

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUAWEI TECHNOLOGIES CO., LTD.,
Petitioner,

v.

SAMSUNG ELECTRONICS CO., LTD.,
Patent Owner.

Case IPR2017-01979
Patent 8,761,130 B2

Before JAMESON LEE, PATRICK M. BOUCHER, and
KAMRAN JIVANI, *Administrative Patent Judges*.

JIVANI, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5(a) and 37 C.F.R. § 42.108(c)

This Order summarizes a conference call held between the Board and counsel for the parties on January 18, 2018. A transcript of the conference call appears in the record as Exhibit 1051.

Background

Petitioner Huawei Technologies seeks *inter partes* review of claims 9–16 (the “Challenged Claims”) of U.S. Patent No. 8,761,130 B2 (the “’130 patent”). Paper 1. Patent Owner Samsung Electronics has filed a Preliminary Response. Paper 7. We have not yet entered a decision on whether to institute the requested *inter partes* review.

On January 12, 2018, Petitioner emailed the Board to request permission to file a reply to the Preliminary Response. Petitioner stated in its email that the proposed reply would address Patent Owner’s interpretation and application of the term “symbol,” which appears in each of the Challenged Claims.¹ Petitioner’s email indicated that Patent Owner opposes the request for a reply.

During the conference, Petitioner argued that good cause for a reply exists because Patent Owner’s application of the term “symbol” in this proceeding conflicts with positions taken by Patent Owner in litigation involving the ’130 patent. *E.g.*, Ex. 1051 at 43:1–9. We denied Petitioner’s request on the conference call. *Id.* at 67:1–3. Reasons for the denial are set forth below.

¹ Petitioner’s email also sought leave to reply to Patent Owner’s interpretation and application of the claim term “sub-frame;” however, counsel for Petitioner withdrew this request during the conference. Ex. 1051.

Analysis

The rules applicable to *inter partes* review do not, as of right, provide an opportunity for a petitioner to file a reply to a preliminary response. *See* 37 C.F.R. § 42.108(c). However, a petitioner “may seek leave to file a reply,” and “[a]ny such request must make a showing of good cause.” *Id.*

According to Petitioner, Patent Owner’s argument in its Preliminary Response on the claim term “symbol” amounts to an assertion that the claimed symbol must be afforded the same meaning that the prior art reference Cho affords that term. Ex. 1051 at 44:12–18. More specifically, Petitioner summarizes Patent Owner argument as asserting that Cho’s symbol block cannot meet the claimed “symbol” because Cho describes its block as containing constituent symbols. *Id.* at 47:22–48:4. Petitioner contends that such an interpretation of the claimed symbol is narrower than positions taken by Patent Owner in infringement contentions in related district court litigation. *Id.* at 44:19–45:6. According to Petitioner, the alleged breadth of Patent Owner’s infringement contentions is inconsistent with Patent Owner’s position in this proceeding that Cho’s symbol block does not meet the claimed symbol. *Id.* at 46:6–13.

We are not persuaded that the alleged inconsistency constitutes good cause justifying the filing of a reply brief. There is no requirement that the positions taken by a party in an *inter partes* review must identically match the positions taken by that party in related litigation. Moreover, we interpret claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear—a standard different from the claim construction standard applied in district court litigation. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136

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S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard in *inter partes* reviews). Accordingly we are not persuaded on this record that the inconsistency alleged by Petitioner warrants a reply.

For the reasons set forth above, it is:

ORDERED that Petitioner’s request for authorization to file a motion for permission to file a reply brief is *denied*.

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