

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

STATON TECHIYA, LLC,

Patent Owner

Case IPR2024-01003

U.S. Patent No. 11,710,473

**Petitioners' Notice Ranking Petitions
And Explaining Material Difference Between
Petitions For U.S. Patent No. 11,710,473**

Petitioners are filing two concurrent petitions challenging the patentability of claims of U.S. Patent No. 11,710,473 (the “’473 patent”)—a first petition challenging claims 1-20 that disputes the priority date to which the claims of the ’473 patent are entitled, and a second petition also challenging claims 1-20 based on the ’473 patent’s earliest alleged priority date. Pursuant to the Board’s November 2019 Consolidated Trial Practice Guide (“TPG”), Petitioners submit this paper to “identify: (1) a ranking of the Petitions in the order in which it wishes the Board to consider the merits ..., and (2) a succinct explanation of the differences between the Petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions.”

I. ORDERING OF PETITIONS

Petitioners believe that both petitions are meritorious and justified. Nonetheless, to the extent required by the TPG, Petitioners request that the Board consider the petitions in the following order:

Rank	PTAB Case No.	References	Challenged Claims
1	IPR2024-01004 (“Petition 1”)	Claims 1-7: <i>Kirsch</i> and <i>DiCenso</i> Claims 8-20: <i>Goldstein</i> and <i>Woodruff</i>	1-20
2	IPR2024-01003	Claims 1-7: <i>Patel</i> , <i>Topholm</i> , <i>Williamson</i> ;	1-20

	("Petition 2")	Claims 8-20: <i>Melanson, Rosenberg, Samadani, and Dijkstra</i>	
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II. MATERIAL DIFFERENCES THAT COMPEL PERMITTING MULTIPLE PETITIONS

Petitioners submit that institution of both petitions against the '473 patent is warranted due to word constraints caused by the arguments within the petitions. Each petition challenges claims 1-20 of the '473 patent, all of which are asserted by Patent Owner in a parallel district court proceeding.

Petition 1 raises a dispute regarding the priority date to which the claims of the '473 patent are entitled (not addressed in Petition 2), and presents two grounds based on references that qualify as prior art if the '473 patent claims are not entitled to priority before February 3, 2022—i.e., the filing date of the application that issued as the '473 patent. Petition 2 presents six grounds and relies only on patents/publications that qualify as prior art as of the earliest alleged priority date on the face of the '473 patent—January 22, 2007.

As discussed in Petition 1, the claims of the '473 patent include a number of limitations that lack written description support in any of the earlier-filed applications to which the '473 patent purports to claim priority. Petitioners' challenge to the priority date of the '473 patent claims requires a discussion of the prosecution history and additional analysis that will not permit the contents of Petition 2 to fit within Petition 1.

In addition, the '473 patent has two independent claims with materially different limitations, requiring Petitioners to present different primary references for each independent claim. Claims 1-7 generally recite a device that transmits gain values to an earpiece, wherein the earpiece applies the gain values to audio signals and mixes the signals together. Claims 8-20 generally recite a device for detecting an “acute sound,” and modifying/mixing audio signals in various ways. The difference in scope between claims 1-7 and 8-20 required Petitioners to use non-overlapping prior art to address each claim set and makes it impractical to include all grounds in a single petition, particularly in view of the need to address the priority date dispute.

The TPG directly addresses the situation presented here, stating “[n]onetheless, the Board recognizes that 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 or *when there is a dispute about priority date requiring arguments under multiple prior art references.*” Consolidated Trial Practice Guide 5 (Nov. 2019) (emphasis added), available at <http://www.uspto.gov/TrialPracticeGuideConsolidated> 59.

Accordingly, the Board has Instituted both IPR petitions in similar circumstances before. *See, e.g., BJ’s Wholesale Club Holdings, Inc. v. Walmart Apollo, LLC*, IPR2022-01564, Paper No. 9 (PTAB Apr. 11, 2023) (granting

institution of second IPR challenging same claims as another instituted IPR, explaining that “where the priority date of the challenged claims is disputed, we conclude it is not unreasonable for Petitioner to present separate challenges, one of which relies on references that are prior art only if the challenged claims are not entitled to Patent Owner’s claimed priority date, which has yet to be finally determined”); *Apple Inc. v. Sonrai Memory Ltd.*, IPR2023-00975, Paper No. 9 (PTAB Dec. 13, 2023) (granting institution of second IPR challenging same claims as another instituted IPR, explaining that “[t]he potential priority dispute between the two parties justifies institution of the two petitions.”).

For these reasons, Petitioners respectfully request institution of both of their concurrently filed IPR petitions against the ’473 patent.

Date: June 12, 2024

Respectfully submitted,

/Ali R. Sharifahmadian/
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Counsel for Petitioners

CERTIFICATE OF SERVICE

I certify that on June 12, 2024, I caused a true and correct copy of the foregoing Petitioners' Notice Ranking Petitions and Explaining Material Differences Between Petitions For U.S. Patent No. 11,710,473 to be served via overnight delivery on the Patent Owner at the following correspondence address of record as listed on Patent Center:

Peter Chiabotti
Akerman LLP
777 South Flagler Drive
Suite 1100 West Tower
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A courtesy copy was also sent via electronic mail to Patent Owner's litigation counsel listed below:

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