UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. AND
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioners,

v.

MAXELL, LTD.,
Patent Owner

Case: IPR2024-00777

U.S. Patent No. 11,017,815

PATENT OWNER'S RESPONSE TO PETITIONERS' NOTICE RANKING MULTIPLE PETITIONS

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Samsung's ostensible excuse for filing multiple petitions against U.S. Patent No. 11,017,815 (the "'815 Patent") is it was "unable to include all of these challenges in a single petition due to the limit on word count and the large number of limitations in the challenged claims." Paper 4 at 1. This excuse is illusory. The challenged claims recite the same core features, evidenced by the fact that substantially the same reference combinations are applied to challenge all four independent claims across the two petitions. Samsung also is not relying on dramatically different prior art combinations in order to be able to address a large number of disparate claim limitations. Rather, the vast majority of the claims are challenged based on combinations made of two references (Horn and Baumgartner), where the same secondary reference (WinTV) is used for each dependent claim. Samsung's claim-splitting strategy across multiple petitions only creates an illusion there was not enough space to address the challenged claims in a single petition.

While "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," even then the Board notes that "this **should be rare**." Consol. Trial Practice Guide ("CTPG") at 59 (November 2019). Samsung has not adequately shown why two petitions were necessary here, particularly where the petitions include multiple repetitive and alternative grounds utilizing art already

considered by the Office.[1] This approach should be rejected and the Board should use its discretion to deny at least IPR2024-00777.

I. The Number Of Asserted Claims Does Not Require Multiple Petitions

Samsung asserts that the number of asserted claims justifies filing more than one petition. However, the fact that a higher number of claims may have been asserted in litigation is only a threshold fact, not a reason unto itself justifying more than one petition. *See Comcast Cable Communs., LLC v. Rovi Guides, Inc.*, IPR2020-00796, Paper 8 at 10-11 (P.T.A.B. Oct. 21, 2020) (denying institution on petitions challenging 56 claims where petitioner did not "explain sufficiently how the two Petitions at issue … collectively challenge the claims in a materially different manner that justifies multiple proceedings."). Even where "a patent owner has asserted a large number of claims in litigation," the need for "***two petitions … should be rare***." CTPG at 59.

Here, Samsung rests its justification on the fact that 26 claims were asserted, but fails to explain why this is the ***rare*** case where the number of claims justifies multiple petitions. It is not. Grounds 1 and 2 in the first petition cover claims 1-15 utilizing Horn, Baumgartner, and WinTV. Grounds 6 and 7 in the second petition

[1] Both petitions should be denied based on 35 U.S.C. §§ 314 and 325(d). *See* Patent Owner's Preliminary Response, filed concurrently herewith, at Section II.

cover claims 16-27 utilizing Horn, Baumgartner, WinTV, and Candelore. All told these four grounds covering all claims expend only about 73 pages between the two petitions. *See* Pet. (IPR2024-00735) at 22-60 *and* Pet. (IPR2024-00777), at 20-55. There is no reason why Samsung could not have covered all of the asserted claims within one petition. Indeed, the basic filing fee for an *inter partes* review contemplates challenging up to 20 claims. *See* 37 C.F.R. § 42.15(a)(1), (3). Six additional claims does not justify another petition.

Contrary to its argument, Samsung did not "make every reasonable effort to include all challenges in a single petition." Instead, it included *three* additional grounds in each respective petition covering the same claims and utilizing prior art (Kaplan and Bryant) already considered by the Office. Another example of superfluous words not requiring two petitions is Samsung's repetition of nearly the same claim construction arguments in both petitions, even though the arguments are common to all independent claims. *Compare* Pet. (IPR2024-00735) at 18-22 *and* Pet. (IPR2024-00777), at 5-9. As such, this is not a case in which a petitioner has to rely on varied prior art combinations in order to be able to address many disparate claim limitations. Instead, these petitions are designed with one thing in mind—to apply multiple, highly-redundant references to the claims as a way to increase the burden on the Board and Patent Owner and evade the Board's word limit.

II. There Is No Material Difference Requiring Multiple Petitions

Samsung argues that multiple petitions are justified because they challenge different claims. In fact, this is the only purported "difference" between the petitions identified; Samsung does not even argue this difference is material. Paper 4 at 2. "[A]lthough Petitioner correctly argues that the petitions in the two proceedings challenge different claims, Petitioner chose that claim allocation without persuasively explaining the 'need' to do so." *Infinera Corp. v. Oyster Optics, LLC*, IPR2020-00326, Paper 12 at 12 (P.T.A.B. June 26, 2020). Even if Samsung explained the claim allocation, which appears designed to make it more difficult for the Board to address all challenged claims in one proceeding, "Petitioner has not explained why all its challenges are necessary." *Id.* In particular, "Petitioner does not address why it could not have, in one petition, presented one ground of unpatentability for each challenged claim." *Id.* Instead, Samsung asserts multiple repetitive grounds for nearly every challenged claim. *Compare* Pet (IPR2024-00735) at Grounds 1-2 and 4-5 and *with* Pet (IPR20204-00777) at Grounds 6-7 and 9-10. This approach is consistently rejected by the Board. *See Fantasia Trading LLC v. CogniPower, LLC*, IPR2021-00068, Paper 22 (P.T.A.B. May 12, 2021). As in *Fantasia Trading*, the repetitiveness throughout the two petitions could have been avoided had each petition been directed to grounds that rely on one primary prior art reference. Instead, Samsung's grounds based on Kaplan and Bryant in both petitions

are repetitive of the Horn and Baumgartner grounds in both petitions.

Indeed, a simple side-by-side comparison reveals severe repetition between the two petitions. Ex. 2005 (showing 11,436 matching words). Samsung duplicates reference to the same set of figures and excerpts from the prior art in both petitions. *See e.g.*, Pet (IPR2024-00735) at 26-42 (relying on Figs. 1, 26, and corresponding descriptions from Horn and Figs 1, 5, and corresponding descriptions from Baumgartner for the Horn + Baumgartner ground) compared to Pet (IPR2024-00777) at 25-42 (same for the Horn + Baumgartner + Candelore Ground); *see also* Pet (IPR2024-00735) at 70-87 (relying on Figs. 4, 8, 9A-9C, and corresponding descriptions from Kaplan and Figs 1, 7, 8 and corresponding descriptions from Bryant for the Kaplan + Bryant Ground) compared to Pet (IPR2024-00777) at 66-92 (same for the Kaplan + Bryant + Wong + Candelore Ground). Clearly Samsung could have fit all its challenges into one petition and met the Board's word limit.

III. Conclusion

For the above reasons, the Board should exercise its discretion under 35 U.S.C. § 314(a) to deny at least IPR2024-00777.

Dated: August 12, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 12th day of August, 2024, a copy of the attached **PATENT OWNER'S RESPONSE TO PETITIONERS' NOTICE RANKING MULTIPLE PETITIONS** was served by electronic mail to the attorneys of record, at the following addresses:

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Respectfully submitted,

Date: August 12, 2024 By: /Robert G Pluta Reg No 50970/
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