UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS AMERICA, INC., HARMAN INTERNATIONAL INDUSTRIES, INC.,

Petitioners

v.

STATON TECHIYA, LLC,

Patent Owner

Case IPR2024-01015

U.S. Patent No. 11,665,493

Petitioners' Notice Ranking Petitions And Explaining Material Difference Between Petitions For U.S. Patent No. 11,665,493

Petitioners are filing two concurrent petitions challenging the patentability of the claims of U.S. Patent No. 11,665,493 (the "'493 patent"). 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	IPR2024-01034 ("Petition 1")	Claims 1, 2, 4-8, 10, 11, 13, 14, 18-20: *Svean*, *Voix*, and *Padhi*; Claims 3, 15-17: *Svean*, *Voix*, *Padhi*, and *Hayashi*; Claims 9, 12: *Svean*, *Voix*, *Padhi*, and *Bourk*	1-20
2	IPR2024-01015 ("Petition 2")	Claims 1, 3-5, 7-8, 10-11, 18-20: *Epley*, *Padhi,* and *Voix*; Claims 9, 12: *Epley*, *Padhi, Voix*, and *Bourke*; Claim 2: *Epley*, *Padhi*, *Voix*, and *Hayashi*; Claims 1, 4, 6, 13-14: *Beard*,	1-20

Rank	PTAB Case No.	References	Challenged Claims
		Epley, *Padhi*, and *Voix*; Claims 15-17: *Beard*, *Epley*, *Padhi*, *Voix*, and *Hayashi*	

II. MATERIAL DIFFERENCES THAT COMPEL PERMITTING MULTIPLE PETITIONS

Petitioners submit that institution of both petitions against the ’493 patent is warranted due to word constraints caused by the arguments within the petitions, as well as the merits of those arguments. Each petition challenges claims 1-20 of the ’493 patent, all of which, aside from claim 2, Patent Owner is asserting in a parallel district court proceeding.

Petitions 1 and 2 divide the challenges based on the primary reference(s) asserted. In particular, Petition 1 is based on *Svean*, while Petition 2 is based on *Epley* and *Beard*. As discussed in Petition 1, *Svean*, as well as secondary reference *Padhi*, were before the Examiner during prosecution of the ’493 patent, and were discussed in notices of allowability. By contrast, neither *Epley* nor *Beard* were considered during prosecution. Thus, Patent Owner may challenge the *Svean*-based grounds under 35 U.S.C. § 325(d). And, while Petitioners explain in Petition 1 why such a challenge should be rejected, the possibility of denial on this basis requires arguments under *Epley* and *Beard*, as well as *Svean*.

Further, it is impracticable to present the *Svean*-, *Epley*-, and *Beard*-based

grounds in one petition. Patent Owner originally asserted all 20 claims of the ’493 patent against Samsung, and has only recently dropped a single dependent claim, necessitating Petitioners to maintain the bulk of the challenges. Patent Owner has not yet identified which claims it intends to assert against Harman. Further, as *Svean* was discussed by the Examiner during prosecution, this necessitated addressing why the Board should not exercise its discretion under § 325(d), which was a reasonable use of space that reduced the available word count.

Indeed, the Board has previously instituted concurrently-filed IPR petitions under similar circumstances. *See, e.g.*, *Abbott Diabetes Care Inc. v. Dexcom, Inc.*, IPR2022-00922, Paper No. 13 (P.T.A.B. Nov. 3, 2022) (Instituting review in both proceedings, and explaining “Petitioner spent a substantial portion of its allocated word-count addressing issues of discretionary denial under §§ 314 and 325(d) on the chance that Patent Owner would request such a denial. … Doing so, trimmed the space available to address the merits of its challenges, the subject matter that forms the basis of *inter partes review*.”).

For these reasons, Petitioners respectfully request institution of both of their concurrently-filed IPR petitions against the ’493 patent.

Date: July 1, 2024

Respectfully submitted,

/James L. Davis, Jr./
James L. Davis, Jr. (Reg. No. 57,325)
Counsel for Petitioners

CERTIFICATE OF SERVICE

I certify that on July 1, 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. 11,665,493 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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Date: July 1, 2024

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