Filed on behalf of:
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Paper No. ____
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

SIONYX, LLC,
Patent Owner.

Case IPR2025-00163
Patent 10,224,359 B2

PATENT OWNER'S RESPONSE TO PETITIONER'S NOTICE RANKING PARALLEL PETITIONS

I. INTRODUCTION

Petitioner Samsung Electronics Co., Ltd. ("Samsung" or "Petitioner") filed two corrected parallel petitions for *inter partes* review of U.S. Patent No. 10,224,359 (the "'359 Patent"), IPR2025-00162 (Paper 4) ("Corrected Petition A") and IPR2025-00163 (Paper 4) ("Corrected Petition B"). The two corrected 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 Corrected Petition A confirms that all the claims in the '359 Patent can be addressed in a single petition. Petitioner's true motivation for filing two petitions is its desire to assert eight (8) different invalidity grounds. It could not fit eight (8) 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 eight (8) invalidity grounds is not a valid basis for filing two petitions.

II. THE TWO CORRECTED PETITIONS

The two corrected petitions are summarized in the chart below:

IPR2025-00162 (Corrected Petition A)

Claims	Ground	Primary Reference	Secondary Reference(s)
Ground A-1: 1-5, 7-8, 10-11, 18, 23, 25, 38-43, 45-50, 52-64, 67-70, 73-75, 80-83	§102 and/or §103	Iida (EX1005)	
Ground A-2: 12-17, 19-22, 26-29, 76-79	§103	Iida (EX1005)	Haddad188 (EX1007)
Ground A-3: 6, 9, 24, 30, 32, 34, 36	§103	Iida (EX1005)	Shinohara (EX1008)
Ground A-4: 44, 51, 65-66, 71-72	§103	Iida (EX1005)	Roy (EX1009)

IPR2025-00163 (Corrected Petition B)

Claims	Ground	Primary Reference	Secondary Reference(s)
Ground 1: 1-5, 7, 10, 18, 23, 25, 38-43, 45-50, 52-64, 67-70, 73-75, 80-83	§102 and/or §103	Hwang (EX1006)	
Ground 2: 12-17, 19-22, 26-29, 76-79	§103	Hwang (EX1006)	Haddad188 (EX1007)
Ground 3: 6, 8, 9, 11, 24, 30, 32, 34, 36	§103	Hwang (EX1006)	Shinohara (EX1008)
Ground 4: 44, 51, 65-66, 71-72	§103	Hwang (EX1006)	Roy (EX1009)

III. RESPONSE TO RANKING DOCUMENT AND MULTIPLE PETITIONS

A. The Board Should Deny Corrected 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 Corrected Petition A. As a result, Petitioner's assertion that two petitions are required because of the number and length of the challenged claims is plainly false, as Corrected 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).

Third, while 79 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 Corrected Explanation of Parallel Petitions Challenging U.S. Patent No. 10,224,359, 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.*, 3. Indeed, as illustrated in Patent Owner's Preliminary Responses filed concurrently herewith, both corrected Petitions fail for similar reasons. 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 Petitioner's an end-run around the Petition's word limit.

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

The two corrected 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 Corrected Petition A confirms that all the claims in the '359 Patent can be addressed in a single petition.

Petitioner's true motivation for filing two petitions is its desire to assert eight (8) different invalidity grounds. *See* above summary chart in Section II. It could not fit eight (8) 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 (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"); *Abbot Diabetes Care Inc., v. Dexcom, Inc.*, IPR2024-00860, Paper 12 at 12 (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 Corrected 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 Corrected Petition B (Paper 4) should be denied.

Respectfully submitted,

Date: April 17, 2025

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Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), this is to certify that on this 17th day of April, 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):

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