

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 RESPONSE TO PATENT OWNER'S SUPPLEMENTAL
SUBMISSION ON DISCRETIONARY DENIAL**

List of Exhibits

Exhibit	Description
1001	U.S. Patent No. 11,069,737 (the “’737 patent”)
1002	File History for U.S. Patent No. 11,069,737
1003	Provisional Application No. 61/841,326
1004	Declaration of Dr. Michael Lebby
1005	Curriculum Vitae of Dr. Michael Lebby
1006	U.S. Patent Application Publication No. 2012/0068289 (Alie)
1007	U.S. Patent Application Publication No. 2006/0081900 (Baggenstoss)
1008	International Publication No. WO 2012/122572 (Jiang)
1009	U.S. Patent Application Publication No. 2012/0313204 (Haddad204)
1010	U.S. Patent Application Publication No. 2010/0006969 (Park)
1011	U.S. Patent No. 7,928,389 (Yap)
1012	U.S. Patent Application Publication No. 2011/0227138 (Haddad138)
1013	Samsung’s Proposed Constructions, Inv. No. 337-TA-1403 (Aug. 27, 2024)
1014	SiOnyx’s Proposed Constructions, Inv. No. 337-TA-1403 (Aug. 27, 2024)
1015	Email from N. Subhedar re: Claim Construction M&C Follow-Up (Sept. 8, 2024)
1016	U.S. Patent No. 8,680,591 (Haddad138 Issued Patent)
1017	U.S. Patent No. 9,496,308 (Haddad204 Issued Patent)
1018	The Authoritative Dictionary of IEEE Standard Terms (7th ed. 2000)
1019	Stephen Y. Chou et al., Nanoimprint Lithography, J. Vac. Sci. Technol. B 14(6), 4129-33 (1996)
1020	Gary S. May & Simon M. Sze, Fundamentals of Semiconductor Fabrication (2003)
1021	Provisional Application No. 61/311,004 (Haddad138-Provisional004)
1022	Provisional Application No. 61/243,434 (Haddad138-Provisional434)
1023	Provisional Application No. 61/311,107 (Haddad138-Provisional107)
1024	U.S. Patent Application Publication No. 2012/0146172 (Carey)
1025	U.S. Patent No. 7,442,629 (Mazur)
1026	U. Gösele & Q.-Y. Tong, Semiconductor Wafer Bonding (1998)
1027	U.S. Patent Application Publication No. 2011/0304003 (Tanida)
1028	S. Wolf, Microchip Manufacturing (2004)
1029	Encyclopedia of Physical Science and Technology (3rd ed. 2002)

1030	Christoph Posch, Detectors, Pixels, and Signal Processing, in Smart Cameras (Ahmed Nabil Belbachir ed., 2010)
1031	Order No. 36: Construing Certain Claim Terms in parallel matter of In re Certain Sensors with Pixels and Products Containing the Same, Inv. No. 337-TA-1403 (U.S.I.T.C.)
1032	March 20, 2025 Email from S. Weidenfeller re: IPR2024-01430 and -01431: Motions to terminate/withdraw ground
1033	March 20, 2025 Email from A. Ahn re: Inv. No. 337-TA-1403/2:24-cv-00291(E.D. Tex.): '737 IPR Stipulation

This case concerns the second of two IPR petitions that Petitioner filed for U.S. Patent No. 11,069,737 ('737 patent), collectively challenging all of its 55 claims. At the time, Petitioner was operating under the guidance of former Director Vidal's 2022 guidance memorandum, which had provided that "the PTAB no longer discretionarily denies petitions based on applying *Fintiv* to a parallel ITC proceeding."¹ Patent Owner appears to have operated under the same guidance, given that it did not raise any discretionary denial arguments in its preliminary responses. Instead, Patent Owner raised only three limited merits arguments in the short preliminary response that it submitted for this IPR. *See* POPR at 3–11. At the same time, Patent Owner disclaimed 44 of the 55 claims of the '737 patent, tacitly acknowledging the strength of the IPR petitions.

Patent Owner has now sought to raise arguments for discretionary denial under *Fintiv* in light of parallel ITC litigation, asserting that institution of this IPR would be "antithetical to the preservation of the efficiency and consistency of the patent system." Paper 14 at 5. Among other things, Patent Owner ignores the fact that the ITC litigation involves only three claims of the '737 patent, whereas this IPR would address the parties' dispute as to all 11 claims that remain after Patent Owner's disclaimer.

¹ Memorandum from Katherine K. Vidal dated June 21, 2022, at 7.

Nonetheless, in an effort to eliminate any remaining overlap, Petitioner is now agreeing to narrow its challenges before the Board and ITC as follows:

- Petitioner is moving to terminate its first-ranked IPR petition, IPR2024-01430. *See* EX-1032.
- Petitioner is moving to withdraw Ground A-3 from this IPR. *See* Ex-1032.
- Petitioner is stipulating that if the Board institutes this IPR on the two remaining applicable grounds, Petitioner will not assert invalidity in parallel litigation using as primary or combination references any of the references asserted in those grounds. *See* EX-1033.

As a result, there will be no overlap of the asserted references between the IPR and the ITC proceeding. The Board need not address Grounds A-2, A-4, A-5, A-6, and B-2 because all claims challenged in those grounds have been disclaimed. The Board need not address Ground A-3 because Petitioner is moving to withdraw it. For the references asserted in the remaining Grounds A-1 and B-1, Petitioner has stipulated not to use those references as primary or combination references at the ITC or in the parallel district court case that has been stayed. *See* EX-1033. Thus, by stipulating at the ITC and limiting the IPR challenges to a narrowed version of Petitioner's second-ranked petition, Petitioner has taken significant steps to avoid

any overlap of issues, and to ensure that this IPR is effectively a “true alternative” to the ITC proceeding under the principles of *Sotera*.

The Board has instituted trials in similar situations. In IPR2020-00470, for example, “Petitioner note[d] that it ‘has stipulated that if the Board institutes *inter partes* review of the challenged claims of the ’752 patent, [Petitioner] will not pursue invalidity on the same grounds or even the same references in the parallel district court proceeding.’” *VMWare, Inc. v. Intellectual Ventures I LLC*, IPR2020-00470, Paper 13 at 20 (PTAB Aug. 18, 2020). The Board declined to exercise its discretion to deny institution under *Fintiv*, finding that such a stipulation “mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.” *Id.*

Indeed, even before the 2022 guidance memorandum, the Board commonly granted institution of IPRs with parallel ITC proceedings where, as here, there was no overlap of the asserted references between the IPR and ITC proceedings. For example, in *Apple, Inc. v. Alivecor, Inc.*, IPR2021-00970, Paper 10 (PTAB Dec. 8, 2021), the Board granted institution, stressing that “the Petition includes materially different grounds, arguments, and/or evidence than the ITC Investigation.” *Id.* at 18, 48. Similarly, in *Philip Morris Prods, S.A. v. RAI Strategic Holdings, Inc.*, IPR2020-01094, Paper 9 (PTAB Jan. 25, 2021), the Board granted institution, finding that the Petitioner’s stipulation to base its “ITC prior art invalidity case on [product and

system art] as the primary references ... has the same effect as the stipulation the petitioner provided in *Sotera*.” *Id.* at 22, 35.

In addition to the lack of overlap between the references asserted in the IPR and ITC proceedings, there is no overlap of *any* unpatentability issues for claims 3, 5, 6, 28, and 34–37. These claims remain at issue in the PTAB, whereas in the ITC proceeding Patent Owner asserts only claims 2, 4, and 33. Moreover, there is a risk that Patent Owner may subsequently attempt to assert these remaining claims in the stayed district court case. Thus, the ITC litigation could not address the parties dispute as to the vast majority (8 out of 11) of the challenged claims that remain after Patent Owner’s disclaimer. The Board has granted institution in similar cases. *See, e.g., Volkswagen Group of America, Inc. v. Arigna Technololgy Ltd.*, IPR2021-01321, Paper 10 at 8, 32 (PTAB Feb. 15, 2022) (declining to exercise discretion to deny institution based on parallel ITC litigation where “only four of the nine challenged claims in [the IPR] are also at issue in the ITC proceeding”; finding that “the additional claims at issue here, but not in the ITC proceeding, weigh against exercising our discretion to deny institution”).

Given the lack of overlap of grounds, arguments, and evidence, the Board should institute trial, particularly where, as here, Petitioner is adapting to the USPTO’s change in guidance by removing any overlap with the ITC proceeding, leaving only discrete, non-overlapping arguments for the Board’s consideration.

Petitioner has separated the grounds fully between the PTAB and the ITC, relying only on primary and combination references in the ITC that are not asserted in the IPR, and Petitioner has withdrawn grounds that it could have raised in both venues.

Applying the *Fintiv* factors, (1) there is no stay at the ITC, but the district court case is stayed, which is neutral; (2) the ITC trial date is imminent, but the district court case is stayed; (3) the parties have invested in the ITC proceeding, but such investment covers only three claims of the '737 patent; (4) significantly, Petitioner has eliminated the overlap in references cited, and this IPR covers many more claims than the ITC matter; (5) Petitioner and Real Parties-in-Interest are Respondents in the ITC matter; and (6) Petitioner has established a strong case on the merits, causing Patent Owner to disclaim 44 of the 55 claims in the '737 patent. Under a holistic assessment of these considerations, in a case where both parties were operating under the 2022 guidance and Patent Owner did not raise *Fintiv* in its preliminary response, Petitioner respectfully submits that this IPR presents an appropriate case for institution and resolution before the Board.

Date: March 20, 2025

Respectfully submitted,

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IPR2024-01431

Patent No. 11,069,737

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that the foregoing Petitioner's Response to Patent Owner's Supplemental Submission on Discretionary Denial, together with Exhibits 1032 and 1033, was served by electronic mail on the following counsel of record for patent owner:

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Dustin.Ferzacca@Troutman.com
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Date: March 20, 2025

/Scott C. Weidenfeller/

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