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

Patent No. 8,416,862

PETITIONER'S NOTICE
REGARDING MULTIPLE PETITIONS

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I. INTRODUCTION

Petitioner is concurrently filing two petitions (called Petition 1 and Petition 2, per the table below) challenging different claims of U.S. Patent No. 8,416,862 ("the '862 patent"). "To aid the Board in determining" why "more than one petition is necessary," Petitioner provides the information below. *See* PTAB Consolidated Trial Practice Guide ("TPG") (November 2019) at 59-60. As explained below, the Board should not exercise its discretion under 35 U.S.C. § 314 to deny either petition on the basis of the filing of multiple petitions, and should instead institute both petitions.

II. RANKING

While both petitions are meritorious and justified as explained below, Petitioner requests that the Board consider the petitions in the following order:[1]

Rank	Petition	Challenged Claims	Grounds
1	Petition 1	9-12	Ground 1: Claims 9, 11, and 12 obvious over *Roh* in view of *Maltsev* and *Haykin* Ground 2: Claim 10 obvious over *Roh* in view of *Maltsev*, *Haykin*, and *Yang* Ground 3: Claims 9, 11, and 12 obvious over Lin in view of *Haykin* and *Maltsev*

[1] While Petitioner is providing this ranking per the PTAB's guidance in the consolidated TPG, Petitioner requests institution of both petitions.

			Ground 4: Claim 10 obvious over Lin in view of *Haykin*, *Maltsev*, and *Yang*
2	Petition 2	9-12	Ground 1: Claims 9, 11, and 12 obvious over *Maltsev* in view of *Haykin* and *Sadrabadi* Ground 2: Claim 10 obvious over *Maltsev* in view of *Haykin* and *Sadrabadi*

III. DIFFERENCES BETWEEN THE PETITIONS, WHY THEY ARE MATERIAL, AND WHY ALL SHOULD BE INSTITUTED

As the Board has recognized, "there may be circumstances in which more than one petition may be necessary." *See* PTAB Consolidated TPG at 59-60. This is such a circumstance. Due to the nature of the subject matter in the challenged claims (claims 9-12) of the '862 patent, *Roh*, which is a non-patent literature (NPL) reference, is among the most relevant references regarding patentability of the challenged claims. Thus, Petition 1 includes grounds relying on *Roh* as a primary reference. As explained in Petition 1, *Roh* faces printed publication issues that may be raised by Patent Owner. Such printed publication issues are not relevant to *Maltsev* (a U.S. patent), which is the primary reference in both grounds of Petition 2. Petitioner should be allowed to proceed with the separate grounds and arguments relating to *Roh* and also those relating to *Maltsev*.

While Petition 1 also includes grounds relying on *Lin*, which is also a U.S. patent, *Lin* discloses the claimed features in a different way than that of *Maltsev*.

For example, as explained in Petition 1, *Lin* discloses the claimed "decompose" feature recited in claim 9, whereas Petition 2 demonstrates how this feature is obvious based on the disclosures of *Sadrabadi*. Petition 1 also presents evidence showing how *Roh* discloses the "decompose" feature recited in claim 9. Consequently, Petitioner's arguments in Petition 2 are materially different in a substantive sense (e.g., regarding mapping prior art to claim limitations, and obviousness arguments) compared to Petition 1. Moreover, *Sadrabadi* is an NPL reference, so it (like *Roh*) faces printed publication issues that may be raised by Patent Owner, as explained in Petition 2.

Thus, the two petitions present different evidence to address the claims in different ways, and thus are very different from one another, and the differences between them are material.

Moreover, due to the nature of the challenged claims, including the length of challenged independent claim 9, and the relevant prior art available, Petitioner had to separate the grounds into separate petitions in order to ensure the grounds contained the necessary specificity as to how the prior art meets the claim limitations while meeting the word limit applicable to IPR petitions. Given that it is Petitioner's burden to establish unpatentability of the challenged claims, the level of detail included in the petitions is appropriate, and the Board should not penalize Petitioner for doing so by exercising its discretion under § 314 to deny

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