

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., and APPLE INC.,
Petitioner,

v.

NEONODE SMARTPHONE LLC,
Patent Owner.

IPR2021-00144 (Patent 8,095,879 B2)
IPR2021-00145 (Patent 8,812,993 B2)¹

Before MICHELLE N. ANKENBRAND, KARA L. SZPONDOWSKI, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

ANKENBRAND, *Administrative Patent Judge*.

ORDER

Authorizing Petitioner to File Documents, Supplemental Brief
Extending Due Date, Word Count for Patent Owner's Preliminary Response
37 C.F.R. § 42.5

¹ This Order addresses issues that are the same in each of the above-identified proceedings. We issue one Order for entry in each proceeding. The parties may not use this style caption without our permission.

IPR2021-00144 (Patent 8,095,879 B2)

IPR2021-00145 (Patent 8,812,993 B2)

I. INTRODUCTION

On March 4, 2021, Petitioner sent an email to the Board requesting a five-page brief to explain how certain developments in co-pending litigations related to these proceedings may impact our analysis of the petitions under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). Ex. 3001, 1–2. Petitioner also requested leave to file four documents as exhibits in each proceeding: (1) Amended Agreed Scheduling Order, filed November 13, 2020, in *Neonode Smartphone LLC v. Apple Inc.*, 6:20-cv-00505 (W.D. Tex.) (“the Apple litigation”); (2) Order Staying Case Pending Completion of Venue Discovery, issued December 8, 2020, in the Apple litigation; (3) Text Order Granting Motion to Stay Case, issued December 11, 2020, in *Neonode Smartphone LLC v. Samsung Elecs. Co.*, 6:20-cv-00507 (W.D. Tex.); and (4) Plaintiff Neonode Smartphone LLC’s Unopposed Motion to Extend Venue Discovery Deadlines, filed February 16, 2021, in the Apple litigation. *Id.*

Petitioner represented in the email that Patent Owner did not oppose the request “under the following conditions”: (1) Petitioner’s five-page brief should be filed before Patent Owner’s Preliminary Response; (2) Patent Owner should receive an extension of the Preliminary Response due date to one week after Petitioner files its supplemental brief; and (3) Patent Owner should receive an extra 1,200 words for the Preliminary Response in view of Petitioner’s additional brief. *Id.* at 2. Petitioner was agreeable to the conditions, and explained that it would be ready to file its five-page brief no later than March 10, 2021. *Id.*

IPR2021-00144 (Patent 8,095,879 B2)
IPR2021-00145 (Patent 8,812,993 B2)

We did not hold a telephone conference, but instead responded to the parties via email explaining that the documents Petitioner requested to file and the briefing Petitioner requested “may be useful to the Board.” *Id.* at 1. As such, we authorized Petitioner to file the documents and a five-page brief as outlined in Petitioner’s email no later than March 10, 2021, extended the due date of the Preliminary Response, and authorized an additional 1,200 words for the Preliminary Response. *Id.* This Order memorializes the response we previously provided to the parties.

II. ORDER

Accordingly, it is

ORDERED that Petitioner is authorized to file in each proceeding the four documents described above as exhibits;

FURTHER ORDERED that Petitioner is authorized to file in each proceeding a supplemental brief discussing developments in co-pending litigations and how those may affect the *Fintiv* analysis;²

FURTHER ORDERED that Patent Owner’s Preliminary Response due date in each proceeding is extended to March 17, 2021; and

FURTHER ORDERED that the word limit for Patent Owner’s Preliminary Response in each proceeding is extended by 1,200 words to 15,200 words.

² Petitioner filed the documents and the supplemental brief on March 10, 2021. IPR2021-00144, IPR2021-00145, Paper 18; Exs. 1043–1046.

IPR2021-00144 (Patent 8,095,879 B2)

IPR2021-00145 (Patent 8,812,993 B2)

For PETITIONER:

Walter Renner

David Holt

FISH & RICHARDSON P.C.

axf-ptab@fr.com

holt2@fr.com

Tiffany Miller

James Heintz

DLA PIPER LLP

tiffany.miller@dlapiper.com

jim.heintz@dlapiper.com

For PATENT OWNER:

Robert Asher

Bruce Sunstein

Wendy Demoracski

SUNSTEIN LLP

rasher@sunsteinlaw.com

bsunstein@sunsteinlaw.com

wdemoracski@sunsteinlaw.com