

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NVIDIA CORPORATION,  
Petitioner,

v.

SAMSUNG ELECTRONICS COMPANY, LTD.,  
Patent Owner.

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Case IPR2016-00134  
Patent 8,252,675 B2

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Before JAMESON LEE, PATRICK R. SCANLON, and  
JUSTIN BUSCH, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

A telephone conference call was held on March 1, 2016. The participants were respective counsel for the parties and Judges Lee, Scanlon, and Busch. The subject matter for discussion is Petitioner's request for authorization to file a reply to Patent Owner's Preliminary Response.

The rules governing an *inter partes* review do not provide the Petitioner an opportunity to file a reply to the Patent Owner's Preliminary Response. Nevertheless, where the situation warrants, the Board may authorize such a reply. This is not such a case. Counsel for Petitioner identified two alleged "misstatements" in the Preliminary Response that Petitioner would like to address in a reply:

1.

The instant petition impermissibly uses the Patent Owner's preliminary response to the first petition in IPR2015-01318 as a roadmap to remedy the errors Petitioner made in its first petition and advances the same or substantially the same prior art or arguments that Petitioner advanced in IPR2015-01318.

Prelim. Resp. 1.

2.

Moreover, contrary to Petitioner's allegations, Petitioner's new prior art, U.S. Patent No. 8,563,669 to Hsu ("Hsu"), was known to petitioner at the time of the filing of the first petition.

Prelim. Resp. 1–2.

The first statement constitutes mere attorney argument based on the fact that Patent Owner's Preliminary Response in IPR2015-01318 was issued prior to filing of the Petition in IPR2016-00134. It is not a factual misrepresentation that justifies a reply. Even if it were a factual misrepresentation, Petitioner has not explained why a reply is necessary, given that the Board can determine whether the representation is supported by evidence in the record.

IPR2016-00134  
Patent 8,252,675 B2

With regard to the second statement, we queried counsel for Petitioner whether Petitioner disputes that the Hsu reference was provided to Petitioner in the related ITC litigation prior to filing of the Petition in this proceeding. Counsel for Petitioner replied that that fact is not in dispute and that the Hsu reference was indeed provided to Petitioner prior to filing of the Petition in this proceeding. Thus, the second statement also does not constitute a factual misrepresentation that justifies a reply by the Petitioner.

We understand the general desire of petitioners to file a reply to a patent owner's preliminary response. No sufficient justification, and resulting deviation from the general rule, however, has been provided here.

Order

It is

ORDERED that Petitioner's request for authorization to file a reply to Patent Owner's Preliminary Response is *denied*.

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