

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

TRUESIGHT COMMUNICATIONS LLC,
Patent Owner.

IPR2025-00123
Patent 8,745,749 B2

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

WEINSCHENK, *Administrative Patent Judge*.

ORDER
Authorizing Reply and Sur-reply
37 C.F.R. § 42.5

I. ANALYSIS

Samsung Electronics Co., Ltd. and Samsung Electronics, America, Inc. (“Petitioner”) filed a Petition (Paper 3, “Pet.”) requesting an *inter partes* review of claims 1–8 and 13–25 (“the challenged claims”) of U.S. Patent No. 8,745,749 B2 (Ex. 1001, “the ’749 patent”). Truesight Communications LLC (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”) to the Petition.

The parties address discretionary denial under 35 U.S.C. § 314(a), and rely on the USPTO memorandum entitled “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation.” Pet. 88; Prelim. Resp. 22. On February 28, 2025, the USPTO rescinded that memorandum, and noted that parties should refer to PTAB precedent for guidance, including *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) and *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A).

As a result, we authorize Petitioner to file a 5-page reply to the Preliminary Response by March 17, 2025, to address the impact of the rescinded memorandum on discretionary denial under § 314(a). If Petitioner files a reply, we authorize Patent Owner to file a 5-page sur-reply by March 24, 2025, to respond to Petitioner’s arguments in the reply.

II. ORDER

It is hereby

ORDERED that Petitioner may file a 5-page reply to the Preliminary Response by March 17, 2025, in accordance with the instructions above; and

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FURTHER ORDERED that if Petitioner files a reply, Patent Owner may file a 5-page sur-reply to the reply by March 24, 2025, in accordance with the instructions above.

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