

U.S. Patent No. 8,749,251
Reasons for and Rankings of Parallel *Inter Partes* Review Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC.,
SONY CORPORATION; AND
SONY MOBILE COMMUNICATIONS INC.
Petitioners

v.

NEODRON LTD.
Patent Owner.

**PETITIONERS' REASONS FOR AND RANKING OF PARALLEL
PETITIONS FOR REVIEW OF U.S. PATENT NO. 8,749,251**

Explanation of Material Differences in *Inter Partes* Review Petitions

Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., Sony Corporation, and Sony Mobile Communications Inc. (collectively, “Petitioners”) filed two petitions for inter partes review (“IPR”) of U.S. Patent No. 8,749,251 (“the ’251 Patent”) (Ex-1001), assigned to Neodron Ltd. (“Patent Owner”). The two petitions concern different, non-overlapping claims and cite different primary prior art references. The “Krah” petition—challenging claims 1-3, 7-12, and 16-18—includes four grounds, all relying upon U.S. Patent Pub. No. 2008/0162996 A1 (“Krah”) (Ex-1005). The “Mese” petition—challenging claims 6 and 15—includes two grounds, each relying upon U.S. Patent No. 5,396,443 (“Mese”) (Ex-1005) and Korean Laid-Open Publication No. 10-2005-0045541 (“Oh”) (Ex-1006). The multiple grounds are necessary because of the nature of the ’251 Patent’s claim set and Patent Owner’s infringement contentions in the co-pending ITC and district court litigations, in which Patent Owner asserts the ’251 Patent against Petitioners. Given these unusual circumstances and the resultant impracticality of including all of the Krah and Mese grounds in a single proceeding, Petitioners respectfully request institution of both petitions against the ’251 Patent. Each involves the same claim construction issue and a related secondary reference (“Chaudhri,” Ex-1007), thus reducing the burden on the Board. Samsung and Sony likewise collaborated rather than filing individual petitions—further reducing the burden on the Board.

I. REASONS TO INSTITUTE BOTH PETITIONS

The Patent Trial and Appeal Board’s November 2019 Consolidated Trial Practice Guide (“TPG”) acknowledges that multiple petitions may “be necessary...when the patent owner has asserted a large number of claims in litigation.” TPG at 59. Here, Patent Owner has asserted claims of the ’251 Patent against Petitioners in both *In the Matter of Certain Capacitive Touch-Controlled Mobile Devices, Computer, and Components Thereof*, Investigation No. 337-TA-1193 (U.S. International Trade Commission) (the “1193 ITC Investigation”) as well as *Neodron Ltd. v. Samsung Electronics Co., Ltd. et al* (W.D. Tex. 20-cv-00121) and *Neodron Ltd. v. Sony Corporation* (W.D. Tex. 20-cv-00122) (“the District Court Matters”), which have been stayed pending the 1193 ITC Investigation. While Patent Owner is only asserting claims 2, 3, 17, and 18 against Petitioners at the ITC (Ex. 1015), Patent Owner asserts **claims 1-20** against Petitioners in the District Court Matters. Ex-1035, ¶ 30; Ex-1036, ¶ 21. That large number of asserted claims justifies multiple petitions. *E.g., Apple Inc. v. Seven Networks, LLC*, IPR2020-00157, Paper 10 at 25 (PTAB June 15, 2020) (instituting review and noting that “initial infringement contentions asserting twenty claims...helps to justify two petitions with mutually exclusive challenged claims”).

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Here, as in IPR2020-00157 and numerous other proceedings in which the Board has instituted multiple petitions filed by the same petitioners, the two petitions being filed by Petitioners concern *mutually exclusive* challenged claims. *E.g., id.* at 28 (“[B]ased on the facts and circumstances, the record justifies two petitions that assert mutually exclusive dependent claims...”); *Google LLC v. Hammond Dev. Int’l, Inc.*, IPR2020-00413, Paper 16 at 42 (PTAB July 14, 2020) (“We determine that the fact that Petitioner’s Petition in [previously instituted] IPR2020-00306 is not directed to the same claims that Petitioner challenges in this proceeding weighs in favor of declining to exercise our discretion to deny institution here.”); *Apple v. UUSI d/b/a Nartron*, IPR2019-00358, Paper 12 at 19-20 (PTAB Aug. 5, 2019) (instituting two petitions concerning nonoverlapping claims); *Intel v. Qualcomm*, IPR2018-01261, Paper 8 at 16-18 (Jan. 15, 2019) (instituting five petitions “challeng[ing] non-overlapping subsets of the claims of the ’490 patent.”).

In other words, *none* of the claims addressed in the Krah petition are addressed in the Mese petition. If the Board “discretionarily dismissed one petition or the other, some claims of the [’251] patent would be left uncovered by any ground alleged by Petitioner[s].” *Marvell Semiconductor, Inc. v. Uniloc 2017 LLC*, IPR2019-01349, Paper 9 at 14 (PTAB Feb. 4, 2020) (instituting review).

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Two petitions are necessary to address the large number of challenged claims given the relevant claim limitations (which at times dictate different primary references—Krah versus Mese and Oh) and a claim construction question concerning the phrase “key touch on the touchscreen.” Patent Owner has advanced one interpretation of this phrase. Petitioners propose an “alternative claim construction[] and present[] at least one ground of unpatentability for each construction.” *10X Genomics, Inc. v. Bio-Rad Labs., Inc.*, IPR2020-00086, Paper 8 at 22 (PTAB Apr. 27, 2020) (instituting review). But this explanation, and the corresponding additional grounds, consume space. The narrower of the two identified claim constructions requires a secondary reference (Chaudhri, Ex-1007), which overlaps between the two petitions, but consumes additional space.

This claim construction and prior art overlap would reduce the burden on the Board in instituting review on both petitions. *Apple*, IPR2020-00157, Paper 10 at 17-18 n.11 (“Because the two IPR proceedings involve non-overlapping claim challenges with overlapping art and claim construction issues, as discussed further below, a minimal loss in efficiency occurs, and a gain in integrity of the patent system occurs, in instituting both trials.”); *Solaredge Techs. Ltd. v. SMA Solar Tech. AG*, IPR2019-1224, Paper 10 at 12 (PTAB Jan. 23, 2020) (instituting review, citing the “overlap in prior art and [claim construction] issues”).

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