

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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SAMSUNG ELECTRONICS CO. LTD., SAMSUNG ELECTRONICS

AMERICA, INC. AND APPLE, INC.,

Petitioners

v.

NEONODE SMARTPHONE LLC,

Patent Owner

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Case IPR2021-00145

U.S. Patent No. 8,095,993

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**PATENT OWNER'S OPPOSITION TO SAMSUNG-PETITIONERS'  
MOTION TO EXPUNGE**

## I. ARGUMENT

The Board filed a Final Written Decision (“FWD”) in this proceeding on June 15, 2022, finding all challenged claims of U.S. Patent No. 8,812,993 (“the ‘993 patent”) unpatentable. The deadline for Patent Owner to appeal to the Federal Circuit from the Board’s FWD is August 17, 2022. Patent Owner intends to file a Notice of Appeal, in conformity with 35 U.S.C. §§ 141-42, 319, and 37 C.F.R. § 90.1, et seq, on or before that date. Accordingly, Patent Owner opposes Samsung’s Motion to Expunge, in order to preserve the record for appeal.

The documents that Samsung seeks to expunge constitute material evidence in support of Patent Owner’s argument that objective factors of non-obviousness demonstrate the patentability of the challenged claims. Patent Owner argued that Exhibit 2025, a Research & Development and License Agreement between Neonode Sweden AB (a predecessor in interest to the ‘993 Patent) and Samsung, pursuant to which the application to which the ‘993 Patent claims priority was specifically licensed to Samsung (“the Samsung Agreement”), constitutes highly probative evidence of industry respect for the ‘993 Patent. Paper 29, pp. 66-67; Paper 55, pp. 26-27. Samsung seeks to expunge Exhibit 2025 in its entirety. In addition, Samsung seeks to expunge (i) the non-public version of a declaration submitted as an exhibit to Patent Owner’s Response, (ii) the non-public version of

Patent Owner's Response, and (iii) the non-public version of Patent Owner's Sur-reply, all of which contain information concerning the Samsung license that has been redacted from the public versions of those documents. This information, including the royalty rate that Samsung agreed to pay, is also probative of Patent Owner's argument that objective evidence demonstrates that the claims were not obvious.

In its FWD, issued June 15, 2022, the Board rejected Patent Owner's argument that the existence and terms of the Samsung Agreement demonstrated industry respect for the claims of the '993 Patent, finding that Patent Owner had not "produced evidence showing a nexus between the evidence of industry respect or licensing and the features of the challenged claims." Paper 68, pp. 49-50.

The documents that Samsung seeks to expunge contain information that is relevant to Patent Owner's argument, which it intends to assert on appeal, that the Board's determination concerning Patent Owner's secondary considerations argument is not supported by substantial evidence. Accordingly, the Board should deny Samsung's Motion to Expunge without prejudice to refile at an appropriate time, in order to preserve the record for appeal.

In *Apple Inc. v. Uniloc 2017 LLC*, IPR2019-01667, 2021 WL 1700859 (P.T.A.B. Apr. 29, 2021), Petitioner filed a motion to expunge, which the patent

owner opposed in order to keep the record intact pending any appeal. The Board denied the motion without prejudice to refile after final disposition of all appeals, and entered an order maintaining the pertinent records under seal until, e.g., twenty business days after final disposition of all appeals. Patent Owner would not oppose entry of a similar order in this proceeding.

Dated: August 15, 2022

Respectfully submitted,

/Robert M. Asher, #30,445/

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**CERTIFICATION OF COMPLIANCE**

Pursuant to 37 C.F.R. § 42.24(d), it is certified that this document contains 494 words, excluding those portions identified in 37 C.F.R. § 42.24(a)(1), as measured by the word-processing system used to prepare this Response.

Dated: August 15, 2022

Respectfully submitted,

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