

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., GARMIN LTD., and
ZEPP HEALTH CORPORATION
Petitioner,

v.

SLYDE ANALYTICS, LLC,
Patent Owner.

IPR2024-00006
Patent 8,588,033 B2

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

COURTENAY, *Administrative Patent Judge*.

ORDER
Conduct Of The Proceeding
37 C.F.R. § 42.5

I. INTRODUCTION

A conference call was held on December 4, 2024, between respective counsel for the parties and Judges Lee, Courtenay, and Horvath. During the conference seven issues were discussed:

(1) A motion for termination as to understudy Petitioner Samsung Electronics Co., Ltd. and Samsung Electronics America (hereinafter “Samsung”),

(2) Promotion of Petitioner Zepp Health (hereinafter “Zepp”) to lead Petitioner and demotion of Petitioner Garmin Ltd. (hereinafter Garmin) to an “understudy” role,

(3) The parties’ preference for an in-person or remote hearing location for Patent Owner Slyde Analytics, LLC (hereinafter “Slyde”) and Petitioner Zepp,

(4) Whether counsel for Garmin (Mr. Seitz) needs to contact the Board when Garmin reaches a settlement agreement with the Patent Owner,

(5) Extension of due dates 5–7 in the Scheduling Order (paper 14),

(6) Whether Patent Owner intends to file a motion to amend, and

(7) Patent Owner’s request to file an expert declaration with their sur-reply.

As background, Garmin contacted the Board on November 26, 2024 to inform the panel that “Petitioner Garmin and Patent Owner Slyde have reached a settlement in principle of the related district court litigation.” Ex. 3004. Garmin requested “leave to file a joint motion to terminate Garmin’s further participation in IPR2024-00006 once the final settlement agreement has been executed.” *Id.* Garmin also indicated that “[j]oint Petitioner Zepp intends to take over the role of lead Petitioner . . . in IPR2024-00006.” *Id.*

On November 27, 2024, Patent Owner requested authorization to file a supplemental expert declaration with its sur-reply. Ex. 3005.

In addition, Samsung notified the Board on December 3, 2024 that Petitioner Samsung and Patent Owner Slyde had reached a settlement. Ex. 3006. Samsung requested: (1) permission to file a joint motion to terminate IPR2024-00006 with respect to Samsung only, under 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, and (2) permission to accompany the motion with a Joint Request to Keep Separate, which asks the Board to treat the settlement agreement as business confidential information and to keep it separate from the files of the challenged patent.

II. DISCUSSION

Issue 1: During the conference call on December 4, 2024, we authorized Mr. Cook, as counsel for Petitioner Samsung: (1) to file a motion to terminate as to Samsung, along with a settlement agreement, and (2) to accompany the motion with a Joint Request to Keep Separate so the settlement agreement will be treated as business confidential information.

Issue 2: Due to the expected settlements of Petitioners Garmin and Samsung with Patent Owner, and as a follow-up to our October 18, 2024 order (Paper 23), the changing roles of the Petitioner parties were discussed. Given the unique facts of this case, the panel finds it reasonable to promote Zepp Health to Lead Petitioner, and demote Garmin to an “understudy” role. Samsung will remain in its understudy role until its motion to terminate is filed and approved. If the circumstances materially change and the expected settlement between Garmin and Patent Owner does not occur, the parties should contact the Board to discuss the matter further.

Issue 3: We asked for the preferences of Patent Owner Slyde and Petitioner Zepp regarding the January 9, 2025 hearing location. After considering the preferences of the parties, it was decided that an in-person hearing would be conducted on January 9, 2025 (1:00 PM EST) at the USPTO headquarters in Alexandria, VA.

Issue 4: Counsel for Garmin (Mr. Seitz) requested permission to file a motion to terminate when Garmin reaches a settlement agreement with Patent Owner, presumably before the end of the year. We responded that when such settlement agreement is reached, Garmin should contact the Board.

Issue 5: We discussed the request from Petitioner Zepp to extend due dates 5–7 in the Scheduling Order to give Zepp approximately one week, now that Zepp is taking over the lead role, to determine whether a motion to exclude evidence is needed. Because the request is unopposed by Petitioner, the request was granted. Therefore, on the call we authorized the parties to file a Notice of Stipulated Change to the Scheduling Order, extending due dates 5, 6, and 7 by mutual agreement.¹

Issue 6: We asked Mr. Rubino whether Patent Owner intended to file a motion to amend in this proceeding. Mr. Rubino answered no.

¹ We note that Zepp subsequently filed a notice extending due dates 3 and 5–7 as Paper 13 in IPR2024-00833, the proceeding between Zepp and Slyde that had previously been joined to this proceeding. Per the terms of our Order joining IPR2024-00833 to this proceeding, “all future filings in the joined proceeding [were] to be made only in IPR2024-00006.” *See Zepp Health Corp. v. Slyde Analytics, Inc.*, IPR2024-00833, Paper 12 at (PTAB Sept. 12, 2024). Consequently, any Notice extending these due dates in *this* proceeding should be filed in *this* proceeding.

Issue 7: Lastly, we discussed Patent Owner’s November 27, 2024 request to file an expert declaration with its sur-reply. Ex. 3005. Patent Owner contends Petitioner raised new arguments in its Reply, including the assertion of new facts, and Patent Owner expressed the need for an opportunity to dispute the facts on the new arguments in an expert declaration. Guided by the “Consolidated Practice Guide,” at pages 73–74,² the panel denied Patent Owner’s request. Patent Owner was reminded they may address any arguments Patent Owner feels are beyond the scope of the Petition in its sur-reply, or request authorization to file a motion to strike such arguments.

III. ORDER

It is

ORDERED that Zepp Health will replace Garmin Ltd. as Lead Petitioner in this proceeding, Garmin will assume a primary “understudy role,” and Samsung will assume a secondary “understudy role” until a motion to terminate is received and approved;

FURTHER ORDERED that Garmin, in its “understudy” role, may no longer file substantive papers or take any active role in the proceeding; however, this in no way prohibits Garmin from filing a motion to terminate, together with a true copy of its settlement agreement with Patent Owner;

² See Patent Trial and Appeal Board, “Consolidated Trial Practice Guide,” November 2019, pp. 73–74 (“The sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness. Sur-replies should only respond to arguments made in reply briefs, comment on reply declaration testimony, or point to cross-examination testimony.”)

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FURTHER ORDERED that until a motion to terminate is received and approved, both Samsung and Garmin will remain in their “understudy” roles and will be bound by future substantive filings of Zepp Health as Lead Petitioner;

FURTHER ORDERED that Petitioner and Patent Owner shall refile in this proceeding, within one week of the date of issuance of this Order, the stipulated notice extending due dates in this proceeding previously filed in IPR2024-00833 or a revision thereto; and

FURTHER ORDERED that Patent Owner’s request to file an expert declaration with its Sur-reply is *denied*.

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