

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC.,
SAMSUNG SEMICONDUCTOR, INC., and
SAMSUNG AUSTIN SEMICONDUCTOR, LLC,
Petitioner,

v.

CHIEN-MIN SUNG,
Patent Owner.

IPR2024-00533 (Patent 8,974,270 B2)
IPR2024-00534 (Patent 9,138,862 B2)
IPR2024-00535 (Patent 9,724,802 B2)¹

Before BARRY L. GROSSMAN, GEORGE R. HOSKINS, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5, 42.10, and 42.108(c)

¹ This Order is being filed in each proceeding listed in the caption, due to the common issues addressed. The parties are not authorized to use a combined caption in these proceedings.

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On July 17, 2024, the Board held a telephone conference in these three proceedings. Judges Grossman, Hoskins, and Ippolito appeared for the Board. Mr. Yung-Hoon Ha spoke on behalf of Petitioner. Mr. Alex Chan spoke on behalf of Patent Owner. Three topics were discussed, as follows.

1. Patent Owner's Counsel of Record

The Board raised an issue concerning Patent Owner's counsel, noting that Patent Owner's counsel of record in all three proceedings include only Mr. Chan as lead counsel, and Mr. Joel Glazer as backup counsel.² Email communications sent to the Board in preparation for the telephone conference came from Mr. Andrew Sherman on behalf of Patent Owner, even though Mr. Sherman is not a counsel of record in any of the three proceedings. *See* IPR2024-00533, Exs. 3001 & 3002. The Board instructed Mr. Chan that any counsel who represents Patent Owner before the Board in relation to these proceedings, including sending email communications to the Board concerning the proceedings, must be a counsel of record. *See* 37 C.F.R. §§ 42.5(a) & 42.10(a)–(b).

*2. Patent Owner's Request For Leave To File
A Corrected Preliminary Response In IPR2024-00533*

The Board granted Patent Owner's request for leave to file a Corrected Preliminary Response in IPR2024-00533, after confirming

² There was some question as to this status during the telephone call, but the Board has since verified that only Mr. Chan and Mr. Glazer were Patent Owner's counsel of record in all three proceedings at the time of the telephone conference. *See* IPR2024-00533, Paper 10; IPR2024-00534, Papers 6 and 10 (adding Mr. Lowell Jacobson as a second backup counsel after the telephone conference); IPR2024-00535, Paper 9.

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Petitioner does not oppose the request, which is limited to correcting four formatting errors enumerated in the request (IPR2024-00533, Ex. 3002).

*3. Petitioner's Request For Leave To File
A Preliminary Reply In All Three Proceedings*

The bulk of the telephone conference concerned Petitioner's request for leave to file a Preliminary Reply in all three of these proceedings, to address four topics in reply to Patent Owner's Preliminary Responses. *See, e.g.*, IPR2024-00533, Ex. 3001 (Petitioner's email request).

Upon consideration of the telephone conference, we grant Petitioner leave to file a Preliminary Reply in each proceeding. The Preliminary Reply shall be limited to addressing the first three topics enumerated in Petitioner's request, which are:

1. The likelihood of a stay being entered by the District Court in *Chien-Min Sung v. Samsung Electronics Co. Ltd., et al.*, Case No. 4:23-cv-00752 (E.D. Tex.) ("the Samsung Litigation");
2. Expenses incurred by the parties in the Samsung Litigation; and
3. Petitioner's submission of a *Sotera* stipulation³ in these proceedings.

See IPR2024-00533, Ex. 3001. We conclude there is good cause for Petitioner to file a Preliminary Reply (*see* 37 C.F.R. § 42.108(c)) to address

³ *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 13–14, 18–19 (PTAB Dec. 1, 2020) (precedential); USPTO Memorandum, *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022), at 3, 7–8 ("Consistent with *Sotera Wireless, Inc.*, the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.").

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these three topics, so that the Board has a complete record when deciding whether to deny institution of review in deference to the Samsung Litigation pursuant to *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019 (PTAB Mar. 20, 2020) (precedential).

We also grant Patent Owner leave to file a Preliminary Sur-reply in each proceeding, to respond to Petitioner's Preliminary Reply.

Petitioner may submit new evidentiary Exhibits with its Preliminary Reply. Patent Owner also may submit new evidentiary Exhibits with its Preliminary Sur-reply.

Part of the telephone conference concerned the timing of Petitioner's potential submission of a *Sotera* stipulation in these proceedings. In this regard, we emphasize that the Board may issue a Decision on Institution at any time after the filing deadline for Patent Owner's Preliminary Sur-reply set forth below. We will not wait to issue our Decision on Institution until the eleventh hour prior to the statutory deadline, to suit Petitioner's objective to minimize the impact of a stipulation. Petitioner may file simultaneously with its Preliminary Reply a stipulation not to pursue in the pending parallel District Court proceeding the same grounds or any grounds that could have reasonably been raised in these three proceedings, mitigating concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB. *See, e.g., BMW of North America, LLC v. NorthStar Systems LLC*, IPR2023-01017, Paper 12, at 9–11 & n.11 (PTAB Dec. 8, 2023) (“As a practical matter, of course, a petitioner would need to submit a *Sotera* stipulation well in advance of the Board's deadline for entering its institution decision, in order to ensure that the Board has the opportunity to consider it.”). If Petitioner opts not to file a stipulation with the Preliminary

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Reply, waiting to see what happens in the Samsung Litigation, Petitioner risks that the Board will issue a Decision on Institution, before Petitioner has another opportunity to file a stipulation.

Finally, we deny Petitioner's request for leave to address Petitioner's fourth topic (i.e., allegedly inconsistent positions Patent Owner has taken among its Preliminary Responses in these three proceedings as to the Sung '026 reference). There is no good cause for this request. *See* 37 C.F.R. § 42.108(c). The Board is able to ascertain any such inconsistencies for itself when reaching Decisions on Institution in these proceedings.

I. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner may file a Corrected Preliminary Response in IPR2024-00533, limited to correcting four formatting errors as enumerated in IPR2024-00533, Exhibit 3002; and

ORDERED that Petitioner may file a Preliminary Reply in each of these three proceedings, on or before July 31, 2024, addressing the three topics enumerated above, and not to exceed five (5) pages; and

FURTHER ORDERED that Patent Owner may file a Preliminary Sur-reply in each of these three proceedings, on or before August 7, 2024, in response to Petitioner's Preliminary Reply, and not to exceed five (5) pages.

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