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. IPR2025-00163
Patent No. 10,224,359

PETITIONER'S EXPLANATION OF PARALLEL PETITIONS CHALLENGING U.S. PATENT NO. 10,224,359

In accordance with the USPTO's PTAB Trial Practice Guide, Petitioner Samsung Electronics Co., Ltd. ("Petitioner") submits this explanation for filing two petitions for *inter partes* review of U.S. Patent No. 10,224,359 (the "'359 patent"), filed in IPR2024-00162 ("Petition A") and IPR2024-00163 ("Petition B"). *See* "Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019" ("TPG") at 59-60.

Two petitions are required because Petitioner is challenging a large number of claims, most of which have been asserted by Patent Owner against Petitioner in ITC litigation (66 claims asserted out of 79 challenged claims, including two independent claims). *See id.*; *see also Microsoft Corp. v. IPA Techs. Inc.*, IPR2019-00810, Paper 12 at 13-14 (Oct. 16, 2019) (determining that multiple petitions were reasonable when a petitioner was "[f]aced with word count limitations and a large number of challenged claims"). Indeed, the claim listings alone for the challenged claims include 2,180 words, collectively. The Board should institute both *inter partes* reviews.

I. EXPLANATION OF THE MATERIAL DIFFERENCES BETWEEN THE TWO PETITIONS

The petitions challenge the same claims over different prior art references:

Petition	Challenged claims of the ’359 patent	Ground
Petition A: IPR2024-00162	1-5, 7-8, 10-11, 18, 23, 25, 38-43, 45-50, 52-64, 67-70, 73-75, and 80-83	Ground 1: §102 and/or §103 over Iida
	12-17, 19-22, 26-29, and 76-79	Ground 2: §103 over Iida and Haddad188
	6, 9, 24, 30, 32, 34, and 36	Ground 3: §103 over Iida and Shinohara
	44, 51, 65-66, and 71-72	Ground 4: §103 over Iida and Roy
Petition B: IPR2024-00163	1-5, 7, 10, 18, 23, 25, 38-43, 45-50, 52-64, 67-70, 73-75, and 80-83	Ground 1: §102 and/or §103 over Hwang
	12-17, 19-22, 26-29, and 76-79	Ground 2: §103 over Hwang and Haddad188
	6, 8, 9, 11, 24, 30, 32, 34, and 36	Ground 3: §103 over Hwang and Shinohara
	44, 51, 65-66, and 71-72	Ground 4: §103 over Hwang and Roy

The length and number of challenged claims justifies multiple petitions. Petitioner challenges 79 claims, 66 of which Patent Owner has asserted in the ITC litigation. Petition A challenges 79 claims, including two independent claims, Petition B challenges 79 claims, including two independent claims. The challenged claims themselves are lengthy and consist of more than 2,180 words in total. Petitioner thus requires additional words to challenge the asserted claims, despite its best efforts to narrow the unpatentability issues presented to the Board. For example, within each petition, any given claim is challenged based on only one primary reference. The petitions have not been split by claims, as doing so would have

required significant repetition of arguments. In order to facilitate the Board's review, the petitions have instead been split by grounds.

II. RANKING OF THE PETITIONS

Given the overlapping issues raised in the petitions, the burden of addressing the grounds of both petitions would not be substantially greater than the burden of addressing the grounds of either petition alone, and the Board should institute *inter partes* review on both petitions. In addition, the Board and the parties can obtain efficiencies by holding a single oral hearing and consolidating depositions in both proceedings. In accordance with the Board's direction that Petitioner should identify "a ranking of the petitions in the order in which it wishes the Board to consider the merits" (TPG at 60), though, Petitioner ranks Petition A first.

Date: November 29, 2024

Respectfully submitted,

By: */Dave A. Garr/*

Dave A. Garr
Registration No.: 74,932
COVINGTON & BURLING LLP
One CityCenter, 850 Tenth Street, NW
Washington, DC 20001-4956
Telephone: (202) 662-5923
Facsimile: (202) 778-5923
Counsel for Petitioner