UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

FENDGO, LLC,

Patent Owner

Case IPR2024-00113

U.S. Patent No. 11,265,404

**Petitioners' Notice Ranking Petitions
And Explaining Material Difference Between
Petitions For U.S. Patent No. 11,265,404**

Petitioners are filing two concurrent petitions challenging the patentability of claims of U.S. Patent No. 11,265,404 (the "'404 patent")—a first petition challenging claims 9-15 based on the earliest alleged priority date, and a second petition challenging claims 1-8 based on a broken priority chain. Pursuant to the Board's November 2019 Consolidated Trial Practice Guide ("TPG"), Petitioners submit this paper to "identify: (1) a ranking of the Petitions in the order in which it wishes the Board to consider the merits …, and (2) a succinct explanation of the differences between the Petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions."

I. ORDERING OF PETITIONS

Petitioners believe that both petitions are meritorious and justified, especially because (as explained further below), both petitions are necessary to address all of the claims that Petitioner seeks to challenge. Nonetheless, to the extent required by the TPG, Petitioners request that the Board consider the petitions in the following order:

Rank	PTAB Case No.	References	Challenged Claims
1	IPR2024-00113 ("Petition 1")	Primary references *Walker*, *Zellner*, and *Martin* and secondary references *Kim* and	9-15

		Dixit	
2	IPR2024-00114 ("Petition 2")	*DiPerna964* and *Strack*	1-8

II. MATERIAL DIFFERENCES THAT COMPEL PERMITTING MULTIPLE PETITIONS

Petitioners submit that institution of both petitions against the '404 patent is warranted due to word constraints caused by the arguments within the petitions.

Petition 1 presents seven grounds based on three primary references against independent claims 9, 13, and 15 as well as dependent claims 10-12 and 14. Petition 1 relies only on patents/publications that qualify as prior art as of the earliest alleged priority date on the face of the '404 patent—January 14, 2005.

Petition 2 raises a priority date dispute which is not addressed in Petition 1. The priority date argument stems from a claim amendment made in September 2021 during prosecution of the application that issued as the '404 patent. As a result of the amendment, Petitioners contend that claims 1-8 are not entitled to priority before January 2019. Petition 2 presents one ground based on two references that only qualify as prior art if the Board agrees with Petitioners. One of the two references is a publication of the earliest non-provisional application in the priority chain of the '404 patent, and the second reference meets the sole limitation challenged for lack of written description.

Demonstrating the broken priority chain of the ’404 patent requires a discussion of the prosecution history and additional analysis that will not fit in Petition 1. The Board has already considered situations in which a priority dispute occurs in one of multiple *inter partes* review petitions directed to different claims in the same patent and has granted institution of all petitions. *See, e.g.*, *Samsung Elecs. Co., Ltd. v. Hardin*, IPR2022-01335, Paper 13 at 17-24 (PTAB. Feb. 8, 2023); *Pfizer, Inc. v. uniQure Biopharma B.V.*, IPR2021-00925, Paper 15 at 12-19 (PTAB Nov. 17, 2021). The TPG also directly addresses this situation, stating “*[n]onetheless, the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example*, when the patent owner has asserted a large number of claims in litigation or *when there is a dispute about priority date requiring arguments under multiple prior art references.*” Consolidated Trial Practice Guide 5 (Nov. 2019) (emphasis added), available at http://www.uspto.gov/TrialPracticeGuideConsolidated 59.

The challenged claims in Petition 2 (claims 1-8) include materially different features not found in any other claims of the ’404 patent and which could not be addressed by primary references (i.e., *Walker*, *Zellner*, and *Martin*) on which Petitioners rely in Petition 1. More particularly, claim 1 (from which claims 2-8 depend) recites, *inter alia*, “a panic button, adapted to, when activated, ***ready itself to*** perform” certain functions, and “wherein the panic button is activated ***by a***

depressing of the panic button together with another button at substantially the same initial time such that no panic button function is activated unless both buttons are depressed." No claim challenged in Petition 1 contains similar features. The dependent claims challenged in Petition 2 (claims 2-8) also include numerous features not found in dependent claims 10-12 and 14.

Moreover, the arguments presented in Petition 2 could not have fit in Petition 1. As an initial matter, Petitioners submit that it was reasonable to include three primary references in Petition 1. *Walker*'s disclosure is unique among *Zellner* and *Martin* with respect to independent claim 15. *Walker* also only qualifies as prior art under Pre-AIA § 102(a) by about two months, assuming (without conceding) that the challenged claims are entitled to priority as of the January 14, 2005 filing date of the provisional application to which the '404 patent claims priority. *Zellner*'s disclosure is unique among *Walker* and *Martin* with respect to dependent claim 11. *Zellner* also qualifies as prior art under pre-AIA § 102(e) by over four years.

Additionally, the arguments presented in Petition 2 could not have fit in Petition 1 even if, for example, Petition 1 was limited to two primary references. The word count of Petition 1 attributable only to those portions relevant to *Walker* and *Zellner* grounds is approximately 11,060 words. The word count attributable to the contents of Petition 2, not including the redundant sections (i.e., Level of Ordinary Skill, Claim Construction, Overview of the '404 Patent, § 314(a)

discussion, etc.), is approximately 3,846 words. Together, that is 14,906 words. Thus, even if Petition 1 included only the Walker and Zellner grounds to address all of claims 9-15, Petitioners would not have been able to fit the additional material of Petition 2 into Petition 1.

Having moved the priority chain argument into Petition 2, the *Martin*-based ground fit within the excess room in the word limit in Petition 1. As such, that the *Martin* ground challenges claims that are also addressed by the *Walker* and/or *Zellner* grounds is not a reason to deny institution of Petition 2. Moreover, given the scope of the stipulation that Petitioners have offered Patent Owner, including *Martin* in the IPR proceedings should serve to reduce the disputed issues in the District Court litigation.

For these reasons, Petitioners respectfully request institution of both of their concurrently filed IPR petitions against the ’404 patent.

Date: November 1, 2023

Respectfully submitted,

/Ali R. Sharifahmadian/
Ali R. Sharifahmadian (Reg. No. 48,202)
Counsel for Petitioners

CERTIFICATE OF SERVICE

I certify that on November 1, 2023, I caused a true and correct copy of the foregoing Petitioners' Notice Ranking Petitions and Explaining Material Differences Between Petitions For U.S. Patent No. 11,265,404 to be served via overnight delivery on the Patent Owner at the following correspondence address of record as listed on PAIR:

Robert Kinberg
39564 - FisherBroyles, LLP
3340 Peachtree Road NE
Suite 1800
Atlanta, GA 30326
UNITED STATES

A courtesy copy was also sent via electronic mail to Patent Owner's litigation counsel listed below:

James R Nuttall (jnuttall@steptoe.com)
Katherine Tellez (ktellez@steptoe.com)
Tron Y. Fu (tfu@steptoe.com)
Charles Everingham, IV (ce@wsfirm.com)
Claire Abernathy Henry (claire@wsfirm.com)

/Ali R. Sharifahmadian/
Ali R. Sharifahmadian (Reg. No. 48,202)
Counsel for Petitioners