IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Samsung Electronics Co., Ltd.,
Petitioner,

v.

SiOnyx, LLC,
Patent Owner.

Case No. IPR2024-01431
Patent No. 11,069,737

PETITIONER'S EXPLANATION OF PARALLEL PETITIONS CHALLENGING U.S. PATENT NO. 11,069,737

In accordance with the USPTO's PTAB Trial Practice Guide, Petitioner Samsung Electronics Co., Ltd. ("Petitioner") submits this explanation for filing two petitions for *inter partes* review of U.S. Patent No. 11,069,737 (the "'737 patent"), filed in IPR2024-01430 ("Petition A") and IPR2024-01431 ("Petition B"). *See* "Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019" ("TPG") at 59-60.

Two petitions are required because Petitioner is challenging a large number of claims, most of which have been asserted by Patent Owner against Petitioner in ITC litigation (48 claims asserted out of 55 challenged claims, including three independent claims). *See id.*; *see also Microsoft Corp. v. IPA Techs. Inc.*, IPR2019-00810, Paper 12 at 13-14 (Oct. 16, 2019) (determining that multiple petitions were reasonable when a petitioner was "[f]aced with word count limitations and a large number of challenged claims"). Indeed, the claim listings alone for the challenged claims include 1,311 words, collectively. The Board should institute both *inter partes* reviews.

I. EXPLANATION OF THE MATERIAL DIFFERENCES BETWEEN THE TWO PETITIONS

The petitions challenge the same claims (with the exception of claim 30, which is only challenged in Petition A) over different prior art references:

Petition	Challenged claims of the ’737 patent	Ground
Petition A: IPR2024-01430	1-11, 13-42, and 44-55	Ground 1: §102 and/or §103 over Alie
	1, 12-13, 21, 24, 30, 43-44, 51, and 54	Ground 2: §103 over Alie and Baggenstoss
	16, 32-42, and 44-55	Ground 3: §103 over Alie and Jiang
	25 and 55	Ground 4: §103 over Alie and Haddad204
	25 and 55	Ground 5: §103 over Alie and Park
Petition B: IPR2024-01431	1-11, 13-16, 18-19, 22, 25, 32-42, 44-46, 48-49, 52, and 55	Ground A-1: §102 and/or §103 over Haddad138
	1, 12-13, 21, 24, 43-44, 51, and 54	Ground A-2: §103 over Haddad138 and Baggenstoss
	16, 32-42, 44-46, 48-49, 52, and 55	Ground A-3: §103 over Haddad138 and Jiang
	17, 20, 23, 47, 50, and 53	Ground A-4: §103 over Haddad138 and Alie
	25 and 55	Ground A-5: §103 over Haddad138 and Haddad204
	25 and 55	Ground A-6: §103 over Haddad138 and Park
	26, 28-29, and 31	Ground B-1: §102 and/or §103 over Yap
	27	Ground B-2: §103 over Yap and Alie

The length and number of challenged claims justifies multiple petitions. Petitioner challenges 55 claims, 48 of which Patent Owner has asserted in the ITC litigation. Petition A challenges 55 claims, including three independent claims, Petition B challenges 54 claims, including three independent claims. The challenged claims themselves are lengthy, and consist of more than 1,300 words in total. Petitioner thus requires additional words to challenge the asserted claims,

despite its best efforts to narrow the unpatentability issues presented to the Board. For example, within each petition, any given claim is challenged based on only one primary reference. The petitions have not been split by claims, as doing so would have required significant repetition of arguments. In order to facilitate the Board's review, the petitions have instead been split by grounds.

II. RANKING OF THE PETITIONS

Given the overlapping issues raised in the petitions, the burden of addressing the grounds of both petitions would not be substantially greater than the burden of addressing the grounds of either petition alone, and the Board should institute inter partes review on both petitions. In addition, the Board and the parties can obtain efficiencies by holding a single oral hearing and consolidating depositions in both proceedings. In accordance with the Board's direction that Petitioner should identify "a ranking of the petitions in the order in which it wishes the Board to consider the merits" (TPG at 60), though, Petitioner ranks Petition A first.

Date: September 24, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6 and 42.105, I hereby certify that on September 24, 2024, I caused a true and correct copy of the foregoing PETITIONER'S EXPLANATION OF PARALLEL PETITIONS CHALLENGING U.S. PATENT NO. 11,069,737, to be served by Federal Express, a means at least as fast and reliable as Priority Mail Express®, on the following correspondence address of record for patent owner:

Troutman Pepper Hamilton Sanders LLP
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Custom # 11951

A courtesy copy was also sent patent owner's litigation counsel:

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Date: September 24, 2024

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