

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

CERENCE OPERATING COMPANY,
Patent Owner.

IPR2024-00978 (Patent 7,395,078 B2)
IPR2024-00979 (Patent 8,081,993 B2)
IPR2024-01267 (Patent 9,026,428 B2)¹

Before BART A. GERSTENBLITH, BRIAN P. MURPHY, and
LISA A. MURRAY, *Administrative Patent Judges*.

MURRAY, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Request for Leave to File
Motion for Reconsideration
of Decision Instituting *Inter Partes* Review
37 C.F.R. § 42.71

¹ This Order addresses identical issues in all three cases. The parties are not authorized to use this heading in any subsequent papers.

IPR2024-00978 (Patent 7,395,078 B2)
IPR2024-00979 (Patent 8,081,993 B2)
IPR2024-01267 (Patent 9,026,428 B2)

On April 7, 2025, Patent Owner Cerence Operating Company contacted the Board requesting leave to file a “motion for reconsideration of institution” in each of IPR2024-00978, IPR2024-00979, and IPR2024-01267.² Patent Owner’s request is denied for the reasons discussed below.

DISCUSSION

IPR2024-00978 was instituted on February 13, 2025, and the deadline for filing a request for rehearing in that proceeding was February 27, 2025. *See* 37 C.F.R. § 42.71(d)(1). IPR2024-00979 and IPR2024-01267 were instituted on January 31, 2025, and any request for rehearing was due by February 14, 2025. Nevertheless, Patent Owner argues that its request should be granted because reconsideration is warranted in view of Chief Administrative Patent Judge Boalick’s recent “Guidance on USPTO’s rescission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation’” (Mar. 24, 2025) (“Guidance Memorandum”) and Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office Stewart’s subsequent memorandum “Interim Processes for PTAB Workload Management” (Mar. 26, 2025). IPR2024-00978 Ex. 3002.

On February 28, 2025, the USPTO rescinded the June 21, 2022, memorandum entitled “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (“Interim

² *See* IPR2024-00978, Ex. 3002; IPR2024-00979, Ex. 3002; IPR2024-01267, Ex. 3003 (e-mail correspondence with the Board, dated Apr. 7, 2025).

IPR2024-00978 (Patent 7,395,078 B2)
IPR2024-00979 (Patent 8,081,993 B2)
IPR2024-01267 (Patent 9,026,428 B2)

Procedure”). The effect of this rescission was “to restore policy in this area to the guidance in place before the Interim Procedure, including the Board’s precedential decisions in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (“*Fintiv*”) and *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (“*Sotera*”).” Guidance Memorandum at 1.

Patent Owner argues that the Guidance Memorandum:

makes it clear that a timely-filed *Sotera* stipulation will no longer be dispositive by itself, “as the Board will now consider such a stipulation as part of its holistic analysis under *Fintiv*,” and . . . in each of the respective IPRs, the Board expressly stated that it did **not** consider each of the *Fintiv* factors when deciding the issue of discretionary denial because a *Sotera* stipulation was filed in each matter.

IPR2024-00978, Ex. 3002. Patent Owner argues the Board should reconsider its decisions to institute the IPRs at issue because those decisions “each relied on now rescinded guidance regarding the impact of *Sotera*-type stipulations[.]” *Id.*

The Guidance Memorandum unambiguously states that “the Interim Procedure’s rescission applies to any case in which the Board has not issued an institution decision, or where a request for rehearing or Director Review of an institution decision was filed and remains pending.” Guidance Memorandum at 2. In all three IPRs at issue, the Board issued an institution decision before the February 28, 2025, rescission date, and no timely request for rehearing or Director Review was filed. The Interim Procedure’s rescission therefore does not apply to IPR2024-00978, IPR2024-00979, or IPR2024-01267.

IPR2024-00978 (Patent 7,395,078 B2)
IPR2024-00979 (Patent 8,081,993 B2)
IPR2024-01267 (Patent 9,026,428 B2)

The Guidance Memorandum further states that “[a]bsent extraordinary circumstances, the Board will not revisit a decision on institution if the time for seeking Director Review or rehearing has passed.” *Id.* Patent Owner asserts that extraordinary circumstances are present here because (a) the Guidance Memorandum makes it clear that a timely-filed *Sotera* stipulation will no longer be dispositive by itself and (b) the Board expressly stated that it did not consider each of the *Fintiv* factors when deciding the issue of discretionary denial because a *Sotera* stipulation was filed in each matter. *See* IPR2024-00978, Ex. 3002. If this were sufficient reason to find that extraordinary circumstances existed, then the exception would swallow the rule established in the Guidance Memorandum. Arguably, any pending instituted proceeding that involved a similar application of the Interim Procedure and in which a rehearing request was not filed would qualify as an “extraordinary” case, subject to reconsideration of institution long after the deadline for filing a rehearing request had passed. This approach would contradict the clear statement in the Guidance Memorandum providing a cutoff date.

We determine that in each of the IPRs at issue, the deadline for requesting a rehearing of the Board’s decision to institute an *inter partes* review expired before the Interim Procedure memorandum was rescinded. We further determine that Patent Owner has not established that extraordinary circumstances exist that would warrant reconsideration of the institution decisions in IPR2024-00978, IPR2024-00979, and IPR2024-01267 at this late date. Consequently, according to the guidance provided in the Guidance Memorandum, Patent Owner’s request is denied.

IPR2024-00978 (Patent 7,395,078 B2)
IPR2024-00979 (Patent 8,081,993 B2)
IPR2024-01267 (Patent 9,026,428 B2)

ORDER

Accordingly, it is

ORDERED that Patent Owner's request for leave to file a motion for reconsideration of institution is *denied*.

IPR2024-00978 (Patent 7,395,078 B2)
IPR2024-00979 (Patent 8,081,993 B2)
IPR2024-01267 (Patent 9,026,428 B2)

For PETITIONER:

Ali R. Sharifahmadian
Patrick Reidy
Douglas Clark
Albert Boardman
ARNOLD & PORTER KAYE SCHOLER LLP
ali.sharifahmadian@arnoldporter.com
patrick.reidy@arnoldporter.com
douglas.clark@arnoldporter.com
albert.boardman@arnoldporter.com

Ben Haber
Jeff Baxter
Kyla Butler
O'MELVENY & MYERS LLP
bhaber@omm.com
jbaxter@omm.com
kbutler@omm.com

For PATENT OWNER:

Qi (Peter) Tong
Benjamin T. Wang
Andrew D. Weiss
RUSS AUGUST & KABAT
ptong@raklaw.com
bwang@raklaw.com
aweiss@raklaw.com