

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

ADVANCED CODING TECHNOLOGIES, LLC,
Patent Owner.

IPR2024-00062
Patent 6,845,128 B2

Before BART A. GERSTENBLITH, NATHAN A. ENGELS, and
RUSSELL E. CASS, *Administrative Patent Judges*.

ENGELS, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Request for Leave to File a
Preliminary Reply to the Preliminary Response and
for Patent Owner to file a Preliminary Sur-Reply
37 C.F.R. §§ 42.5, 42.108(c)

Petitioner emailed the Board requesting authorization to file a five-page preliminary reply to Patent Owner's Preliminary Response (Paper 6) for the purpose of "explain[ing] how the analysis in the petition and the cited prior art satisfies the constructions of 'emphasis processing' and 'emphasis level' advanced in the Preliminary Response" and "to explain why [Patent Owner's] proposed construction of 'at least one factor among' is incorrect and inconsistent with examples in the '128 patent." See Ex. 3001 (email correspondence). Petitioner stated that "[g]ood cause exists for briefing because the constructions arose after filing of the petition and, thus, could not have been addressed in the petition." *Id.* Petitioner represented that Patent Owner opposes Petitioner's request to file a preliminary reply. *Id.*

Judges Gerstenblith, Engels, and Cass conducted a conference call with counsel for the parties to discuss Petitioner's request. A court reporter was present on the call, and a transcript of the call has been entered into the record as Exhibit 1024.

"Emphasis Processing" and "Emphasis Level"

During the call, Petitioner stated that the Petition proposes the plain and ordinary meaning of the claim terms "emphasis processing" and "emphasis level" and that Petitioner did not believe a controversy over those terms would develop during the proceeding. Ex. 1024, 5:7–12. Petitioner stated that after it filed the Petition, a dispute over the meanings of those terms arose as they relate to Patent Owner's allegations of infringement in the parties' district-court litigation. *Id.* at 6:9–7:3. Further, Petitioner stated that Patent Owner's Preliminary Response cites the proposed interpretations of those terms as advanced in the district court, and Petitioner's proposed preliminary reply would address how those proposed interpretations are

consistent with the plain and ordinary meaning of the terms, as advanced in the Petition. *See id.* at 6:9–8:16.

Patent Owner responded that good cause does not exist for Petitioner’s proposed briefing because the district court’s claim constructions were offered by Petitioner and should have been considered in the Petition. *Id.* at 9. Patent Owner disagreed with Petitioner’s position that a dispute arose in the district court after the Petition was filed; rather, Patent Owner stated that Petitioner proposed its constructions several weeks after filing its Petition and that the constructions are agreed upon in the district-court litigation. *Id.* According to Patent Owner, Petitioner does not explain why it proposed plain and ordinary meaning in the Petition and later decided to propose claim interpretations in the district court. *Id.* at 9–10. Patent Owner did not take a position regarding whether the proposed interpretations are the plain and ordinary meanings of the terms, but Patent Owner stated that it agrees with the proposed interpretations. *Id.* at 10–11.

“At Least One Factor Among”

Petitioner stated that good cause exists for a preliminary reply to address the proposed interpretation of “at least one factor among,” as advanced in Patent Owner’s Preliminary Response. Ex. 1024, 16:3–17:3. Petitioner stated that Patent Owner’s proposed interpretation was not raised in the parties’ district-court litigation nor otherwise raised prior to the Preliminary Response. *Id.* Petitioner stated that its proposed briefing would point out how Patent Owner’s proposed interpretation is incorrect and inconsistent with the ’128 patent’s Specification. *Id.*

Patent Owner stated that good cause does not exist for the proposed briefing because Petitioner recognized in the Petition that Patent Owner’s

interpretation was plausible, as shown by footnote 5 on page 14 of the Petition in which Petitioner presents its own understanding of the claim term. *Id.* at 17:6–18:3.

DISCUSSION

After hearing and considering the parties’ positions, we are persuaded that, under the circumstances of this proceeding, Petitioner has established good cause for authorization to file a preliminary reply to explain how its analysis in the Petition satisfies the constructions of “emphasis processing” and “emphasis level” advanced in Patent Owner’s Preliminary Response. Notwithstanding the fact that Petitioner articulated the constructions that it now seeks to address, Petitioner presented those constructions to the district court several weeks after the Petition was filed in this proceeding. We accept Petitioner’s counsel’s representation that, at the time the Petition was filed, Petitioner had not identified a need to propose constructions for these terms and that the apparent need arose after the filing of the Petition. We also recognize that, in the Preliminary Response, Patent Owner “does not dispute that Petitioner’s proposed constructions in the District Court Action should be applied in this proceeding.” Paper 6, 10. Further, Petitioner’s request for additional briefing arises, at least in part, from Patent Owner’s argument in the Preliminary Response that Petitioner failed to satisfy its duty under 37 C.F.R. § 42.104(b)(3) to identify how the challenged claims are to be construed, specifically because Petitioner did not address the constructions it presented in the district court weeks later. *See, e.g., id.* at 9.¹

¹ Patent Owner refers to 42.104(b)(3) as “42.104(3).” Paper 6, 9.

Considering the above circumstances we find that Petitioner has established sufficient good cause for additional briefing for its intended purpose.

We also are persuaded that the circumstances of this proceeding warrant additional briefing to address the scope and meaning of the phrase “at least one factor among,” as recited in several of the challenged claims. Among other things, Patent Owner’s Preliminary Response (Paper 6, 17–19) asserts that the challenged claims are similar, in relevant part, to those addressed in *Samsung Electronics Co. v. Apex Beam Technologies, LLC*, IPR2023-00603, Paper 10 at 22–23 (PTAB Oct. 20, 2023), and we determine that additional briefing will be helpful in resolving the parties’ dispute in this proceeding. In the additional briefing, we request that the parties specifically address the U.S. Court of Appeals for the Federal Circuit’s decisions in *SIMO Holdings Inc. v. Hong Kong uCloudlink Network Technology Ltd.*, 983 F.3d 1367 (Fed. Cir. 2021), and *SuperGuide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870 (Fed. Cir. 2004).

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s request for leave to file a preliminary reply to Patent Owner’s Preliminary Response and for Patent Owner to file a preliminary sur-reply is *granted*;

FURTHER ORDERED that, no later than April 26, 2024, Petitioner is authorized to file a preliminary reply of not more than seven pages to Patent Owner’s Preliminary Response to address the issues discussed in this Order regarding the claim terms “emphasis processing,” “emphasis level,” and “at least one among”; and

IPR2024-00062
Patent 6,845,128 B2

FURTHER ORDERED that, no later than May 3, 2024, Patent Owner is authorized to file a preliminary sur-reply of not more than seven pages limited to addressing the issues raised in Petitioner's preliminary reply.

IPR2024-00062
Patent 6,845,128 B2

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