

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

NANOCO TECHNOLOGIES LTD.,
Patent Owner

U.S. PATENT NO. 8,524,365

Case No. IPR2021-00186

PETITIONER'S REQUEST FOR ORAL HEARING

IPR2021-00186: Petitioner's Request for Oral Hearing

Pursuant to 37 C.F.R. § 42.70(a), Petitioners Samsung Electronics Co, Ltd. and Samsung Electronics America, Inc. (collectively, "Petitioner") respectfully request oral argument. The oral argument is presently scheduled for February 23, 2022. Paper 18. The issues to be argued with respect to IPR2021-00186 include the following:

- (i) Whether claims 1, 7-12, 17, and 22-23 of U.S. Patent No. 8,524,365 are anticipated by Banin;
- (ii) Whether claims 1, 7-12, 15-17, and 22-23 of U.S. Patent No. 8,524,365 are rendered obvious by Banin;
- (iii) Whether claims 2-6 and 18-21 of U.S. Patent No. 8,524,365 are rendered obvious by the combination of Banin and Herron;
- (iv) Whether claims 13 and 14 of U.S. Patent No. 8,524,365 are rendered obvious by the combination of Banin and Treadway;
- (v) Whether claims 1-9 and 17-23 of U.S. Patent No. 8,524,365 are rendered obvious by the combination of Zaban, Farneth, and Yu;
- (vi) Whether claims 1-2, 4, 7-12, 17-18, and 22-23 of U.S. Patent No. 8,524,365 are rendered obvious by the combination of Lucey and Ahrenkiel;
- (vii) Whether claims 13-16 of U.S. Patent No. 8,524,365 are rendered obvious by the combination of Lucey, Ahrenkiel, and Treadway;
- (viii) Procedural and evidentiary issues raised, e.g., in Motions to Strike or Exclude;
- (ix) Any additional issues on which the Board seeks information or clarification.

Petitioner requests that the argument in this proceeding be consolidated with and heard at the same time as the arguments in three other proceedings involving the

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same parties currently scheduled for the same day: IPR2021-00183, -00184, and -00185. The patents at issue in these four proceedings relate to similar technology, preparing nanoparticles, and three of the four patents are in the same family. Petitioner's challenges to the validity of these patents is also based on the same prior art and similar grounds in each of IPR2021-00183, -00184, -00185, and -00186, and Patent Owner's arguments in response to Petitioner's challenges are similar in each proceeding. A consolidated hearing in these proceedings would minimize repetitive argument and lead to an efficient presentation of the evidence and argument. Due to the number of challenged claims and grounds in each proceeding, and the number of issues Patent Owner raises in response, Petitioner requests that each party be allowed a total of ninety (90) minutes for its arguments in that consolidated proceeding, with the opportunity to reserve a portion of that time for rebuttal. Petitioner conferred with Patent Owner prior to filing this request, and while the parties are in agreement regarding consolidating argument on IPR2021-00183, -00184, -00185, and -00186, the parties could not reach agreement regarding the time for the consolidated argument.

Petitioner also requests that the consolidated hearing for IPR2021-00183, -00184, -00185, and -00186 be combined with the hearing for IPR2021-00182, which involves the same parties and has been scheduled for the same day. Petitioner conferred with Patent Owner, and the parties are in agreement that argument for

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IPR2021-00182 should be combined with the consolidated hearing on IPR2021-00183, -00184, -00185, and -00186, and that the parties should each have thirty (30) minutes per side for argument regarding IPR2021-00182.

In total, Petitioner requests a total of one hundred and twenty (120) minutes per side for argument in the five proceedings involving the same parties scheduled for the same day, with each side allocated thirty (30) minutes of the argument time for IPR2021-00182 and ninety (90) minutes of the argument time for the consolidated hearing on proceedings IPR2021-00183, -00184, -00185, and -00186.

Petitioner requests the services of a court reporter to transcribe the proceeding, with one transcript for the combined argument on IPR2021-00182, -00183, -00184, -00185, and -00186. Petitioner understands that the oral hearing will be remote, but if not, Petitioner requests the use of audio-visual equipment to assist its arguments and to display its demonstrative exhibits, including a computer-connectable projector, an ELMO, and a screen.

Dated: January 6, 2022

Respectfully submitted,

/s/ F. Christopher Mizzo, P.C.

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