Paper No. 15

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.

Case No. IPR2023-00993
U.S. Patent No. 9,941,830

PATENT OWNER'S PRELIMINARY SUR-REPLY

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Order Denying Motion to Stay Proceedings Pending *Inter Partes* Review in *Resonant Systems, Inc. v. Samsung Elecs. Co., Ltd.*, No. 2:22-cv-00423 (E.D. Tex. Aug. 10, 2023)
2002	Federal Court Management Statistics for the Eastern District of Texas (June 2023)
2003	Plaintiff's Infringement Contentions in *Resonant Systems, Inc. v. Samsung Elecs. Co., Ltd.*, No. 2:22-cv-00423 (E.D. Tex. Mar. 7, 2023)
2004	Defendants' Invalidity Contentions in *Resonant Systems, Inc. v. Samsung Elecs. Co., Ltd.*, No. 2:22-cv-00423 (E.D. Tex. June 16, 2023)

Petitioner's preliminary reply fails to address, let alone refute, patent owner's central argument for discretionary denial based upon *Adaptics*. Petitioner does not dispute—and could not dispute—that its petition raises more than thirty grounds or that this is an unusually high number of grounds. More importantly, petitioner does not even attempt to explain why so many grounds are necessary or justified by the facts and issues raised in this case. Indeed, there is no justification for burdening the Board and patent owner with considering and responding to this excessive number of grounds in petitioner's scattershot petition. For that reason, and for the other reasons set forth in the preliminary response, the Board should exercise its discretion to deny institution.

A. The Board Should Deny Institution for Raising Voluminous and Excessive Grounds

While the use of "and/or" was an issue in *Adaptics*, the Board's decision denying institution made clear that it was not dispositive. Rather, the Board noted that even if the "and/or" were effectively replaced by "or" in the third obviousness ground, such that only two-reference combinations were considered, the resulting seventeen combinations would yield "an unduly burdensome number of combinations." *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20, 18–19 (PTAB Mar. 6, 2019). The Board then explained how the use of "and/or" made the situation still worse by adding hundreds of additional combinations. *Id.* But nothing in *Adaptics* suggests that simply avoiding the use of "and/or" makes a petition immune from denial on *Adaptics* grounds. Rather, it expressly says the opposite.

The fact that the *Adaptics* petition actually contained hundreds of grounds or that other petitions that have been denied institution contained thousands, *e.g.*, *Uber Tech., Inc. v. Surgetech LLC*, IPR2023-00735, Paper 13, 13–16 (PTAB Oct. 12, 2023), does not mean

that the petition's purported 30 grounds[1] is appropriate. As the Board made clear in *Adaptics*, even a petition with dozens of combinations would have been "unduly burdensome" in the circumstances of that case. *Adaptics*, IPR2018-01596, Paper 20 at 18–19.

The fact that the grounds may follow discernable "patterns," as argued by petitioner, also does not solve the problems of voluminousness or undue burden. The *Adaptics* grounds likewise followed patterns. *E.g.*, *Adaptics*, IPR2018-01596, Paper 20 at 8–9, 18–19. Indeed, it is hard to imagine how a petitioner *could* present dozens or hundreds of grounds within the 14,000-word limit *without* relying heavily on patterns and reusing the same arguments across a number of different grounds. Even though there are patterns and overlapping issues, the large number of grounds necessarily increases the burden and complexity. The only possible reason for asserting 12 obviousness grounds against a single claim (as the petition does against claim 7) is because the petitioner envisions the possibility that 11 of those grounds might fail and only the single remaining ground would successfully establish obviousness. While the issue of what a given reference teaches may be common across several different grounds, other necessary factors in the obviousness analysis, such as ascertaining differences between the claimed invention and the prior art, *see Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), and motivation to combine may be unique to each combination. Undue multiplicity of obviousness grounds burdens both patent owner and the Board, even if there are patterns among the grounds.

The cases cited by petitioner do not support granting institution. In *PAWS*, the patent owner did not even contend that institution should be denied based on the number of grounds or the *Adaptics* analysis alone. *PAWS v. Onpoint Sys.*, IPR2021-01483, Paper 10,

[1] An undercount, as discussed in Paper 11 at 9–10.

29–30 (Dec. 16, 2021). Rather, the patent owner presented the number of grounds as one of two arguments under the sixth *Fintiv* factor. *Id.* at 25–30. The Board deemed the burden "minimal" because the alternative combinations related to a single limitation. *PAWS v. Onpoint Sys.*, IPR2021-01483, Paper 11, 18 (PTAB Dec. 16, 2021). Here, even petitioner's own summary of its grounds makes clear the combinations do not all relate to the same limitations. Paper 14 at 2. Importantly, the Board in *PAWS* found that the sixth *Fintiv* factor as a whole weighed in favor of institution because the secondary references were "explicitly referenced in the corresponding primary reference for the relied-upon teachings," making the grounds "particularly strong" on the merits. *Id.* at 19. No similarly strong arguments on the merits are present here.

Philip Morris involved only five references and fewer combinations than at issue here. *Philip Morris Prods. SA v. RAI Strategic Holdings, Inc.*, IPR2020-00921, Paper 13, 16 (PTAB Aug. 5, 2021). Just as importantly, the petitioner identified a specific reason for using two different references to satisfy a particular limitation under two different constructions of a disputed claim term. *Id.* at 40–41 (use of different references to satisfy limitation under broad and narrow construction "distinguishes this case from *Adaptics*"). Petitioner points to no similar claim construction dispute in the present petition that would justify multiplying the number of references and grounds.

B. Petitioner Fails to Rebut Patent Owner's Arguments for Denial of Institution

While petitioner dismisses certain of patent owner's arguments as "meritless," it does not actually dispute them as a factual matter or establish that they should not be considered in determining whether the petition's grounds are excessive. Petitioner does not dispute that grounds 2A-C each contain "alternative combinations" within them, that petitioner's

expert invokes additional references, or that nine grounds are directed to unasserted claims. Paper 14 at 3–4. Petitioner likewise does not dispute that the petition presents 12 grounds challenging claim 7 or that an "and/or" ground presenting all combinations among the references at issue would represent 16 grounds. Paper 14 at 4; Paper 11 at 11.

Petitioner misreads *Adaptics* when it says that "nothing in *Adaptics* suggests that 10 references is improper." Paper 14 at 4. The Board in *Adaptics* expressly held that the number of references in that petition was "disproportionately large" and pointed to that as a reason to deny institution. *Adaptics*, IPR2018-01596, Paper 20 at 21–22. The number of references in *Adaptics* was also 10. *Id*. at 6.

The preliminary response points to several substantive shortcomings in the petition that flow in part from petitioner's large number of grounds and the brief discussion devoted to many of them. Paper 11 at 12–14. Petitioner's reply dismisses these arguments as "*ipse dixit* and cursory" but does not even attempt to substantively rebut them. Petitioner suggests that these arguments should be rejected because they "go to the merits of the Petition," but consideration of the merits and the sufficiency of the petition's arguments is not only appropriate at the institution stage but required. 35 U.S.C. § 314(a); *see Adaptics*, IPR2018-01596, Paper 20 at 13. It is both appropriate and entirely routine for an attorney-written preliminary response to point out the factual and legal shortcomings of the arguments presented in a petition.

C. Conclusion

For the foregoing reasons and the reasons set forth in the preliminary response, the Board should exercise its discretion to deny institution of the petition.

Dated: November 20, 2023

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CERTIFICATE OF SERVICE

I hereby certify that "Patent Owner's Preliminary Sur-Reply" was served on November 20, 2023 by email sent to:

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