

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

PRISUA ENGINEERING CORP.,
Patent Owner.

IPR2017-01188
Patent 8,650,591 B2

Before BARBARA A. PARVIS, STACEY G. WHITE, and
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding on Remand
37 C.F.R. § 42.5

This case is before us on remand from the Federal Circuit. *Samsung Elecs. Am., Inc. v. Prisia Eng’r Corp.*, 948 F.3d 1342, 1354 (Fed. Cir. 2020). A conference call was held on May 13, 2020 to discuss procedures on remand. We listened to proposals from both parties.

Petitioner requests briefing on one topic—whether estoppel or law of the case doctrine applies with respect to Petitioner’s ground that claim 1 would have been obvious over Sitrick because claim 1 is the same as claim 11, except claim 1 recites one additional limitation. Petitioner requests ten (10) pages and three (3) weeks for its brief and agrees to Patent Owner having the same for its response. Patent Owner opposes Petitioner’s request on the basis that the aforementioned doctrines do not apply in this case.

Patent Owner requests authorization to file a motion to terminate the proceeding under two theories: (1) *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (Decision Denying Institution of Inter Partes Review) (“*NHK*”) applies because the trial in the instant proceeding is over and validity was already considered; and (2) we cannot construe claim 1 due to *IPXL*-type¹ indefiniteness, which has not been disputed by either party. Patent Owner also asserts if briefing pointing to arguments and evidence already in the record would be helpful to the panel, Petitioner should file first and Patent Owner would like a responsive brief. Patent Owner asks for the default rules to apply regarding page length and timing.

Petitioner opposes Patent Owner’s motion to terminate on the basis that the efficiency considerations Patent Owner relies on do not apply at this

¹ *IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005) (“*IPXL*”).

late, post-remand juncture in the proceeding. Petitioner also indicated it does not seek a brief pointing to arguments and evidence already in the record.

We determine that it would be helpful to the panel to have briefing on whether estoppel or law of the case doctrine applies and whether a motion to terminate is appropriate. The parties' opposing arguments may be raised in responsive briefs. We, therefore, grant the parties' requests to brief their proposed topics. Specifically, Petitioner is authorized to file a ten (10) page brief regarding whether estoppel or law of the case doctrine applies with respect to Petitioner's ground that claim 1 would have been obvious over Sitrick and Patent Owner is authorized to file a response of the same length. Also, Patent Owner is authorized to file its motion to terminate the proceeding under both theories limited to fifteen (15) pages, and Petitioner is authorized to file an opposition of the same length. The parties are given three (3) weeks from the date of entry of this order to file each authorized opening paper and three (3) weeks from receipt of the opening paper to file the response or opposition.

The panel has determined that the record is sufficiently clear and further briefing pointing to past briefing would not be particularly useful. Accordingly, no further briefing is authorized at this time.

For the foregoing reasons, it is

ORDERED that Petitioner is authorized to file a brief regarding whether estoppel or law of the case doctrine applies with respect to Petitioner's ground that claim 1 would have been obvious over Sitrick limited to ten (10) pages and due three (3) weeks from the date of entry of this order;

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FURTHER ORDERED that Patent Owner is authorized to file a responsive brief limited to responding to arguments in Petitioner's brief and also limited to ten (10) pages and due three (3) weeks from the date of filing of Petitioner's brief;

FURTHER ORDERED that Patent Owner is authorized to file a Motion to Terminate the instant proceeding limited to fifteen (15) pages and due three (3) weeks from the date of entry of this order; and

FURTHER ORDERED that Petitioner is authorized to file a responsive brief limited to responding to arguments in Patent Owner's Motion and also limited to fifteen (15) pages and due three (3) weeks from the date of filing of Patent Owner's Motion; and

FURTHER ORDERED that no reply, sur-reply, or other briefing is authorized at this time and no new evidence may be introduced.

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