

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners,

v.

SLYDE ANALYTICS, LLC,

Patent Owner.

Patent No. 10,198,085
Filing Date: October 31, 2017
Issue Date: February 5, 2019

Inventors: Alex Bezing, Adrian Mohni, Daniel Pfeifer, and Musa Dogan
Title: METHOD AND CIRCUIT FOR SWITCHING A WRISTWATCH
FROM A FIRST POWER MODE TO A SECOND POWER MODE

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2024-00041

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2001	Second Amended Docket Control Order, Dkt. 33, <i>Slyde Analytics LLC v. Samsung Elecs. Co.</i> , No. 2:23-cv-00083-RWS-RSP (E.D. Tex. October 5, 2023)
2002	Defendants' Joint Patent L.R. 3-3 Invalidity Contentions and Subject Matter Ineligibility Contentions, <i>Slyde Analytics LLC v. Samsung Elecs. Co.</i> , No. 2:23-cv-00083-RWS-RSP, served November 14, 2023

I. INTRODUCTION

On November 2, 2023, Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioner” or “Samsung”) submitted a petition (Paper 3, “Petition” or “Pet.”) to institute *inter partes* review (“IPR”) of U.S. Patent No. 10,198,085 (Ex. 1001, the “’085 Patent”), challenging claims 1-10 (the “Challenged Claims”). The Petition asserts that (i) Claims 1-10 are obvious over U.S. Patent Application Publication No. US 2009/0164219 (“Ex. 1005” or “Yeung”) in view of U.S. Patent No. 8,228,292 (“Ex. 1006” or “Ruiz”); (ii) Claims 1-4, 6, and 8-10 are obvious over Yeung combined with U.S. Patent Application Publication No. US 2011/0148752 (“Ex. 1007” or “Alameh”) and further combined with Mark Joselli and Esteban Clua, gRmobile: A Framework for Touch Accelerometer Gesture Recognition for Mobile Games, IEEE 141-150 (2010) (“Ex. 1008” or “Joselli”); and (iii) Claims 5 and 7 are obvious over Yeung combined with Alameh and Joselli and further combined with U.S. Patent No. 8,615,375 (“Yano”). Pet. at 3. The Board should deny the Petition for at least the reasons described briefly below.

Petitioner also fails to show that both combinations of Yeung and Ruiz and Yeung, Alameh, and Joselli disclose at least “switching said wristwatch from said first power mode to said second power mode when a wristturn has been detected,” and “in response to a detection that the orientation of the wristwatch is in the second

range, detecting that the wristwatch remains substantially immobile during a predetermined duration and that a duration between the starting position and the final position is in a predefined range,” as required by Claim 1 of the ’085 Patent. In particular, neither Petitioner’s Grounds 1 and 2 show that the cited references disclose a wristwatch with multiple power modes or a duration of time between the starting position and final position of the wristwatch in a predefined range.

The Board should exercise its discretion to deny the Petition under 35 U.S.C. § 314(a) for at least the following reasons: (i) there exists a parallel District Court Litigation between the same parties or real-parties-in-interest; (ii) the District Court Litigation involves the same subject patent (the ’085 Patent) with substantially the same claims; (iii) the District Court’s trial will be *over three months before* the projected statutory deadline; (iv) the parties have heavily invested in the District Court Litigation and a trial date is set for February 18, 2025; and (v) there is no stay of the parallel District Court Litigation.

II. THE ’085 PATENT

The ’085 Patent “is related to a method for switching a wristwatch from a first power mode to a second power mode, and to a wristwatch which can be switched from a first power mode to a second power mode. The present invention is also related to wristwatches with a touch panel and a plurality of power modes. ’085 Patent, 1:15-20.

As the '085 Patent describes, the various components for wristwatches that would determine the claimed wristwatch's first power mode and second power mode cannot be compared to or combined with the components for mobile phones or other larger computing devices. The '085 Patent further describes that wristwatches possess a greater potential for false positives, namely, of "undesirable activation of the touch panel," because of higher acceleration, during normal use or during sport, due to their size and mass.

EP2315101 describes a method combining use of an inertial sensor and of a touch panel for detecting taps on the touch panel of a device such as a smartphone. The detection of taps by the touch panel is mainly based on the amplitude of the acceleration signal; if this amplitude is higher than a threshold, then the touch panel will be woken up to confirm this detection. Although this process might work well in smartphones, it has been found that *a more precise detection method would be needed for wristwatches*. Indeed, *wristwatches are often subject to high acceleration values*, sometimes in the magnitude of 50 G or higher, in normal use or during sport. The inertial system described in this document is not able to distinguish reliably between those high acceleration values in normal use and acceleration due to a tap or other gesture. This results in numerous undesirable activation of the touch panel and therefore in a decrease of the power reserve. Moreover, the user is requested to exert a strong pressure on the display in order to produce an acceleration above the detection threshold.

'085 Patent, 1:55-2:6 (emphasis added).

The '085 Patent explicitly describes that various “functionalities” can be activated and displayed by the user within *one* power mode (*i.e.*, without switching power modes):

The display 4 can display various indications, for example the current time, date, chrono, reverse counter, calendar, etc. . . . or phases of the moon as shown in FIG. 1. ***In order to extend the watch’s functionalities, the user can switch from one display mode to another and for example replace the card displayed in FIG. 1 with other cards.*** In a preferred embodiment, the user can move from one card to the other with a slide (fast) or scroll (slow) gesture for moving through and viewing a collection of available displays or cards. Scrolling or sliding in the horizontal or vertical direction is achieved by moving the finger on the glass in the corresponding direction.

Id., 4:60-5:4 (emphasis added).

As noted in the '085 Patent, the claimed “predefined range” or “given range” can be the angular range in relation to the user’s face between the starting position of the wristwatch and the final position of the wristwatch:

The accelerometer 23 is set so as to generate an interrupt ***when its position changes and reaches a given range*** that is maintained during a predetermined duration, as will be described.

Id., 9:48-51 (emphasis added).

The duration between the starting position and the final position may be measured. If this duration is not in a predefined range, the method is interrupted. Otherwise, the touch controller 24 changes to a No-movement & Angle Check mode. Alternatively, this No-movement &

Angle Check detection may be performed by the embedded processing capabilities within the accelerometer 23.

Id., 10:18-24 (emphasis added).

III. THE ALLEGED PRIOR ART

A. Yeung

Yeung relates to using accelerometer-based orientation and/or movement sensing to control wearable devices, such as wrist-worn audio recorders and wristwatches. Ex. 1005, [0005].

Yeung describes that an “audio recording function of audio recorder 30 turns on automatically when the user positions audio recorder 30 in a predetermined orientation, such as the natural orientation for recording shown in FIG. 6, and/or after audio recorder 30 has completed a predetermined movement” without noting whether the function is activated within a power mode or not. Ex. 1005, [0048].

B. Ruiz

Ruiz focuses exclusively on mobile devices:

This document relates to systems and techniques for interpreting motion-based user inputs to a mobile computing device.

Ex. 1006, 1:15-17.

In general, the system is represented by a mobile device 202, such as a smart phone, that has a touch screen display 208.

Id., 6:47-49.

Describing how to determine an intentional movement by the user, Ruiz discloses that the “user may hold the device in this orientation for a time period, which may be as little as a split instant,” with no upper bound on time (*i.e.*, an indefinite or not defined time). *Id.*, 4:53-63.

C. Alameh

Alameh focuses exclusively on mobile devices:

The present invention relates generally to mobile devices and, more particularly, to methods and systems capable of being implemented by mobile devices that facilitate interactions with one or more of those mobile devices.

Mobile devices such as cellular telephones, smart phones, and other handheld or portable electronic devices such as personal digital assistants (PDAs), headsets, MP3 players, etc. have become increasingly popular and ubiquitous. As more and more people carry mobile devices with them, there is a desire that such mobile devices become capable of numerous functions, yet also be easy to use.

Ex. 1007, [0002]-[0003].

D. Joselli

Joselli is directed to mobile phone games and gestures used in mobile phone games:

Mobile phone games are usually designed to be able to play using the traditional number pads of the handsets. This is stressfully difficult for the user interaction and consequently for the game design. Because of that, one of

the most desired features of a mobile game is the usage of few buttons as possible.

...

This framework can also be used for the development of mobile application with the use of gestures.

Ex. 1008, 141.

IV. CLAIM CONSTRUCTION

For the purposes of this Preliminary Response, Patent Owner agrees with Petitioner that claim construction is not warranted. Pet. at 8. At this stage, Patent Owner does not believe claim construction is required to resolve any issues.

V. LEVEL OF ORDINARY SKILL IN THE ART

For the purposes of this Preliminary Response only, Patent Owner utilizes Petitioner's proposed level of skill in the art: "a bachelor's degree in electrical engineering, computer science, computer engineering, or a related field, and two-three years of experience in the research, design, development, or testing of user interfaces, inertial sensors, touchscreens, and human-computer interaction in mobile devices, with additional education substituting for experience and vice-versa." Pet. at 7 (citations omitted).

VI. PETITIONER HAS NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF SUCCESS FOR THE GROUNDS ADVANCED IN THE PETITION, AND THE PETITION SHOULD BE DENIED

The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art, (2) any

differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) so-called secondary considerations where in evidence. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983).

The Board has held that a failure to identify the differences between the claimed subject matter and the prior art is fatal to an obviousness challenge. *See, Apple, Inc. v. Contentguard Holdings, Inc.*, IPR2015-00355, Decision Denying Institution of *Inter Partes* Review, Paper 9 at 9-10 (P.T.A.B. June 26, 2015) (denying institution for failure to identify the differences between the claimed subject matter and the prior art).

In arriving at an obviousness determination, the Board must sufficiently explain and support the conclusions that the prior-art references disclose all the elements recited in the Challenged Claims and a relevant, skilled artisan not only could have made, but would have been motivated to combine all the prior art references in the way the patent claims and reasonably expected success. *Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017). That is, even if all the claim elements are found across a number of references, an obviousness

determination must consider whether a person of ordinary skill in the art would have the motivation to combine those references. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1368 (Fed. Cir. 2016); *Los Angeles Biomedical Rsch. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co.*, 849 F.3d 1049, 1067 (Fed. Cir. 2017) (vacating and remanding an obviousness determination, in part, because the Board did not make factual finding as to whether there was an apparent reason to combine all three prior art references to achieve the claimed invention and whether a person of skill in the art would have had a reasonable expectation of success from such a combination). This combinability determination, as supported by an articulated motivation to combine, requires a plausible rationale as to why those prior art references would have worked together. *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1335 (Fed. Cir. 2013). Absent some articulated rationale, a “common sense” finding is no different than the conclusory statement “would have been obvious.” *In re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017). Of additional importance, “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references. . . .” *Innogenetics, N.V. v. Abbott Lab’ys.*, 512 F.3d 1363, 1373 (Fed. Cir. 2008).

A. Ground 1: Claims 1-10 Are Not Obvious Over Yeung in View of Ruiz

1. The Petition Does Not Show that the Combination of Yeung and Ruiz Discloses “switching said wristwatch from said first power mode to said second power mode when a wristturn has been detected,” as Required by Claim Element 1[b]

Claim 1 of the '085 Patent recites “switching said wristwatch from said first power mode to said second power mode when a wristturn has been detected.” Petitioner only relies on Yeung to disclose this claim limitation. Pet. at 29.

Petitioner fails to demonstrate that Yeung discloses multiple power modes. Petitioner equates activating functionality, i.e., an audio recorder, with switching power modes, but Petitioner presents no evidence that Yeung changes power modes when the audio recorder is activated. Pet. at 29. The fact that a function may cause a device to consume more power than when the device is idle does not demonstrate that the device has also changed power modes.

Petitioner incorrectly argues that activating an audio recording function shows a “switch from a lower-power ‘first power mode’ to a higher-power ‘second power mode’ because audio recording would consume additional processing power.” Pet. at 29. Petitioner’s understanding is incorrect because Yeung’s audio recording is just a functionality that can be activated or not, which is irrelevant as to whether there are switched power modes. In fact, the '085 Patent explicitly describes that various “functionalities” can be activated and displayed by the user within *one* power mode

(i.e., without switching power modes):

The display 4 can display various indications, for example the current time, date, chrono, reverse counter, calendar, etc. . . . or phases of the moon as shown in FIG. 1. ***In order to extend the watch's functionalities, the user can switch from one display mode to another and for example replace the card displayed in FIG. 1 with other cards.*** In a preferred embodiment, the user can move from one card to the other with a slide (fast) or scroll (slow) gesture for moving through and viewing a collection of available displays or cards. Scrolling or sliding in the horizontal or vertical direction is achieved by moving the finger on the glass in the corresponding direction.

'085 Patent, 4:60-5:4 (emphasis added). Therefore, activating a functionality (e.g., an audio recording), as Yeung describes, does not disclose the claimed “switching said wristwatch from said first power mode to said second power mode.”

Petitioner attempts to bootstrap its argument to the '085 Patent, arguing that “[t]his is similar to the challenged patent’s characterization of the second power mode as a ‘time display’ mode as opposed to a ‘power saving’ first power mode.” Pet. at 29 (citing Ex. 1001, 6:2-6). The Petition then quotes the '085 Patent’s disclosure that “the wristwatch should be switched to a second power mode for example in order to activate the display.” Pet. at 29 (quoting Ex. 1001, 9:40-42). However, this disclosure merely shows that in the '085 Patent, a power mode is changed when certain functionality is enabled; it does not show, as Petitioner argues, that Yeung’s activation of its display *necessarily* causes a corresponding change in

power mode.

Therefore, the Petition is deficient because it fails to show that claim element 1[b] is disclosed or rendered obvious by the combination of Yeung and Ruiz.

2. The Petition Does Not Show that the Combination of Yeung and Ruiz Discloses “*detecting that an orientation of the wristwatch is in a starting position, wherein said step of detecting that the orientation is in the starting position comprises detecting that the orientation of the wristwatch is held within a first range for a defined time,*” as Required by Claim Element 1[c.1]

Claim 1 of the '085 Patent recites “detecting that an orientation of the wristwatch is in a starting position, wherein said step of detecting that the orientation is in the starting position comprises detecting that the orientation of the wristwatch is held within a first range for a defined time.”

The Petition does not show that the combination of Yeung and Ruiz discloses a “defined time” within which the orientation of the wristwatch is detected to be held within a first range. Even Petitioner’s own citation to Ruiz’s disclosure that the “user may hold the device in this orientation for a time period, which may be as little as a split instant,” actually indicates an undefined time period because the time “*may* be as little as a split instant” with no upper bound on time (*i.e.*, an indefinite or not defined time). Pet. at 33 (citing Ex. 1006, 4:53-63) (emphasis added).

Therefore, the Petition is deficient because it fails to show that claim element 1[c.1] is disclosed or rendered obvious by the combination of Yeung and Ruiz.

3. The Petition Does Not Show that the Combination of Yeung and Ruiz Discloses “*detecting that an orientation of the wristwatch is then in a final position, wherein said step of detecting that the orientation is in the final position comprises detecting that the orientation is in a second range different from said first range,*” as Required by Claim Element 1[c.2]

Claim 1 of the '085 Patent recites “detecting that an orientation of the wristwatch is then in a final position, wherein said step of detecting that the orientation is in the final position comprises detecting that the orientation is in a second range different from said first range.”

Since the combination of Yeung and Ruiz does not disclose the claimed “detecting that an orientation of the wristwatch is in a starting position, wherein said step of detecting that the orientation is in the starting position comprises detecting that the orientation of the wristwatch is held *within a first range for a defined time,*” it cannot now disclose the claimed “detecting that an orientation of the wristwatch is then in a final position, wherein said step of detecting that the orientation is in the final position comprises detecting that the orientation is in a *second range different from said first range.*” *See supra* Section VI.A.2.

Therefore, the Petition is deficient because it fails to show that claim element 1[c.2] is disclosed or rendered obvious by the combination of Yeung and Ruiz.

4. The Petition Does Not Show that the Combination of Yeung and Ruiz Discloses “in response to a detection that the orientation of the wristwatch is in the second range, detecting that the wristwatch remains substantially immobile during a predetermined duration and that a duration between the starting position and the final position is in a predefined range,” as Required by Claim Element 1[c.3]

Claim 1 of the '085 Patent recites “in response to a detection that the orientation of the wristwatch is in the second range, detecting that the wristwatch remains substantially immobile during a predetermined duration and that a duration between the starting position and the final position is in a predefined range.”

Since the combination of Yeung and Ruiz does not disclose the claimed “detecting that an orientation of the wristwatch is then in a final position, wherein said step of detecting that the orientation is in the final position comprises detecting that the orientation is in *a second range different from said first range*,” it cannot now disclose the claimed “*in response to a detection that the orientation of the wristwatch is in the second range*, detecting that the wristwatch remains substantially immobile during a predetermined duration and that a duration between the starting position and the final position is in a predefined range.” *See supra* Section VI.A.3.

Petitioner also does not show that the combination of Yeung and Ruiz discloses the claimed “duration between the starting position and the final position is in a predefined range.” Instead, Petitioner only argues that “[t]he period of time

from when the user begins the double flip to when the user completes the double flip is within a predefined range of 200ms.” Pet. at 37. However, Petitioner incorrectly conflates the separately claimed “duration” of time with the claimed “predefined range.” As with the previously claimed “first range” and “second range,” “predefined range” refers to the spatial range or range of positions of the wristwatch. As noted in the ’085 Patent, the claimed “predefined range” or “given range” can be the angular range in relation to the user’s face between the starting position of the wristwatch and the final position of the wristwatch:

The accelerometer 23 is set so as to generate an interrupt *when its position changes and reaches a given range* that is maintained during a predetermined duration, as will be described.

’085 Patent, 9:48-51 (emphasis added).

The duration between the starting position and the final position may be measured. If this duration is not in a predefined range, the method is interrupted. Otherwise, the touch controller 24 changes to a No-movement & Angle Check mode. Alternatively, this No-movement & Angle Check detection may be performed by the embedded processing capabilities within the accelerometer 23.

Id., 10:18-24 (emphasis added). Yeung and Ruiz are silent on a predefined spatial range in which the duration of the movement of the wristwatch occurs.

Therefore, the Petition is deficient because it fails to show that claim element 1[c.3] is disclosed or rendered obvious by the combination of Yeung and Ruiz.

5. The Petition Does Not Show that the Combination of Yeung and Ruiz Renders Claims 2-10 Obvious

Claims 2-10 are dependent on Claim 1. Therefore, Claims 2-10 are not rendered obvious by the combination of Yeung and Ruiz for at least the same reasons as Claim 1.

B. Ground 2: Claims 1-4, 6, and 8-10 are Not Obvious Over the Combination of Yeung, Alameh, and Joselli

1. The Petition Does Not Show that the Combination of Yeung and Ruiz Discloses “switching said wristwatch from said first power mode to said second power mode when a wristturn has been detected,” as Required by Claim Element 1[b]

Claim 1 of the '085 Patent recites “switching said wristwatch from said first power mode to said second power mode when a wristturn has been detected.” Petitioner relies on the “same reasons described with reference to Ground 1” with respect to this claim limitation, for at least the same reasons as Ground 1. Pet. at 60-61.

Therefore, the Petition is deficient because it fails to show that claim element 1[b] is disclosed or rendered obvious by the combination of Yeung, Alameh, and Joselli. *See supra* Section VI.A.1.

2. The Petition Does Not Show that the Combination of Yeung, Alameh, and Joselli Discloses “*in response to a detection that the orientation of the wristwatch is in the second range, detecting that the wristwatch remains substantially immobile during a predetermined duration and that a duration between the starting position and the final position is in a predefined range,*” as Required by Claim Element 1[c.3]

Claim 1 of the '085 Patent recites “in response to a detection that the orientation of the wristwatch is in the second range, detecting that the wristwatch remains substantially immobile during a predetermined duration and that a duration between the starting position and the final position is in a predefined range.”

Petitioner does not show that the combination of Yeung, Alameh, and Joselli discloses the claimed “duration between the starting position and the final position is in a predefined range.” Instead, Petitioner only argues that “In applying Joselli’s teachings to Yeung’s wrist raise and twist movement pattern, it would have been obvious to require a *predefined range for the time* it takes to complete the movement from the starting position (with the watch/recorder resting by the user’s side) to the final position (with the watch/recorder raised to the user’s mouth and facing the user), *such as 0.6 seconds to 2 seconds*, as disclosed by Joselli.” Pet. at 66 (emphasis added). However, Petitioner incorrectly conflates the claimed “duration” of time with the separately claimed “predefined range.” As with the previously claimed “first range” and “second range,” “predefined range” refers to the spatial range or range of positions of the wristwatch. As noted in the '085 Patent, the claimed

“predefined range” or “given range” can be the angular range in relation to the user’s face between the starting position of the wristwatch and the final position of the wristwatch:

The accelerometer 23 is set so as to generate an interrupt *when its position changes and reaches a given range* that is maintained during a predetermined duration, as will be described.

’085 Patent, 9:48-51 (emphasis added).

The duration between the starting position and the final position may be measured. If this duration is not in a predefined range, the method is interrupted. Otherwise, the touch controller 24 changes to a No-movement & Angle Check mode. Alternatively, this No-movement & Angle Check detection may be performed by the embedded processing capabilities within the accelerometer 23.

Id., 10:18-24 (emphasis added). Yeung, Alameh, and Joselli are silent on a predefined spatial range in which the duration of the movement of the wristwatch occurs.

Therefore, the Petition is deficient because it fails to show that claim element 1[c.3] is disclosed or rendered obvious by the combination of Yeung, Alameh, and Joselli.

3. The Petition Does Not Show that the Combination of Yeung, Alameh, and Joselli Renders Claims 2-4, 6, and 8-10 Obvious

Claims 2-4, 6, and 8-10 are dependent on Claim 1. Therefore, Claims 2-4, 6, and 8-10 are not rendered obvious by the combination of Yeung, Alameh, and Joselli for at least the same reasons as Claim 1.

C. Ground 3: Claims 5 and 7 are Not Obvious By the Combination of Yeung, Alameh, Joselli, and Yano

Claims 5 and 7 are dependent on Claim 1. Therefore, Claims 5 and 7 are not rendered obvious by the combination of Yeung, Alameh, Joselli, and Yano for at least the same reasons as noted for Claim 1 in Ground 2 on which Petitioner's Ground 3 relies.

VII. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(a)

Based on Petitioner's reasons regarding § 314(a), the Board should exercise its discretion to deny this Petition.

The circumstances of the parallel District Court Litigation necessitate denial of the Petition under the Board's precedent, as every factor considered in relation to efficiency, fairness, and the merits supports denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (precedential) (considering (a) "whether the petitioner and the defendant in the parallel proceeding are the same party"; (b) "overlap between issues raised in the petition and in the parallel proceeding" (c) "proximity of the court's trial date to the Board's projected statutory

deadline for a final written decision”; (d) “investment in the parallel proceeding by the court and the parties”; (e) “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted”; and (f) “other circumstances that impact the Board’s exercise of discretion, including the merits.”).

As set forth below, these factors collectively demonstrate that efficiency and integrity of the AIA are best served by denying review. First, the Petitioner is the Defendant in the parallel proceeding. *See infra* Section VII.A. Second, the asserted claims in the District Court Litigation are all at issue in the Petition. *See infra* Section II.B. Third, trial in the District Court Litigation is set for February 18, 2025, over three months prior to the projected statutory deadline for a Final Written Decision of this Petition in May 21, 2025. *See infra* Section VII.C. Fourth, the parties (and Patent Owner in particular) have invested significant resources on developing legal and factual issues of validity and infringement in the District Court Litigation and will have invested substantially more resources before any decision on this Petition. *See infra* Section VII.D. Fifth, the Court has neither granted nor denied a stay pending this Petition. *See infra* Section VII.E. Finally, no other factors favor institution. *See infra* Section VII.F.

Accordingly, the Board should exercise its discretion under § 314(a) and deny the Petition because institution of this proceeding would not be consistent with the objective of the AIA to “provide an effective and efficient alternative to district court

litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential)).

A. The Parallel District Court Litigation and the Petition Involve the Same Parties

As noted in Patent Owner’s Mandatory Notice, there exists a parallel District Court Litigation between the same parties regarding the same subject patent (the ’085 Patent). *Samsung Elecs. Co., v. Slyde Analytics, LLC*, IPR2024-00041, Paper 5 at 2 (P.T.A.B. November 22, 2023); Pet. at 1. Petitioner is a party to the District Court Litigation captioned as *Slyde Analytics LLC v. Samsung Elecs. Co.*, Case No. 2-23-cv-00083 (E.D. Tex.) (the “District Court Litigation”). Accordingly, this factor weighs in favor of discretionary denial.

B. The District Court Litigation Involves Substantially the Same Claims

All of the asserted claims of the ’085 Patent in the District Court Litigation are at issue in this Petition. “In at least these ways, the parallel proceedings would duplicate effort. This is an inefficient use of Board, party, and judicial resources and raises the possibility of conflicting decisions.” *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (P.T.A.B. May 15, 2020). Accordingly, this fact weighs in favor of discretionary denial.

C. Proximity of the District Court’s Trial Date

The proximity of the District Court Litigation’s trial date to the Board’s projected statutory deadline for a Final Written Decision strongly weighs in favor of discretionary denial.

The parties’ trial is scheduled for February 18, 2025. Exhibit 2001 (Second Amended Docket Control Order, Dkt. 33, *Slyde Analytics LLC v. Samsung Elecs. Co.*, No. 2:23-cv-00083-RWS-RSP (E.D. Tex. October 5, 2023)). Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a Final Written Decision of this Petition is May 21, 2025.¹ As the District Court’s trial will be *over three months before* the projected statutory deadline, this factor weighs strongly in favor of denying institution. *See Supercell Oy v. Gree, Inc.*, IPR2020-00513, Paper 11 at 10-12 (P.T.A.B. June 24, 2020) (denying institution where the jury trial was scheduled to conclude approximately ten months before the statutory deadline); *Edward LifeSciences Corp. v. Evalve, Inc.*, IPR2019-01479, Paper 7, at 6-13 (P.T.A.B. Feb. 26, 2020) (denying institution where jury trial would conclude more than nine months before a final decision would be due); *Samsung Elecs. Am.*,

¹ The statutory deadline for institution is May 21, 2024, “three months after receiving a preliminary response to the petition under section 313.” *See* 35 U.S.C. § 314(b)(1). If instituted, the statutory deadline for Final Written Decision is May 21, 2025, “not later than 1 year after the date on which the Director notices the institution of a review.”

Inc. v. Uniloc 2017 LLC, IPR2019-01218, Paper 7, at 7-10 (P.T.A.B. Jan. 7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TrustID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude “several months,” before a final decision would be due); *Cisco Sys., Inc.*, IPR2020-00122, Paper 15 at 8 (“Because the trial date is substantially earlier than the projected statutory deadline for the Board’s final decision, this factor weighs in favor of discretionary denial.”).

Petitioner does not contest that the proximity of the trial favors denial of institution. Thus, this factor also weighs in favor of discretionary denial.

D. Significant Investment and Petitioner’s Delay in Filing the Petition

The parties’ investment in the parallel proceeding weighs in favor of discretionary denial. In the District Court Litigation, the Court has already entered three Docket Control Orders (Dkts. 28, 31, 33), Discovery Order (Dkt. 29), Protective Order (Dkt. 41), and E-Discovery Order (Dkt. 40). Discovery is also well under way. The parties have already exchanged infringement contentions pursuant to P.R. 3-1, and invalidity contentions pursuant to P.R. 3-3, and a trial date is set for February 18, 2025, which is only about a year away. Ex. 2001. Thus, the parties’ and Court’s substantial investment in this proceeding weighs in favor of denial of

institution under this factor.

E. No Stay of the Parallel District Court Litigation

There is no stay of the parallel District Court Litigation. Even if the Petition were instituted and Petitioner filed a motion to stay the District Court Litigation, prejudice, tactical disadvantage to Slyde Analytics, the late stage of the litigation, and the lack of potential simplification would weigh strongly against such a motion. *See Lennon Image Techs., LLC v. Macy's Retail Holdings, Inc.*, 2:13-CV-00235-JRG, 2014 WL 4652117, at *1 (E.D. Tex. Sept. 18, 2014). The statutory deadline for institution is not until after claim construction discovery begins.² Ex. 2001; *see Intell. Ventures II v. FedEx Corp.*, No. 2:16-cv-00980-JRG, Dkt. 141 at 5 (E.D. Tex. Oct. 24, 2017) (“The Court agrees that the Parties have already invested substantial effort and resources during discovery and in preparing claim construction briefing. . . . These circumstances weigh against staying this case”).

Moreover, a stay would not decrease the burden on the Court and the parties since any instituted IPR would only cover 3 out of 46 combinations of obviousness that Petitioner has raised in the District Court Litigation, and do not include Petitioner's challenges under § 102 or § 112. *See generally* Ex. 2002, at 128-168,

² As noted above, the statutory deadline for institution is April 17, 2024. *See supra* n. 1. Per Ex. 2001, the date for compliance with P.R. 4-1 (Exchange Proposed Claim Terms) is March 22, 2024.

178-179, and 186-187. *Intell. Ventures II*, No. 2:16-cv-00980-JRG, Dkt. 141 at 3-4 (“[T]he instituted IPRs only cover a narrow slice of the invalidity arguments Defendants have raised in this case. For example, Defendants have argued that the ’715 Patent is invalid under § 102 with respect to at least eight references . . . under § 103 with respect to at least twenty-six combinations . . . under § 112 [], and under § 101.”).

Accordingly, it would be unlikely for the Court to hold that a stay would streamline the litigation and this factor supports denial of institution.

F. Other Factors Favor Discretionary Denial

Petitioner does not present a strong case on the merits, further supporting denial of institution. *See supra* Section VI. Petitioner also does not identify any other factors which weigh against discretionary denial. Pet. at 78-80.

Thus, when viewing the factors together, the Petition should be denied in the Director’s discretion under 35 U.S.C. § 314(a).

VIII. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board deny institution of the Petition in its entirety.

Respectfully submitted,

Dated: February 21, 2024

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE specified in 37 C.F.R. § 42.24 has 5,742 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

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CERTIFICATE OF SERVICE

A copy of PATENT OWNER'S PRELIMINARY RESPONSE and EXHIBITS 2001 through 2002 have been served on Petitioner's counsel of record as follows:

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