

Paper No. ____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.

Petitioner

v.

MEMORYWEB, LLC

Patent Owner

Patent No. 10,621,228

Inter Partes Review No. IPR2022-00222

PATENT OWNER'S PRELIMINARY SUR-REPLY

The Board authorized MemoryWeb to file this five-page response to Samsung's Reply. Ex. 1038. For the reasons set forth in the Preliminary Response and set forth below, institution should be denied.

I. The *General Plastic* Factors Favor Denial

Samsung continues to argue that it is unrelated to Unified Patents and that Unified is an "independent party." But, Samsung does not deny that it is a member of Unified Patents. Samsung also does not deny that it should have been named an RPI in the Unified Petition. Gamesmanship by Unified to allow its own members to later file follow-on petitions should not be allowed because it is a deliberate attempt to waste the Board's resources.

Samsung does not deny the similarities between its petition and those of Unified and Apple or cumulativeness of the cited references and combination. Reply, 2. It also does not deny that it used the Apple or Unified petitions as roadmaps in preparing its own petition. *Id.* Instead, Samsung argues that it delayed filing the petition because it was waiting for MemoryWeb's identification of asserted claims. Reply, 3. MemoryWeb first identified the asserted claims on September 17, 2021. Samsung's Petition was filed on December 3, 2021. Samsung offers no justification for the eleven-week delay in filing this Petition after it received the identification of the asserted claims. The delay is significant considering the substantial overlap between Samsung's petition and the Unified and Apple petitions.

LG Electronics v. Bell Northern Research, LLC, IPR2020-00319, Paper 15, p. 12 (factor weighed slightly in favor of invoking discretion to deny institution where Petitioner waited for identification of asserted claims to file petition).

As outlined in the POPR, the finite resources of the Board would be challenged because Samsung proposes the schedule for this IPR be the same as the Unified IPR. The Patent Owner Response in the Unified IPR is due on June 6, which is before the Board's deadline to determine whether to institute this IPR. In order to not prejudice MemoryWeb, the schedule of the Unified IPR would have to be delayed by months in order for the schedules of the Unified IPR and this proceeding to be consolidated. This delay would impact the Board's ability to issue a final decision within one year as required by 35 U.S.C. § 316(a)(11) in the Unified IPR.

Notably, Samsung does not address the cumulateness of its petition to the other petitions or the issues with consolidating the schedules of the IPRs addressed in the POPR. POPR, 38.

In sum, the *General Plastic* factors collectively weigh in favor of the Board exercising its discretion to deny institution based on the Unified and Apple IPRs.

II. The *Fintiv* Factors Favor Denial

Samsung does not deny that it has not requested a stay. Samsung also does not address whether it will not request a stay in the district court case – a tacit

admission that it will not file one. Samsung also does deny that any potential request for a stay would be unlikely.

There is no indication that the pending motion to transfer will be granted or that it will have any impact on the trial date. As explained in the POPR, the trial date is scheduled during the same month as the anticipated final written decision for this IPR. Accordingly, the second factor is neutral.

Samsung does not address the third factor in the reply, which favors denial for the reasons set forth in the Preliminary Response

Samsung's arguments regarding the fourth factor are misleading. The only ground relating to Okamura in Samsung's invalidity contentions is the Belitz and Okamura combination. Ex. 2014, p. 30 (B-1). Samsung, however, presents eleven additional grounds for invalidity in its invalidity contentions which are not covered by the stipulation. Ex. 2014, p. 30 (B-2 – B-12). Because the stipulation is not a broad stipulation (i.e., because it does not address at least grounds B-2 – B-12), it does not ensure that this *inter partes* review is a “true alternative” to the district court proceeding. *See Sotera*, IPR2020-01019, Paper 12 at 19.

Samsung offers no basis for the fifth factor being neutral. Instead, as set forth in the Preliminary Response, the fifth factor favors denial because Samsung did not sufficiently justify its delay in filing its Petition – a Petition that it admits is similar to the previously filed petitions. *Fintiv*, Paper 11 at 13-14; Petition, 90; Reply, 2

(“it is not surprising that similar arguments may arise when mapping excellent prior art (e.g., Okamura for Samsung and A3UM [*sic*] for Apple) to identical claim limitations”); Reply, 5.

With respect to the sixth factor, Samsung concedes the Okamura-Belitz ground it advances is different than the Okamura-Flora ground advanced by Unified. Reply, p. 5. Notably, Samsung’s petition differs from Unified’s petition in a key way: the only argument that Samsung presents about the “second name” (limitation [1k]) in the claimed people view is deficient because Samsung does not offer any evidence that Okamura discloses or that it would be obvious to modify Okamura to show both the first name adjacent the first image and second name adjacent to the second image. POPR, 49-50. The Unified IPR, on the other hand, offered an obviousness theory based on Okamura alone and an obviousness theory based on Okamura in combination with Flora and Gilley. Unified Petition, 60-61 (Okamura alone), 93-94 (Okamura in combination with Gilley). This key difference supports denial under the sixth *Fintiv* factor because the Board’s resources should not be wasted on theories that are deficient.

In sum, **all six *Fintiv* factors** are neutral or weigh in favor of denying institution. In these circumstances, efficiency and the integrity of the system are best served by denying institution. *Fintiv*, Paper 11 at 6.

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