

Filed: May 26, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,

PETITIONER,

V.

BELL NORTHERN RESEARCH, LLC,

PATENT OWNER.

Case Nos. IPR2020-00611

U.S. Patent No. 8,416,862

**PATENT OWNER'S RESPONSE TO PETITIONER'S NOTICE
REGARDING MULTIPLE PETITIONS**

There is no reason why Petitioner could not have thoroughly challenged the '862 Patent in a single petition: “Based on the Board’s prior experience, one petition should be sufficient to challenge the claims of a patent in most situations.” (PTAB Consolidated Trial Practice Guide (November 2019) (“TPG”) at 59.) As the Board well understands, “[t]wo or more petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner) may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns.” (*Id.*)

Petitioner offers no justifiable basis to need two petitions. *First*, despite its contention, Petitioner cannot justify multiple petitions based on its own choice to use prior art that it admits faces printed publication issues. (Paper 3 (IPR2020-00611) at 2 (“*Roh* faces printed publication issues that may be raised by Patent Owner.”), Paper 3 (IPR2020-00613) at 3 (“*Sadrabadi* is an NPL reference, so it (like *Roh*) faces printed publication issues that may be raised by Patent Owner.”).) These are not issues raised by a dispute over the critical date of the '862 Patent; they are whether Petitioner has met its burden to show *when* any references were made publicly available to even begin the inquiry as to whether it occurred before or after the critical date. *Second*, Petitioner seeks to justify two petitions in an effort to comply with the Board’s rules regarding “the necessary specificity as to how the prior art meets the claim limitations while meeting the word limit

applicable to IPR petitions.” (Paper 3 (IPR2020-00611) at 3, Paper 3 (IPR2020-00613) at 3.) This justification rings hollow in light of Petitioner’s 224-page Expert Declaration it filed in in IPR2020-00611 and its separate 184-page Expert Declaration in IPR2020-00613. This is especially true where, as set out in Patent Owner’s Preliminary Responses, Petitioner still improperly incorporated argument by reference in multiple places—*including in attempting to address the very printed publication issues that Petitioner claimed justifies two petitions.*

To further assist the Board, Patent Owner provides the below responses to the Board’s questions as set out in the TPG:

1) What are the differences among the two petitions and are they material?

As Petitioner acknowledges through its ranking, there is significant overlap in the utilization of prior art references and each Petition challenges the same single independent claim and three dependent claims. (Paper 3 at 1–2.) As Petitioner points out, “in each petition, the grounds addressing claim 9 (the only challenged independent claim) rely on two references in common (*Maltsev* and *Haykin*) and one additional reference (*Roh* or *Lin* for Petition 1 [IPR2020–00611]; *Sadrabadi* for Petition 2)” and the same holds true for two of the three challenged dependent claims (claims 11, 12). (Paper 3 at 4.) The additional independent claim, claim 10, uses the same reference—*Yang*—in each case. (Paper 3 at 1–2.)

Notably, Petitioner frames its necessity for two petitions to ameliorate printed publication issues of *Roh* and *Sadrabadi*. But Petition 1 includes the grounds that utilize *Lin*, and thus ameliorate Petitioner’s alleged concerns over the printed publication status of *Roh* and *Sadrabadi*. (Paper 3 at 1–2.) Adding a second petition that includes a reference with issues related to printed publication (*Sadrabadi*) does not assist Petitioner in mitigating and risk to its chosen prior art references. Petitioner addressed that risk within the first Petition itself by using *Lin* (a U.S. patent) as an alternative to *Roh*. *See id.*

2) Why should the Board institute additional petitions if one will suffice?

Petitioner argues that “both the Administrative Procedures Act and due process concerns weigh against denying institution of either petition based on the Board’s discretion.” (Paper 3 at 4.) Neither is true.

“[Section] 314(a) invests the Director with discretion on the question whether to institute review” (emphasis omitted)); *SAS Inst. v. Iancu*, 138 S. Ct. 1348, 1356 (2018). That discretion includes the discretion to deny a petition. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”) Indeed, “the PTO is permitted, but never compelled, to institute an IPR proceeding.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed.

Cir. 2016). No violation of the APA or due process would occur if the Board declined to institute one or both petitions.

First, the very same reason that Petitioner argues that “institution of both petitions would not implicate concerns regarding the Board’s time and resources required” is the same reason Petitioner need not have filed two petitions—there is significant overlap between the asserted prior art. In *Comcast Cable Comm’s, LLC v. Veveo, Inc.*, IPR2019-00238, Paper 15 (PTAB July 5, 2019), the Board found overlap in the references at issue in multiple petitions and declined to institute all of them. Similarly, the Board can, and should, exercise its discretion here to decline to institute one or more of the present petitions.

Second, as noted in Patent Owner’s Preliminary Response, there are sufficient grounds to deny both petitions under § 314(a) in light of the *Fintiv* Factors. *See also Nalox-1 Pharmaceuticals, LLC v. Opiant Pharmaceuticals, Inc.*, IPR2019-00686, Paper 11, 6 (PTAB Aug. 27, 2019) (“When determining whether to exercise our discretion under § 314(a), [the Board] consider[s], among other factors, whether a petitioner has filed multiple other petitions challenging the same patent.”).

Third, denial of one or more of the petitions is appropriate because Petitioner fails to comply with the Board’s rules. As noted in Patent Owner’s Preliminary Response, Petitioner violates the word limit by incorporating arguments by

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