

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioner,

v.

COLLISION COMMUNICATIONS, INC.,
Patent Owner.

IPR2024-01247 (Patent 7,593,492 B2)
IPR2024-01249 (Patent 6,947,505 B2)¹

Before CHARLES J. BOUDREAU and DONALD E. DAYBELL,
Administrative Patent Judges.

DAYBELL, *Administrative Patent Judge*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This Order addresses issues that are the same in each of the above-identified proceedings. We issue one Order for entry in each proceeding. The parties may not use this style caption without our permission.

INTRODUCTION

On December 16, 2024, counsel for Petitioner Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd. emailed the Board requesting authorization to file preliminary replies to Patent Owner Collision Communications, Inc.’s Preliminary Responses (IPR2024-01247, Paper 7; IPR2024-01249, Paper 7), seeking to address two issues raised in the Preliminary Responses. Ex. 3001; Ex. 3002. First, for both proceedings Petitioner sought to address arguments for discretionary denial under 35 U.S.C § 314(a) in view of *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB March 20, 2020) (precedential) (“*Fintiv*”). Ex. 3001; Ex. 3002. Second, for the -1247 proceeding Petitioner sought to address Patent Owner’s claim construction for the term “multi-user detector decision unit” recited in claims 1 and 10 of U.S. Patent 7,593,492 B2 (“the ’492 Patent”). Ex. 3001.

On December 23, 2024, a conference call was conducted by Judges Daybell and Boudreau with counsel for the parties to discuss these issues. A court reporter was present on the call, and a transcript of the call has been entered in the record. Ex. 1050.

Prior to the call, Petitioner advised the Board that it had reached an agreement with Patent Owner as to the first issue, and that it had reached a partial agreement as to the second issue. Ex. 3003. As to the first issue, Petitioner expressed its intention to file a “*Sotera* stipulation” in each proceeding, pursuant to the Board’s precedential decision in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2024-01019, Paper 12 (PTAB Dec. 1, 2020), if authorized by the Board. As to the second issue, Petitioner represented that it has agreed to accept the claim construction proposed by Patent Owner in

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the -1247 Preliminary Response (hereinafter “Preliminary Response” or “Prelim. Resp.”), for purposes of that proceeding. Prelim. Resp. 18.

As to the first issue, the Board on the call authorized Petitioner to file a *Sotera* stipulation in both the -1247 and -1249 proceedings. The Board then heard argument as to Petitioner’s proposal to provide a further explanation of its position as to how its arguments set forth in the -1247 Petition (IPR2024-01247, Paper 3; hereinafter “Petition” or “Pet.”) read the “multi-user detector decision unit” term from claims 1 and 10 in the ’492 Patent onto the cited prior art under Patent Owner’s proposed claim construction.

In the Petition, Petitioner did not propose to construe any term of the ’492 Patent and instead argued that “[u]nless otherwise indicated, and for this proceeding only, the claim terms should be given their plain and ordinary meaning under *Phillips* [*v. AWG Corp*, 415 F.3d 1303 (Fed. Cir. 2005)]”. Pet. 11. Petitioner provided argument as to how the claims of the ’492 Patent, including the “multi-user detector decision unit” term, allegedly read on the cited prior art, under such plain and ordinary meaning. *See id.* at 34–37. In the Preliminary Response, however, Patent Owner proposed a construction for the term “multi-user detector decision unit,” under 35 U.S.C. § 112 ¶ 6 (hereinafter “Section 112(6)”). Prelim. Resp. 16–24. Patent Owner’s construction tracked the construction adopted by the District Court for the Eastern District of Texas in a prior case, *Collision Communications, Inc. v. Nokia Networks & Solutions Oy*, No. 2:21-cv-000308 (E.D. Tex.). Prelim. Resp. 17 (citing Ex. 2005 (Claim Construction Order, *Collision Commc’ns, Inc. v. Nokia Networks & Sol’s.*, Docket. No. 125, at 65–73 (E.D. Tex. Aug. 31, 2022))). Patent Owner then contended that, under the proper construction, Petitioner had failed to show how this

term read on the cited prior art. *Id.* at 21–24. Petitioner now seeks leave to “connect the dots” between the arguments in the Petition and the requirements of the Patent Owner’s proposed claim construction for this term.

On the call, Petitioner’s counsel argued that good cause exists to allow additional briefing because neither lead nor backup counsel were aware of the existence of the prior claim construction order at the time of filing of the Petition. Petitioner further argued that the Board would benefit from a complete record on this issue. Petitioner’s counsel conceded that it was generally aware of the prior litigation, and that in IPR2024-01248, a related proceeding before the Board, it had cited to the *Nokia* case as a related matter.² Petitioner, however, reiterated that neither of the counsel involved with preparing and filing the Petition were aware of the prior claim construction order from the Eastern District court addressing this term.

Petitioner further contended that it did not believe, at the time the Petition was filed, that Patent Owner intended to offer a construction under Section 112(6) for this term. Petitioner noted that Patent Owner’s infringement contentions in the underlying litigation between the present parties did not set forth such a construction (which Petitioner alleges is a

² In IPR2024-01248, Petitioner challenges U.S. Patent 9,814,071. That patent was also a subject of the prior *Nokia* litigation, including the same claim construction order at issue here. In that litigation, however, no terms of the ’071 Patent were construed in the claim construction order at issue here. Ex. 2005, 3 n.1. We also observe that the -1247 proceeding involves additional backup counsel not listed for the -1248 proceeding. *Compare* IPR2024-01247, Paper 3, 62, *with* IPR2024-01248, Paper 3, 91. While by no means dispositive, this at least leaves open the possibility that Petitioner’s counsel for the -1247 proceeding may not have been aware of the claim construction order or of its relevance to the -1247 proceeding.

requirement of the operative local rules in the district court), and that Patent Owner had not identified the prior litigation as a related matter in Patent Owner's Mandatory Notice (IPR2024-01247, Paper 5).³

Patent Owner's counsel contended that Petitioner failed to show good cause because Petitioner's claims of lack of knowledge of the prior litigation's claim construction order lacked credibility and contended that Petitioner knew or should have known about the prior claim construction order in view of its citation of the *Nokia* litigation in IPR2024-01248. *See supra* note 2. Patent Owner further contended that it had been prejudiced by Petitioner's failure to address claim construction in its Petition, because of the passage of time and the possibility that Patent Owner may have made different arguments had it known of Petitioner's views on claim construction for this term in the months prior to preparing the Preliminary Response.

DISCUSSION

After hearing and considering the parties' positions, we are persuaded that Petitioner has established good cause for authorization to file a preliminary reply limited to explaining how its analysis in the Petition satisfies the construction of "multi-user detector decision unit" set forth in

³ 37 C.F.R. 42.8(b)(2) requires parties' mandatory notices to "identify any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding." A prior judicial claim construction order construing a term found in the challenged patent falls within the scope of this requirement, because such an order plainly "would affect . . . a decision in the proceeding." Neither Petitioner nor Patent Owner identified the prior litigation nor the claim construction order in their mandatory notices for this proceeding. Pet. 60; Patent Owner's Mandatory Notices, 2 (Paper No. 5).

the Preliminary Response. Patent Owner is also authorized to file a preliminary sur-reply in response to Petitioner's reply.

Under the particular circumstances of this proceeding as set forth in the record to date, we accept for purposes of this Order Petitioner's counsel's representation that at the time the Petition was filed neither lead counsel nor backup counsel who prepared the -1247 Petition were aware of the prior claim construction order. We note that Patent Owner failed to include in its Mandatory Notices any mention of the prior litigation generally, nor of the claim construction order specifically. Nor did Patent Owner update its Mandatory Notices at any time after filing them, to include any mention of the prior litigation or the prior order. Nor does it appear on this record that (prior to the filing of the Petition) Patent Owner provided in the underlying litigation between the present parties any notice to Petitioner that it intended to take the position that the "multi-user detector decision unit" term was subject to Section 112(6). Indeed, the parties' arguments during the conference call suggest that the opposite may be true. Petitioner contended that Patent Owner was required to identify terms it believed were subject to Section 112(6), as part of the district court's rules governing infringement contentions. Petitioner further contended that Patent Owner did not thus identify the "multi-user detector decision unit" term. Patent Owner did not dispute this contention during the call. Thus, it appears on this record that the first time Petitioner became aware that Patent Owner intended to rely on the prior claim construction order and a Section 112(6) construction for this term may have been upon receiving the Preliminary Response filed November 14, 2024.

We are troubled by Petitioner's professed lack of awareness of the existence of a publicly filed order from a District Court that directly

addresses a claim term from the same patent that is now at issue before the Board. However, Patent Owner's failure to timely provide notice of the prior litigation in its Mandatory Notices is also a factor contributing to Petitioner's lack of awareness. Patent Owner furthermore does not identify any particularized prejudice that may arise from granting leave to Petitioner. Patent Owner's concerns about possible alternative courses of action it might have taken had Petitioner acted more expeditiously are speculative at best. We see little if any prejudice to Patent Owner that would be caused by granting Petitioner leave to file a short brief limited to "connecting the dots" between the arguments in the Petition and the claim construction proposed by Patent Owner. Patent Owner is free to further develop its concerns about prejudice in its preliminary sur-reply.

We further find that Petitioner's proposed additional briefing will be helpful to the Board in resolving the parties' dispute in this proceeding. A short additional statement that "connects the dots" between Petitioner's existing arguments in the Petition and the requirements of Patent Owner's proposed claim construction will be useful to the Board in analyzing this issue. We caution Petitioner that this brief is strictly limited to a succinct explanation of how the existing arguments in the Petition demonstrate that the cited prior art meets Patent Owner's proposed claim construction. No new theories or new substantive evidence are permitted.⁴ We further note that our grant of leave to file this additional brief does not necessarily mean that the Board will consider any substantive argument in Petitioner's

⁴ Should the parties wish to submit evidence supporting or refuting good cause and timeliness, such as evidence supporting the positions the parties took on the conference call as reflected in the transcript, this is hereby authorized.

preliminary reply to be timely. That is a question we reserve for our review of the preliminary reply and any preliminary sur-reply Patent Owner chooses to file.

We are also troubled by the fact that Petitioner waited over one month after the Preliminary Response was filed before it first sought leave from the Board to address this issue. We caution the parties that delay in seeking relief in the future may lead to denial of same.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request for leave to file a preliminary reply to Patent Owner's Preliminary Response is *granted*;

FURTHER ORDERED that, no later than January 6, 2025, Petitioner is authorized to file a preliminary reply of no more than two pages to Patent Owner's Preliminary Response to address the issue of how the arguments set forth in the Petition demonstrate that the cited prior art meets Patent Owner's proposed construction for the term "multi-user detector decision unit";

FURTHER ORDERED that, no later than January 21, 2025, Patent Owner is authorized to file a preliminary sur-reply of no more than two pages limited to addressing the issues raised in Petitioner's preliminary reply;

FURTHER ORDERED that, no later than January 6, 2025, Petitioner is authorized to file a *Sotera* stipulation in the -1247 and -1249 proceedings; and

FURTHER ORDERED that, no later than December 30, 2024, Petitioner is to file a transcript of the conference call as Petitioner's next exhibit.

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