

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)

Andrew.Zappia@Troutman.com

Paper No. _____

Date: April 7, 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 IPR2025-00065
Patent 10,347,682

**PATENT OWNER'S SUR-REPLY IN SUPPORT OF
DISCRETIONARY DENIAL OF PETITION**

LIST OF PATENT OWNER'S EXHIBITS

PO Exhibit Number	Description
	Filed and Served on February 13, 2025 with Patent Owner's Motion for <i>Pro Hac Vice</i> Admission of Andrew P. Zappia Under 37 C.F.R. § 42.10
2001	Declaration of Andrew P. Zappia in Support of Patent Owner's Motion for <i>Pro Hac Vice</i> Admission
	Filed and Served on March 12, 2025 with Patent Owner's Preliminary Response
2002	Second Amended Docket Control Order dated December 27, 2024 (ECF No. 50) in SiOnyx, LLC v. Samsung Electronics, Co., Ltd., Case No. 2:24-cv-00408-JRG (E.D. Tex.)
2003	Memorandum Opinion and Order dated August 30, 2024 (ECF No. 18) in SiOnyx, LLC v. Samsung Electronics, Co., Ltd., Case No. 2:24-cv-00408-JRG (E.D. Tex.)
2004	Excerpts of Defendants' P.R. 3-3 Invalidity Contentions served October 30, 2024, in SiOnyx, LLC v. Samsung Electronics, Co., Ltd., Case No. 2:24-cv-00408-JRG (E.D. Tex.)

The weight of the *Fintiv* factors strongly favor discretionary denial.

Petitioner's purported *Sotera* stipulation ("Stipulation") (EX1037) does not change this; first, because the Stipulation does not eliminate the overlapping issues between the District Court case and this proceeding and second, because the investment in the District Court has been significant and that case will be concluded prior to any final written decision here.

Petitioner's Stipulation fails to reduce the invalidity issues that will be presented to the District Court. The invalidity arguments advanced by Petitioner in the District Court case are broader than but fully inclusive of, the Grounds presented in this Petition. In the District Court, there are far more combinations of art (both art cited and relied on in this Petition and additional art). Significantly, Petitioner also asserts in the District Court product art in combination with some of the art asserted in this Petition. Thus, Petitioner's art and arguments here are being considered in the District Court. For this reason alone, the Stipulation is inadequate, because it does not reduce the overlapping invalidity issues and positions already presented to the District Court. Thus, a duplication of effort by the Board and the Court will be required. *See Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205 to 1208, Paper 19 at 4 (PTAB Mar. 28, 2025) (Director vacating institution decisions and denying institution) ("Petitioner's invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in [the IPR] proceedings

with unpublished system prior art, which Petitioner's stipulation is not likely to moot"). As in *Motorola*, the scope of the Stipulation here fails to outweigh the substantial investment already made in the District Court case. *Id. See also Illumina, Inc. v. Natera, Inc.*, IPR2019-01201, Paper 19 at 6 (PTAB Dec. 18, 2019).

The investment in the District Court case also has been significant for both Petitioner and Patent Owner, outweighing any benefit in efficiencies allegedly addressed by Petitioner's Stipulation. The entirety of claim construction and discovery – fact and expert, including reports and depositions – will be completed by the end of this calendar year. Instituting the Petition will require a full duplication of effort. The significant investment that has and will be made in the District Court before the Board will issue a final written decision here weighs against institution.

Further, Petitioner opted to file counterclaims in the District Court challenging the validity of all the claims in the '682 Patent. Thus, all 44 of the claims that are challenged in this Petition are at issue in the District Court. This is a complete overlap of claims in both proceedings, contrary to Petitioner's statement otherwise. This complete overlap of the claims at issue, the art, and the invalidity theories advanced favors discretionary denial. Patent Owner additionally notes that the weak merits of this Petition, which were succinctly and directly addressed in the Preliminary Response, further weighs in favor of discretionary denial.

Based on the foregoing, Patent Owner respectfully requests that the Board exercise its discretion to deny institution of this Petition, based on the weight of the *Fintiv* factors when considered as a whole, as set forth above and as addressed in detail in Patent Owner's Preliminary Response (Paper 10).

Respectfully submitted,

Date: April 7, 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 7th day of April, 2025, I caused to be served a true and correct copy of the foregoing **PATENT OWNER'S SUR-REPLY IN SUPPORT OF DISCRETIONARY DENIAL OF PETITION** by e-mail on the following (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
Tel: (202) 662-5950
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
Salesforce Tower
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