

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

TRUESIGHT COMMUNICATIONS LLC,
Patent Owner.

IPR2024-01477
Patent US 8,898,803 B1

Before JOSIAH C. COCKS, ROBERT J. WEINSCHENK, and
BACH V. HOANG, *Administrative Patent Judges*.

HOANG, *Administrative Patent Judge*.

ORDER
Inviting Supplemental Briefing on
Discretionary Denial Under 35 U.S.C. § 314(a)
37 C.F.R. § 42.5

On September 27, 2024, Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioner”) filed a petition requesting an *inter partes* review of claims 1–14 of U.S. Patent No. 8,898,803 B1 (Ex. 1001, “the ’803 Patent”). Paper 3 (“Pet.”). Truesight Communications LLC (“Patent Owner”) timely filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

The parties state the ’803 Patent is also the subject of a related district court litigation: *Truesight Communications LLC. v. Samsung Electronics Co., Ltd. et al.*, 2-23-cv-00643 (E.D. Tex.) (“district court litigation”). Pet. 89; Paper 5, 2. The parties disagree as to whether we should exercise the discretion to deny institution under 35 U.S.C. § 314(a) based on the district court litigation. Pet. 89; Prelim. Resp. 15–23. The parties’ arguments address the USPTO’s *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022) (“Interim Procedure”). Pet. 89; Prelim. Resp. 19. However, that Interim Procedure was rescinded on February 28, 2025 and directs the parties to “refer to Patent Trial and Appeal Board (PTAB) precedent for guidance.” *USPTO Rescinds Memorandum Addressing Discretionary Denial Procedures*, <https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures>.

As the Petition and Preliminary Response offered discretionary denial arguments on the basis of guidance which was later rescinded, the panel has determined that the record would benefit from additional briefing before our decision on institution. We authorize Petitioner to file a five page supplemental brief addressing what effect the rescission of the Interim Procedure has on the exercise of discretion to deny institution under 35 U.S.C. § 314(a) based on the district court litigation. If Petitioner files a

supplemental brief, we authorize Patent Owner to file a five page response to Petitioner's supplemental brief. The parties' supplemental briefing may not address any other issue.

Accordingly, it is:

ORDERED that Petitioner may file a supplemental brief on the effect of the recission of the Interim Procedure, as discussed above, limited to five pages and within five business days of this Order;

FURTHER ORDERED that Patent Owner may file a response to Petitioner's supplemental brief, as discussed above, limited to five pages and within five business days of Petitioner's supplemental brief;

FURTHER ORDERED that that no other briefing is authorized at this time.

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