

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONIC SCO., LTD,
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

SLYDE ANALYTICS, LLC,
Patent Owner.

IPR2024-00002
Patent 9,651,922 B2

Before JAMESON LEE, ST. JOHN COURTENAY III, and
JOHN F. HORVATH, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER
Granting-in-Part Request to File Preliminary Reply
37 C.F.R. § 42.108(c)

I. INTRODUCTION

A conference call was held on February 20, 2024, between respective counsel for the parties and Judges Lee, Courtenay III, and Horvath, in response to Petitioner's email of February 8, 2024 (Ex. 3001) requesting authorization to file a preliminary reply to Patent Owner's Preliminary Response filed on January 17, 2024. In the email, Petitioner stated:

Specifically, the preliminary reply would address the following: (1) Patent Owner's argument for denial under Section 325(d) based on a secondary reference that was not considered during prosecution; (2) Patent Owner's argument that the prior art does not disclose scrolling cards that occupy the "entire digital matrix display," and (3) Patent Owner's argument that Duarte does not disclose causing "several available cards to scroll past."

Ex. 3001. Petitioner further stated: "[I]f the Board would prefer Petitioner to address [*Fintiv*] issue in a paper, Petitioner requests authorization to address Patent Owner's arguments for discretionary denial under Section 314(a), as well, in the requested reply here and in the related proceedings [IPR2024-00006, IPR2024-00040, IPR2024-00041]." *Id.*

During the conference call, the panel heard arguments from both parties. For reasons discussed below, in this proceeding, Petitioner's request is *granted-in part*.

II. DISCUSSION

The filing of a preliminary reply is not automatically authorized by the rules. "A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause." 37 C.F.R. § 42.108(c).

Patent Owner objects to Petitioner having an opportunity to respond to Patent Owner's arguments for discretionary denial under 35 U.S.C. § 325(d),

because Patent Owner believes Petitioner should have already expected the argument made by Patent Owner. Petitioner, however, made sufficient arguments to indicate that the argument made by Patent Owner might not have been reasonably foreseeable. We find good cause to allow Petitioner an opportunity to respond to Patent Owner's arguments under 35 U.S.C. § 325(d), provided that Petitioner also explains in the preliminary response why Patent Owner's argument was not reasonably foreseeable.

With regard to discretionary denial under 35 U.S.C. § 314(a), Petitioner indicates in its email that it has filed a *Sotera*-type stipulation and that that should moot the issue. Ex. 3001. However, in the conference call, counsel for Patent Owner represented that Patent Owner does not withdraw its request for discretionary denial under 35 U.S.C. § 314(a). Accordingly, it is appropriate to allow Petitioner an opportunity to respond to Patent Owner's arguments under 35 U.S.C. § 314(a).

With regard to the other two matters Petitioner seeks to address in a preliminary reply, i.e., (2) Patent Owner's argument that the prior art does not disclose scrolling cards that occupy the "entire digital matrix display," and (3) Patent Owner's argument that Duarte does not disclose causing "several available cards to scroll past," we find Petitioner has not made a showing of good cause under 37 C.F.R. § 42.108(c) to justify its filing of a preliminary reply.

Both matters directly involved expressly recited claim limitations. Item 2 involves limitation [1e] and [1g] and is specifically addressed, in detail, on pages 19–22 and 106–110 of the Petition. Item (3) involves limitation [1c] and [1e] and is specifically addressed, in detail, on pages 56–60 of the Petition. We do not see Patent Owner's arguments in the

Preliminary Response as deviating from the issues presented in the Petition or going beyond alleging lack of support for Petitioner's contentions. Indeed, counsel for Petitioner during the conference call represented that Petitioner desires to point out in the requested preliminary reply where in the Petition Petitioner already presented evidence Patent Owner asserts is not there.

Further, Petitioner asserts that it desires to explain why "entirety" can be met by "substantially all" as a matter of claim construction. But Patent Owner did not propose any surprising construction of "entire" or "entire digital matrix display." What Patent Owner proposed as the plain and ordinary meaning of "entirety" cannot be deemed unexpected by Petitioner who has the obligation, in the first instance, under 37 C.F.R. § 42.104 (b)(3), to identify "[h]ow the challenged claim is to be construed." Petitioner failed to show any instance in which Patent Owner in the Preliminary Response applied a meaning that did not flow directly from the plain wording of the claims.

For the foregoing reasons, Petitioner has not shown good cause with respect to Items (2) and (3).

III. ORDER

It is

ORDERED that Petitioner's request to file a preliminary reply is *granted-in-part*, in that the request is *denied* with respect to Items (2) and (3) discussed above,¹ and *granted* with respect to addressing Patent Owner's

¹ Item (2) is Patent Owner's argument that the prior art does not disclose scrolling cards that occupy the "entire digital matrix display." Item (3) is Patent Owner's argument that Duarte does not disclose causing "several available cards to scroll past."

arguments for discretionary denial under 35 U.S.C. § 325(d) and 35 U.S.C. § 314(a);²

FURTHER ORDERED that the preliminary reply is limited to five pages and due February 27, 2024; and

FURTHER ORDERED that Patent Owner is authorized to file a preliminary sur-reply, limited to three pages and due March 1, 2024.

² The preliminary reply shall also explain why Patent Owner's arguments under 35 U.S.C. § 325(d) was not reasonably foreseeable to Petitioner to address in the first instance in the Petition.

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