Filed on behalf of:
Patent Owner
By: Alison L. McCarthy (Lead Counsel)
Alison.McCarthy@Troutman.com
Dustin N. Ferzacca (Back-up Counsel)
Dustin.Ferzacca@Troutman.com
Andrew P. Zappia (Back-up Counsel)
(*pro hac vice* conditionally approved)
Andrew.Zappia@Troutman.com

Paper No. ____
Date: March 12, 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 IPR2025-00064
Patent 10,347,682 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. 10,347,682 (the "'682 Patent"), IPR2025-00064 ("Petition A") and IPR2025-00065 ("Petition B"). The two petitions challenge the identical set of claims. 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 '682 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:

IPR2025-00064 (Petition A)

Claims	Ground	Primary Reference	Secondary Reference(s)
Ground A-1: 1-3, 6-8, 11-12, 15-18, 21, 26-27	§102 and/or §103	Haddad138 (EX1012)	
Ground A-2: 4-5, 14, 21-22	§103	Haddad138 (EX1012)	Baggenstoss (EX1007)
Ground A-3: 9-10, 13, 19-20, 28-31, 34-42	§103	Haddad138 (EX1012)	Alie (EX1006)
Ground A-4: 23	§103	Haddad138 (EX1012)	Haddad204 (EX1009)
Ground A-5: 23	§103	Haddad138 (EX1012)	Park (EX1010)
Ground A-6 32-33, 42-43	§103	Haddad138 (EX1012)	Alie (EX1006) and Baggenstoss (EX1007)
Ground A-7 44	§103	Haddad138 (EX1012)	Alie (EX1006) and Haddad204 (EX1009)
Ground A-8 44	§103	Haddad138 (EX1012)	Alie (EX1006) and Park (EX1010)
Ground B-1 24-25	§103	Park (EX1010)	Baggenstoss (EX1007)

IPR2025-00065 (Petition B)

Claims	Ground	Primary Reference	Secondary Reference(s)
Ground 1: 1-3, 5-22, 24-31, 33-43	§103	Alie (EX1006)	
Ground 2: 4-5, 14, 21-22, 25, 32-33, 42-43	§103	Alie (EX1006)	Baggenstoss (EX1007)
Ground 3: 23, 44	§103	Alie (EX1006)	Haddad204 (EX1009)
Ground 4: 23, 44	§103	Alie (EX1006)	Park (EX1010)

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. 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[1] 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).

[1] Terms not otherwise defined have the same meaning as ascribed to them in the Patent Owner's Preliminary Response.

Third, while 44 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. 10,347,682 (Paper 3), 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.*, 4. 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 elements. 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 petitioners an end-run around the petition's word limit.

B. Petitioner's True Motivation For Multiple Petitions Is Improper

The two Petitions challenge the identical set of claims. 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 '682 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 (PTAB 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"); *Abbott Diabetes Care Inc. v. Dexcom, Inc.*, IPR2024-00860, Paper 12 at 12 (PTAB 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.

Respectfully submitted,

Date: March 12, 2025

/Alison L. McCarthy/
Alison L. McCarthy (Lead Counsel)
Registration No. 51,998

Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), this is to certify that on this 12th day of March, 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):

Scott C. Weidenfeller (Lead Counsel)
Reg. No. 54,531
COVINGTON & BURLING LLP
One CityCenter
850 Tenth Street, NW
Washington, DC 20001
Tel: (202) 662-5923
Fax: (202) 778-5923
Service email:
sweidenfeller@cov.com
Samsung-SiOnyx-IPR-Cov@cov.com

Counsel for Petitioner

David A. Garr (Back-up Counsel)
Reg. No. 74,932
COVINGTON & BURLING LLP
One CityCenter
850 Tenth Street, NW
Washington, DC 20001-4956
Tel: (202) 662-5250
Fax: (202) 778-5250
Service email: dgarr@cov.com

Counsel for Petitioner

Alice J. Ahn (Back-up Counsel)
Reg. No. 79,829
COVINGTON & BURLING LLP
415 Mission Street, Ste. 5400
San Francisco, CA 94150-2533
Tel: (415) 591-7091
Fax: (415) 955-6591
Service email: aahn@cov.com

Counsel for Petitioner

/Alison L. McCarthy/
Alison L. McCarthy (Lead Counsel)
Registration No. 51,998

Counsel for Patent Owner