

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

OURARING INC.
Patent Owner.

Case No. IPR2024-01079
U.S. Patent No. 10,281,953

**PETITIONER'S NOTICE OF RANKING PETITIONS FOR *INTER*
PARTES REVIEW OF U.S. PATENT NO. 10,281,953**

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I. INTRODUCTION

Petitioner is concurrently filing two petitions for *inter partes* review of U.S. Patent No. 10,281,953 (“the ’953 Patent”) (Ex-1001). “To aid the Board in determining” why “more than one petition is necessary,” Petitioner provides the information below. *See* PTAB Consolidated Trial Practice Guide (“TPG”) (November 2019) at 59-60. As explained below, the Board should institute both.

II. RANKING

While both petitions are meritorious and justified as explained below, Petitioner requests that the Board consider the petitions in the following order:¹

Rank	Petition	Challenged Claims	Grounds
1	IPR2024-01078 (“Petition 1”)	1-6, 11-15, 38-43	<u>Ground 1</u> : Claims 1-6 and 11-14 are obvious over <i>Mestas</i> and <i>Asami</i> <u>Ground 2</u> : Claims 1-6, 11, 14-15, 38-39, and 41-43 are obvious over <i>Mestas</i> and <i>Schröder</i> <u>Ground 3</u> : Claims 1-6, 11, 14-15, 38-39, and 41-43 are obvious over <i>Schröder</i> and <i>Mestas</i> <u>Ground 4</u> : Claims 11-15 are obvious over <i>Schröder</i> , <i>Mestas</i> , and <i>Asami</i> <u>Ground 5</u> : Claims 40-43 are obvious over <i>Schröder</i> , <i>Mestas</i> , and <i>Wissmar</i>

¹ While Petitioner provides this ranking in accordance with the TPG, Petitioner believes ranking in this instance is inappropriate and unnecessary because each petition addresses different claims.

Rank	Petition	Challenged Claims	Grounds
2	IPR2024-01079 ("Petition 2")	16-18, 20-21, 23-24, 30-35, 37	<u>Ground 1:</u> Claims 16-18, 20-21, 23-24, 30-35, and 37 are obvious over <i>Sun</i> <u>Ground 2:</u> Claims 16-18, 20-21, 23-24, 30-35, and 37 are obvious over <i>Sun</i> and <i>Bress</i> <u>Ground 3:</u> Claims 16-18, 20-21, 23-24, 30-35, and 37 are obvious over <i>Sun</i> and <i>Asami</i> <u>Ground 4:</u> Claims 16-18, 20-21, 23-24, 30-35, and 37 are obvious over <i>Sun</i>, <i>Asami</i>, and <i>Bress</i> <u>Ground 5:</u> Claims 16-18, 20-21, 23-24, 30-35 are obvious over <i>Asami</i> and <i>Bress</i>

III. MATERIAL DIFFERENCES AND REASONS FOR INSTITUTION

As the Board has recognized, “there may be circumstances in which more than one petition may be necessary.” PTAB Consolidated TPG at 59-60. This is such a circumstance. The ’953 Patent includes two sets of independent claims, each directed to distinct subject matter: (1) claims 1 and 38 directed to a wearable computing device recite certain structural components of the device, including enclosure structures, printed circuit boards, and a light emitting diode (Ex-1001, 48:22-45, 52:15-35), and (2) claims 16 and 30 directed to a method and a computer readable medium containing computer instructions, respectively, for gesture recognition using a wearable computing device (*Id.*, 49:51-50:16, 50:62-51:17).

Petition 1 challenges the first set of independent claims, 1 and 38, based on Mestas and Schroder as primary references in combination with Asami and Wissmar, as well as their dependent claims 2-6, 11-15, and 39-43 based on the same references. Petition 1 challenges 17 claims total. Petition 2 challenges the second set of independent claims, 16 and 30, based on Asami and Sun as primary references, alone or in combination with Bress, as well as their dependent claims 17-18, 20-21, 23-24, 31-35, and 37 based on the same references. Petition 2 challenges 14 claims total. The two petitions challenge different claims and were specifically tailored to address the different combinations of features in the claims.

There was no practicable way to fit the grounds for all 31 challenged claims in a single petition, given the IPR word limit restrictions. The two sets of claims are directed to separate alleged inventions—the first set to a wearable computing device and its structural details, while the second set to gesture recognition methods. Patent applications claiming such distinct inventions typically prompt a patent examiner to issue a restriction requirement that causes the applicant to elect a set of claims to prosecute. *See* MPEP §802.02. No such restriction was issued during the prosecution of the '953 Patent. *See, generally*, Ex-1004 ('953 File History). Accordingly, the '953 Patent issued with 43 claims directed to the above distinct subject matter. Because each of the two petitions challenges a distinct subset of claims, both should be instituted. *See Dolby Labs., Inc. v. Intertrust*

Techs. Corp., IPR2020-01105, Paper 14 at 20-21 (P.T.A.B. Jan. 5, 2021) (“we decline to exercise our discretion under § 314(a) to deny inter partes review because Dolby filed three parallel petitions each challenging different subsets of claims of the ’157 patent.”); *Intel Corp. v. VLSI Technology LLC*, IPR2019-01199, Paper 19 at 10 (P.T.A.B. Feb. 6, 2020) (declining to exercise discretion to deny institution where “each petition is directed to a different independent claim.”); *see also Samsung Elecs. Co. v. Hardin*, IPR2022-01328, Paper No. 13 at 21 (P.T.A.B. Feb. 8, 2023) (declining to exercise discretion to deny institution of three concurrent petitions covering thirty-four claims); *Microsoft Corp. v. IPA Techs. Inc.*, IPR2019-00810, Paper 12 at 14 (P.T.A.B. Oct. 16, 2019) (“Faced with word count limitations and a large number of challenged claims, Petitioner’s decision to divide its analysis of those claims among a number of petitions appears reasonable.”); *Samsung Elecs. Co. v. Mojo Mobility*, IPR2023-01089, Paper 11 at 26 (P.T.A.B. Jan. 11, 2024) (“[W]e find persuasive Petitioner’s reasons for filing two parallel petitions, particularly because the petitions challenge different claims of the ’349 patent. In effect, the two petitions were filed instead of one merely because our Rules have page limit restrictions.”).

The concurrent filing of the petitions also weighs against discretionary denial. Because Petitioner has filed its two petitions concurrently, it “did not gain a timing advantage that might otherwise occur were the petitions filed serially,”

which further supports institution. *Hardin*, IPR2022-01328 at 22-23.

IV. DENIAL OF TRIAL INSTITUTION WOULD BE UNFAIR

Given that it is Petitioner's burden to establish unpatentability of the challenged claims, the level of detail included in the petitions is appropriate, and the Board should not penalize Petitioner for doing so by exercising its discretion under 35 U.S.C. § 314 to deny either petition. Petitioners should not be penalized for the applicant's choices in how many claims were presented during prosecution, nor for the Examiner's decisions not to issue a restriction requirement.

Institution of both petitions would not implicate time or resource concerns if trial is instituted in both, and Petitioner would not oppose consolidation of the hearings for the two proceedings upon institution.² Moreover, both the Administrative Procedures Act and due process weigh against discretionary denial of institution of either petition because, as discussed, *different claims are challenged in each respective petition*. Denial of either petition would deprive Petitioners of the forum Congress created to hear patentability challenges.

V. CONCLUSION

For the reasons presented above, the Board should institute both petitions.

² Nor would Petitioner oppose consolidation of the substantive briefing, provided that appropriate accommodations were made to page limits for substantive filings.

U.S. Patent No. 10,281,953
Petition for *Inter Partes* Review

Respectfully Submitted,

/s/ William M. Fink

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CERTIFICATE OF SERVICE (37 C.F.R. §42.6(e)(1))

The undersigned hereby certifies that the above document was served on June 28, 2024, by filing this document through the Patent Trial and Appeal Board P-TACTS System, as well as delivering a copy via express mail upon the following attorneys of record for the Patent Owner:

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