

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.

IPR2024-00327
Patent 9,986,303 B2

Before BART A. GERSTENBLITH, NATHAN A. ENGELS, and
JASON M. REPKO, *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 ("POPR")) for the purpose of addressing "Patent Owner's construction of the phrase 'reconstructing video image coding data from the basic video image coding data and the supplementary video image coding data'" raised in the POPR. *See* Ex. 3001 (email correspondence). Petitioner stated that "[g]ood cause exists for briefing on this issue because the construction advanced in the POPR only arose in the litigation after the Petition was filed 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 Repko 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 1036.

During the call, Petitioner stated that the Petition proposes the plain and ordinary meaning of the claim term "reconstructing video image coding data" and that "the construction referenced in the POPR only arose after the Petition was filed." Ex. 1036, 8:10–12. Petitioner stated that after it filed the Petition, a dispute over the meanings of the "reconstructing" term arose as they relate to Patent Owner's allegations of infringement in the parties' district-court litigation. *Id.* at 8:12–9:20. Further, Petitioner stated that the POPR 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 11:11–21.

Patent Owner responded that good cause does not exist for Petitioner's proposed briefing because the claim constructions agreed to by the parties in the district court litigation were offered by Petitioner's co-defendant and should have been addressed in the Petition. *Id.* at 12:1–13:19. 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's co-defendant proposed the construction four days after the filing of the Petition and that the constructions were agreed upon in the district-court litigation. *Id.* at 13:4–19. According to Patent Owner, Petitioner does not explain why it proposed the plain and ordinary meaning in the Petition and later decided to agree to the afore-mentioned claim interpretation in the district court. *Id.* at 13:20–14:3.

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 construction of "reconstructing video image coding data from the basic video image coding data and the supplementary video image coding data" advanced in the POPR. Notwithstanding the fact that Petitioner's co-defendant in the district court litigation proposed the construction that it now seeks to address, Petitioner agreed to that construction in the district court *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 a construction for this term and that the apparent need arose after the filing of the Petition. We also recognize that, in the Preliminary Response, Patent

Owner indicates that “[t]he Parties’ agreed upon constructions in the District Court Action should be applied in this proceeding.” Paper 6, 14. 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 agreed to in the district court after filing the Petition. *See, e.g., id.* at 13.¹ Considering the above circumstances, we find that Petitioner has established sufficient good cause for additional briefing for its intended purpose.

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 June 24, 2024, Petitioner is authorized to file a preliminary reply of not more than five pages to Patent Owner’s Preliminary Response to address the issues discussed in this Order regarding the claim term “reconstructing video image coding data from the basic video image coding data and the supplementary video image coding data”; and

FURTHER ORDERED that, no later than July 1, 2024, Patent Owner is authorized to file a preliminary sur-reply of not more than five pages limited to addressing the issues raised in Petitioner’s preliminary reply.

¹ Patent Owner refers to 42.104(b)(3) as “42.104(3).” Paper 6, 13.

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