request for additional briefing that goes beyond the *Fintiv* issue, including any proposed supplemental briefing on merits issues, excessive/voluminous grounds, or Section 325(d). *Id.*

The Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022) ("Interim Procedure") states as follows:¹ "Consistent with *Sotera Wireless, Inc.*, the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB." Interim Procedure at 3 (footnote omitted) (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A)); *see id.* at 7, 9.

Accordingly, the Board believes that a *Sotera* stipulation will simplify the issues in this proceeding and avoid an extensive analysis whether the Board should exercise discretion based on *Fintiv* to deny institution in view of parallel litigation.

¹ Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

Further, after reviewing the Petition and the Preliminary Response and considering the circumstances, the Board believes that further briefing will assist it in deciding whether the Petition “raises voluminous and excessive grounds without justification.”

ORDER

Accordingly, it is

ORDERED that no later than five business days after the date of this order, Petitioner may file a *Sotera* stipulation;

ORDERED that no later than five business days after the date of this order, Petitioner may file a Preliminary Reply no longer than four pages that addresses whether the Petition “raises voluminous and excessive grounds without justification” and the proper application of the *Fintiv* factors in this proceeding;

FURTHER ORDERED that no later than ten business days after the date of this order, Patent Owner may file a Preliminary Sur-reply no longer than four pages that responds to the Preliminary Reply; and

FURTHER ORDERED that Petitioner may not file any new evidence with the Preliminary Reply and Patent Owner may not file any new evidence with the Preliminary Sur-reply.

IPR2023-00993
Patent 9,941,830 B2

For PETITIONER:

Ali R. Sharifahmadian
Jin-Suk Park
Christopher Marando
Tyler Knox
ARNOLD & PORTER KAYE SCHOLER LLP
ali.sharifahmadian@arnoldporter.com
jin.park@arnoldporter.com
chris.marando@arnoldporter.com
tyler.knox@arnoldporter.com

For PATENT OWNER:

Reza Mirzaie
Qi (Peter) Tong
Kristopher R. Davis
RUSS AUGUST & KABAT
rmirzaie@raklaw.com
ptong@raklaw.com
kdavis@raklaw.com