

Filed on behalf of:

Patent Owner

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Paper No. _____

Date: January 22, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

SIONYX, LLC,
Patent Owner.

Case IPR2024-01431
Patent 11,069,737 B2

**PATENT OWNER'S RESPONSE TO
PETITIONER'S NOTICE RANKING PARALLEL PETITIONS**

I. INTRODUCTION

Petitioner Samsung Electronics Co., Ltd. (“Samsung” or “Petitioner”) filed two parallel petitions for *inter partes* review of U.S. Patent No. 11,069,737 (the “’737 Patent”), IPR2024-01430 (“Petition A”) and IPR2024-01431 (“Petition B”). The two petitions challenge an almost identical set of claims (the only difference is claim 30, which is only addressed in Petition A). Petitioner’s only justification for filing parallel petitions is the number and length of the challenged claims. However, that justification fails, because Petition A confirms that all the claims in the ’737 Patent can be addressed in a single petition. Petitioner’s true motivation for filing two petitions is its desire to assert thirteen (13) different invalidity grounds. It could not fit thirteen (13) grounds in one petition, so Petitioner filed two petitions.

The Patent Trial and Appeal Board Consolidated Trial Practice Guide (“Trial Practice Guide”) indicates that multiple petitions should only be allowed in “rare” circumstances. *See* Trial Practice Guide (November 2019), 59. A Petitioner’s desire to assert thirteen (13) invalidity grounds is not a valid basis for filing two petitions.

II. THE TWO PETITIONS

The two petitions are summarized in the chart below:

IPR2024-01431 (Patent 11,069,737)
PO's Response to Notice Ranking Parallel Petitions

IPR2024-01430 (Petition A)

Claims	Ground	Primary Reference	Secondary Reference(s)
Ground 1: 1-11, 13-42, 44-55	§102 and/or §103	Alie (EX1006)	
Ground 2: 1, 12-13, 21, 24, 30, 43-44, 51, 54	§103	Alie (EX1006)	Baggenstoss (EX1007)
Ground 3: 16, 32-42, 44-55	§103	Alie (EX1006)	Jiang (EX1008)
Ground 4: 25, 55	§103	Alie (EX1006)	Haddad204 (EX1009)
Ground 5: 25, 55	§103	Alie (EX1006)	Park (EX1010)

IPR2024-01431 (Petition B)

Claims	Ground	Primary Reference	Secondary Reference(s)
Ground A-1: 1-11, 13-16, 18-19, 22, 25, 32-42, 44-46, 48-49, 52, 55	§102 and/or §103	Haddad138 (EX1012)	
Ground A-2: 1, 12-13, 21, 24, 43- 44, 51, 54	§103	Haddad138 (EX1012)	Baggenstoss (EX1007)
Ground A-3: 16, 32-42, 44-46, 48- 49, 52, 55	§103	Haddad138 (EX1012)	Jiang (EX1008)
Ground A-4: 17, 20, 23, 47, 50, 53	§103	Haddad138 (EX1012)	Alie (EX1006)
Ground A-5: 25, 55	§103	Haddad138 (EX1012)	Haddad204 (EX1009)
Ground A-6: 25, 55	§103	Haddad138 (EX1012)	Park (EX1010)
Ground B-1: 26, 28-29, 31	§102 and/or §103	Yap (EX1011)	
Ground B-2: 27	§103	Yap (EX1011)	Park (EX1010)

Patent Owner notes that concurrent with the Patent Owner's Preliminary Response, Patent Owner filed a disclaimer cancelling claims 1, 7-27, 29-32, and 38-55 of the '737 Patent. As a result, claims 2-6, 28, 33, and 34-37 remain at issue.

III. RESPONSE TO RANKING DOCUMENT AND MULTIPLE PETITIONS

A. The Board Should Deny Petition B (the Second Ranked Petition), Because Petitioner's Justification Fails

The Trial Practice Guide provides that "one petition should be sufficient to challenge the claims of a patent in most situations." Trial Practice Guide (November 2019), 59. This is not one of the rare cases where multiple petitions are proper.

First, Petitioner challenges the same set of claims in both Petitions, with the exception of claim 30, which is only challenged in Petition A. *See* IPR2024-01430 Petition, 62, 79-80. Petitioner was able to address all the claims in one petition because Petitioner did exactly that in Petition A. As a result, Petitioner's assertion that two petitions were required because of the number and length of the challenged claims is plainly false, as Petition A confirms.

Second, contrary to Petitioner's allegations, the challenged claims are not particularly long or complex, and as the Board's rules confirm, presenting the

claims and the claim language in a claim listing does not count against the word count limitations for a petition. *See* 37 C.F.R. § 42.24(a)(1).

Third, while 55 claims are challenged, the independent claims, and many of the dependent claims, are related in scope, allowing what Petitioner itself characterizes as “significant repetition of arguments.” Petitioner’s Explanation of Parallel Petitions Challenging U.S. Patent No. 11,069,737, 3.

Fourth, the parallel petitions at issue are redundant; even Petitioner agrees, characterizing the issues as “overlapping” and capable of sharing “a single oral hearing.” *Id.* Indeed, as illustrated in Patent Owner’s Preliminary Responses to Petitions A and B filed concurrently herewith, both Petitions fail for the same reason – both primary references lack the same element. Petitioner’s acknowledgment that the Petitions are redundant undercuts its argument that both Petitions are necessary. The Board’s consent for multiple petitions in “rare” circumstances does not provide petitioner’s an end-run around the petition’s word limit.

B. Petitioner’s True Motivation for Multiple Petitions Is Improper

The two Petitions challenge an almost identical set of claims (the only difference is claim 30, which is only addressed in Petition A). Petitioner’s only justification for filing parallel petitions is the number and length of the challenged

claims. However, that justification fails because Petition A confirms that all the claims in the '737 Patent can be addressed in a single petition.

Petitioner's true motivation for filing two petitions is its desire to assert thirteen (13) different invalidity grounds. *See* above summary chart in Section II. It could not fit thirteen (13) grounds in one petition, so Petitioner filed two petitions. That is not a proper justification for filing two petitions. *See, e.g., Aylo Freesites Ltd, v. Dish Techs. LLC*, IPR2024-00941, Paper 12 at 10-11 (Nov. 21, 2024) (denying institution of parallel petitions where both petitions challenged the same set of claims because “the scope of the challenges is exactly the same in both cases”); *Abbot Diabetes Care Inc., v. Dexcom, Inc.*, IPR2024-00860, Paper 12 at 12 (Nov. 20, 2024) (rejecting “the length and number of challenged claims” as a justification for multiple petitions, where both petitions challenge the same set of claims).

In view of the above, institution should be denied on Petition B.

IV. CONCLUSION

For the reasons set forth above, Petitioner's request for institution of multiple redundant petitions for *inter partes* review fails and institution of Petition B should be denied.

IPR2024-01431 (Patent 11,069,737)

PO's Response to Notice Ranking Parallel Petitions

Respectfully submitted,

Date: January 22, 2025

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Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), this is to certify that on this 22 day of January, 2025, I caused to be served a true and correct copy of the foregoing **PATENT OWNER'S RESPONSE TO PETITIONER'S NOTICE RANKING PARALLEL PETITIONS** by e-mail (as agreed in the Service Information section of the Petition):

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