

Filed: August 14, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE (USA), INC., and
SAMSUNG ELECTRONICS CO., LTD.,¹

PETITIONERS,

v.

BELL NORTHERN RESEARCH, LLC,
PATENT OWNER.

Case No. IPR2019-01365
U.S. Patent No. 7,039,435

**PATENT OWNER'S RESPONSE TO
PETITIONER SAMSUNG'S REQUEST FOR EXTENSION OF TIME FOR
REPLY TO PATENT OWNER'S RESPONSE**

¹ Samsung Electronics Co., Ltd., who filed a petition in IPR2020-00697, has been joined as a petitioner to this proceeding.

Patent Owner Bell Northern Research, LLC (“BNR” or “Patent Owner”) files this response to Petitioner Samsung Electronics Co., Ltd. (“Petitioner” or “Samsung”) Request for Extension of Time for Reply to Patent Owner’s Response.

The present proceeding is currently scheduled for oral argument on October 29, 2020, and concerns U.S. Patent No. 7,039,435 (“’435 patent”). *See* Paper 14 at 9. The Board has also scheduled oral argument in IPR2019-01319 and 2019-01320 concerning two patents (the “Goris patents”), which are unrelated to the ’435 patent, on the same date. For the reasons explained herein, Samsung waived any right to seek an extension of the original case. However, BNR does not oppose moving the oral argument date in this matter, provided there is no impact on the oral argument date for the Goris patents. The technical subject matter of the Goris patents is not related to the ’435 patent. Further, BNR has asserted the Goris patents in pending litigations (and stayed litigations) and would be unduly prejudiced if the Goris IPR proceedings are delayed.² In addition, although Samsung is joined in the Goris IPRs, it is in an “understudy” role and does not actively participate in those proceedings; thus, the primary party in the Goris IPRs is not the same as in the ’435 patent IPR.

² For clarity, BNR does not understand Samsung to be asking for an extension in the IPR2019-01319 and -01320 proceedings.

On the other hand, if the Board intends to conduct the oral arguments for the Goris and '435 patents at the same time, such that Samsung's request would impact and delay the oral argument date for the Goris patents, BNR opposes Samsung's request. In its joinder motion, Samsung represented to the Board that it would assume an "understudy" role and that joinder would "neither unduly complicate the ZTE IPR nor delay its schedule." *See* IPR2020-00697, Paper 4 at 2; *see also id.* at 3 ("as all issues are substantively identical and Samsung will act as an 'understudy,' joinder will have minimal or no impact on the pending schedule of the ZTE IPR."), *id.* at 6 ("[Samsung] explicitly consents to the existing trial schedule."). The Board accepted Samsung's representations in granting joinder as reflected in the joinder order filed in this matter. *See* Paper 25 at 6 ("FURTHER ORDERED that the Scheduling Order in place in IPR2019-01365 will continue to govern the joined proceeding."). Now, Samsung is backtracking.

As an understudy, Samsung agreed to abide by the decisions made by ZTE, the original petitioner, and not pursue an active role unless and until ZTE ceased participation in these proceedings. Thus, before any withdrawal³, ZTE could make arguments, admissions, and strategy decisions disagreeable to Samsung, and

³ ZTE requested authorization to withdraw from this proceeding in an email to the Board dated July 30, 2020.

Samsung would have no recourse as the “understudy.” *See* IPR2020-00697, Paper 4 at 2 (“[Samsung] will not assume an active role unless the current Petitioner ceases to participate in the instituted IPR.”), *id.* at 7 (“Unless and until the current Petitioner ceases to actively participate in the ZTE IPR, Samsung will not assume an active role therein.”); *see also* IPR2019-01365, Paper 25 at 5 (“In view of Petitioner’s agreement to abide by the conditions set forth in its Motion, Patent Owner does not oppose Petitioner’s motion to join as a party to the 1365 IPR proceeding.”). That ZTE decided not to file a reply was always a possibility and a risk that Samsung knowingly assumed. After all, submitting a reply in an IPR proceeding is optional, not mandatory, as evidenced by the permissive language in the Scheduling Order. *See* Paper 14 at 7 (“Petitioner **may** file a reply to the Patent Owner’s response.”); *see also* Consolidated Trial and Practice Guide (Nov. 2019) (“TPG”) at 73 (same). Samsung should be required to pick up these proceedings where ZTE left off, and that includes complying with the existing case schedule and abide by ZTE’s filings (or absence thereof) up to the point of ZTE’s withdrawal.

If Samsung did not want to be bound by the decision of ZTE, it could have proceeded with its own IPR and not sought joinder. But Samsung saw a tactical advantage in joining this proceeding to get an earlier final written decision.

Samsung got what it sought and cannot now be heard to complain and backtrack

on its express representations because it does not like how these proceedings have played out.

The Petition sets forth arguments and evidence purportedly showing why the challenged claims of the '435 patent are unpatentable, and BNR has responded to those arguments and evidence. *See also* TPG at 73 (“Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability.”). Nothing prevents the Board from deciding the issues raised on the current record.⁴

Therefore, to the extent that Samsung’s request for an extension would affect the date for oral argument in the Goris IPRs and consequently prejudice Patent Owner by causing a delay in those unrelated proceedings, the Board should deny Samsung’s request.

⁴ Indeed, the Board often decides issues without permitting replies and sur-replies.

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