

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

KANNUU PTY LTD.,
Patent Owner.

IPR2020-00736 (Patent 9,697,264 B2)
IPR2020-00737 (Patent 9,436,354 B2)
IPR2020-00738 (Patent 8,370,393 B2)
IPR2020-00739 (Patent 8,996,579 B2)
IPR2020-00740 (Patent 8,676,852 B2)

Before KRISTEN L. DROESCH, MINN CHUNG, and
JESSICA C. KAISER, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

ORDER¹

Granting Patent Owner's Request for Submission of
Corrected Preliminary Response
Granting Petitioner's Request for Additional Briefing
37 C.F.R. §§ 42.5, 42.108(c)

¹ We issue one Order to be filed in each case. The parties are not authorized to use a multi-case caption.

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I. DISCUSSION

A conference call was held on July 10, 2020, among respective counsel for Petitioner and Patent Owner and Judges Droesch, Kaiser, and Chung, in response to Petitioner's request, in each of the above-identified proceedings, to strike Patent Owner's Preliminary Response for exceeding the word count limit and Patent Owner's request for submitting a Corrected Preliminary Response to comply with the word limit. Petitioner also requested authorization under 37 C.F.R. § 42.108(c) to file a reply to Patent Owner's Preliminary Response in each of these proceedings. This Order memorializes the rulings made on the call.

During the conference call, Petitioner argued that Patent Owner's Preliminary Response in each of these proceedings should be struck in its entirety because the overages are egregious and appear to have been calculated to avoid the word limit under 37 C.F.R. § 42.24(b)(1). As an example of Patent Owner's alleged egregious violation of our rules, Petitioner asserted that in each Preliminary Response, Patent Owner placed nearly all citations in footnotes and failed to count the words in the footnotes, which amounted to thousands of words. As an alternative remedy, Petitioner requested that the Board require Patent Owner's Preliminary Responses be made compliant by deleting words only and without any other modifications.

Patent Owner responded that the overages were unintentional and were due to inadvertent failure to count the words in the footnotes. Similar to Petitioner's alternative remedy, Patent Owner requested authorization to file a motion to correct its preliminary responses to comply with the word

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limit.

Having considered the parties positions, during the conference call, we authorized Patent Owner to file, within three business days, a Corrected Preliminary Response in each of these proceedings that complies with the word count limit specified in 37 C.F.R. § 42.24(b)(1) by deleting words only. No other modification is permitted except for revisions to the table of contents and the table of authorities to be consistent with the deletions. In addition, Patent Owner's lead counsel is required to submit an affidavit certifying the total number of words, including the words in the footnotes and pictures, in each Corrected Preliminary Response. Patent Owner is also required to submit, in each proceeding, a redlined version of the Corrected Preliminary Response, comparing the Corrected Preliminary Response with the previously filed Preliminary Response.

Turning to the next issue, during the conference call, Petitioner requested authorization to file a 10-page reply in each proceeding to address the contractual estoppel issue and alleged secondary considerations evidence issue presented in Patent Owner's Preliminary Response. Patent Owner argued that there is no good cause because Petitioner knew or should have known that under the forum selection clause of the non-disclosure agreement (NDA) between the parties, Petitioner is estopped from requesting *inter partes* review, and because Petitioner failed to address known evidence of secondary considerations in the Petition.

Having considered the parties positions, during the conference call, we authorized Petitioner to file, in each of these proceedings, a reply to Patent Owner's Corrected Preliminary Response, not to exceed 8 pages and

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limited to addressing the contractual estoppel issue presented in Patent Owner's Corrected Preliminary Response. We also authorized Patent Owner to file a sur-reply in each of these proceedings, not to exceed 8 pages and limited to responding to the assertions and arguments made in Petitioner's reply in the same proceeding. The parties may not submit any new evidence with the reply or the sur-reply.

II. ORDER

It is hereby:

ORDERED that Patent Owner is authorized to file, no later than July 15, 2020, a Corrected Preliminary Response in each of these proceedings that complies with the word count limit specified in 37 C.F.R. § 42.24(b)(1) by deleting words only. No other modification is permitted except for revisions in the table of contents and the table of authorities to be consistent with the deletions.

FURTHER ORDERED that, with each Corrected Preliminary Response, Patent Owner's lead counsel is required to submit an affidavit certifying the total number of words, including the words in all of the footnotes and pictures, in the Corrected Preliminary Response;

FURTHER ORDERED that Patent Owner is required to submit, in each proceeding, a redlined version of the Corrected Preliminary Response, comparing the Corrected Preliminary Response with the previously filed Preliminary Response;

FURTHER ORDERED that Petitioner's request for authorization to file a reply to Patent Owner's Corrected Preliminary Response in each of these proceedings is *granted*;

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FURTHER ORDERED that Petitioner's reply is limited to addressing the contractual estoppel issue presented in Patent Owner's Corrected Preliminary Response;

FURTHER ORDERED that Petitioner's reply is not to exceed 8 pages and is to be filed no later than 1 week from the filing of Patent Owner's Corrected Preliminary Response;

FURTHER ORDERED that Patent Owner is authorized to file a sur-reply in each of these proceedings, limited to responding to the assertions and arguments made in Petitioner's reply in the same proceeding;

FURTHER ORDERED that Patent Owner's sur-reply is not to exceed 8 pages and is to be filed no later than 1 week from the filing of Petitioner's reply; and

FURTHER ORDERED that the parties may *not* submit new evidence.

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