

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.

IPR2024-00372
Patent 10,218,995 B2

Before BART A. GERSTENBLITH, NATHAN A. ENGELS, and
JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

ORDER

Denying Petitioner's Request to File a Preliminary Reply to the
Preliminary Response
37 C.F.R. §§ 42.5, 42.108(c)

I. SUMMARY

Petitioner emailed the Board requesting a conference call to discuss authorization to file a two-page preliminary reply to Patent Owner's Preliminary Response (Paper 6) to address "Patent Owner's characterizations of the Martins, He, and Segall references." *See* Ex. 3001 (email). Patent Owner opposes this request. *Id.* Judges Gerstenblith, Engels, and Repko held a conference call with counsel for the parties. A court reporter was present, and a transcript has been entered into the record as Exhibit 1044.

II. ANALYSIS

A petitioner must show good cause to file a reply to a preliminary response. 37 C.F.R. § 42.108(c).

During the call, Petitioner stated that "the arguments advanced in the preliminary response were incomplete" because they "didn't address some pertinent teachings in the prior art." Ex. 1044, 24:5–9, 24:17–18. In Petitioner's view, it was unforeseeable that Patent Owner would overlook some of the disclosures cited in the Petition or advance positions contrary to those teachings without addressing them in Patent Owner's arguments. *Id.* at 23:9–15. Petitioner argues that their goal is to "clarify the record" in the proposed reply by bringing certain facts from the Petition to our attention. *Id.* at 23:16–20.

Patent Owner responded that good cause does not exist for Petitioner's proposed briefing and that Petitioner is merely "looking to shore up arguments" made in the Petition. *Id.* at 25:7–10. Patent Owner asserted that Petitioner is essentially saying that it did not foresee certain weaknesses in the arguments raised in the Petition and that if a preliminary reply is

appropriate in this case, it is appropriate in virtually every case where a preliminary response points to weaknesses in a petition. *Id.* at 25:12–22.

Although Petitioner points to Patent Owner’s alleged mischaracterizations as the basis for its preliminary reply, it may always be the case that a petitioner disagrees with how a patent owner characterizes the facts and law presented in a petition. Our rules, however, provide for a preliminary reply only when good cause is shown. 37 C.F.R. § 42.108(c).

Petitioner has not established good cause here. First, Petitioner contends that it seeks to point to things already set forth in the Petition. We are fully capable of reviewing the citations provided in the Petition. Second, Petitioner does not assert that there are new developments in the parallel district-court proceeding that could warrant its request for a preliminary reply. *See* Ex. 1044, 24:3–8. Third, it appears that the basis for Petitioner’s request is simply a desire to respond to Patent Owner’s arguments in the Preliminary Response without a sufficient reason to show good cause and, as such, would apply to effectively every request for a preliminary reply. *See id.* at 23:16–20. Thus, Petitioner’s request for leave to file a preliminary reply is denied.

III. ORDER

It is ORDERED that Petitioner’s request for leave to file a preliminary reply to Patent Owner’s Preliminary Response is *denied*.

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FOR PETITIONER:

W. Karl Renner
Jeremy Monaldo
Nicholas Stephens
Rishi Gupta
FISH & RICHARDSON P.C.
axf-ptab@fr.com
jjm@fr.com
nstephens@fr.com
rgupta@fr.com

FOR PATENT OWNER:

Peter Lambrianakos
Vincent J. Rubino, III
Joseph M. Mercadante
FABRICANT LLP
plambrianakos@fabricantllp.com
vrubino@fabricantllp.com
jmercadante@fabricantllp.com