

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

CELLECT, LLC,
Patent Owner.

IPR2020-00472, -00473, -00474, -00475, -00476, -00477, -00512;
IPR2020-00559, -00560, -00561, -00562, -00563, -00564, -00565;
IPR2020-00566, -00567, -00568, -00569, -00571, -00572

Before JAMESON LEE, PATRICK M. BOUCHER,
TERRENCE W. McMILLIN, GARTH D. BAER, JOHN R. KENNY,¹
Administrative Patent Judges.

PER CURIAM.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ These judges are assigned to three-judge panels for the above-identified IPRs.

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In several of the above-identified IPRs, Patent Owner argues, that under *NHK Spring Co. Ltd. v. Intri-Plex Techs., Inc.*, IPR 2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential), we should exercise our delegated discretion to deny institution due to the advanced stage of a related litigation (i.e., *Collect, LLC v. Samsung Electronics Co, D. Col.*, 1:19-cv-00438-CMA-MEH). '472 Prelim. Resp. 38–46.² According to Patent Owner, the pretrial conference in the related litigation is scheduled for August 17, 2020, and trial will likely start by early 2021. *Id.* at 41. Patent Owner further asserts that the parties and the district court are substantially invested in the litigation. *Id.* at 42–43. Although Patent Owner acknowledges that a motion to stay is pending in the litigation (D.I. 56), Patent Owner argues the pendency of that motion is at least a neutral factor (from Patent Owner's perspective) regarding the exercise of our discretion not to institute. *Id.* at 45–46. Further, Patent Owner contends that it “can assert claims in district court that are not and will not be subject to any IPR proceeding, significantly reducing the likelihood that institution of IPR on any of the challenged claims will simplify matters.” *Id.* at 40.

On May 5, 2020, the Board made precedential an order in *Apple v. Fintiv Inc.*, IPR2020-00019, Paper 11 (March 20, 2020), which identifies the factors to be considered when a patent owner raises an argument for discretionary denial of petition based on an earlier trial date in a parallel proceeding in another forum, under *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential,

² For simplicity, we cite the papers in IPR2020-00472. Also, for clarification, Patent Owner has not yet filed a Preliminary Response in some of the above-identified IPRs.

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designated May 7, 2019)). The order was made precedential after the filing of the petitions here. It is appropriate to provide Petitioner an opportunity to address *Apple v. Fintiv*, and we provide such an opportunity in a Reply, as set forth below.

The factors set forth in *Apple v. Fintiv*, however, are based on specific facts pertaining to each case. To ensure that we make an informed decision in that regard, a list of factual inquiries pertinent to these specific cases, are attached in Appendix A. It would be beneficial for the parties to address them, e.g., certain scheduling questions regarding the related litigation.

Within ten business days of the issuance of this Order, the parties shall file a joint submission in each above identified IPR responding to Questions 1–9 in the Appendix. Questions 1–5 probe certain facts relating to Factors 1, 2, and 3 of *Apple v. Fintiv*. Question 6 probes certain facts relating to Factors 1 and 6 of *Apple v. Fintiv*. Questions 7–9 probe certain facts relating to Factor 6 of *Apple v. Fintiv*.

The joint submission: (i) shall be no more than ten pages, (ii) shall present the parties' responses to Questions 1–9 in the Appendix, and (iii) shall indicate the parties' agreement or disagreement for each response. Further, for IPRs in which a Preliminary Response has been filed as of the filing of the joint submission, within fifteen business days from the issuance of this Order, Petitioner may file a Reply to the Preliminary Response for the limited purpose of addressing the above questions and addressing whether we should exercise discretion to decline institution of the above identified proceedings due to the schedule of the related litigation. For IPRs where the Preliminary Response has not been filed as of the filing of

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the joint submission, Petitioner may file its Reply within five business days of the filing of the Preliminary Response. The Reply shall be no more than seven pages. Within five business days of the filing of the Reply in each IPR, Patent Owner may file a Sur-Reply to the authorized Reply, addressing the above questions and responding to Petitioner’s Reply. The Sur-Reply shall be no more than seven pages.³

In the authorized Replies, Petitioner may address *Apple v. Fintiv*. In the authorized Sur-Replies, Patent Owner may also address *Apple v. Fintiv* irrespective of whether a Preliminary Response in any or all of the above-identified IPRs addressed the case. *See, e.g.*, ’472 Prelim. Resp. 40.

The parties are further instructed to notify the Board of any decision by the district court (i) regarding the pending stay motion or (ii) that significantly impacts the litigation schedule. The parties shall file such notice in each above-identified IPR within two business days of the issuance of the decision.⁴

The parties should, to the extent possible, provide factual, non-speculative information in their submissions. A decision regarding a discretionary denial should not rest on incomplete, inconsistent, or speculative information.

³ Separate orders have authorized additional briefing with respect to *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential).

⁴ The parties may use consolidated captions for the authorized submissions and notices. The parties, however, are not authorized to use consolidated captions for any other submissions or notices in the identified IPRs without prior Board authorization.

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It is:

ORDERED that, within ten business days of the issuance of this Order, the parties shall file, in each above-identified IPR, the joint submission specified above;

FURTHER ORDERED that, within the time period specified above, Petitioner may file, in each above-identified IPR, a Reply of no more than seven pages as specified above.

FURTHER ORDERED that, within five business days from the filing of the Reply, Patent Owner may file, in each above-identified IPR, a Sur-Reply, of no more than seven pages as specified above.

FURTHER ORDERED that, as specified above, the parties shall notify the Board of any decision by the district court (i) regarding the pending stay motion or (ii) that significantly affects the litigation schedule.

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Appendix A

- 1) Is it likely that the pretrial conference in the related litigation will occur on August 17, 2020? (Expert discovery appears to be scheduled to continue until October 2020). If not, what is the likely date for the pretrial conference?
- 2) Will the trial likely start by February 2021? If not, when will it likely start?
- 3) Has a claim construction hearing been scheduled in the litigation? When will it occur?
- 4) Is fact discovery scheduled to end this month? If not, when will it likely end?
- 5) Is expert discovery likely to conclude in October 2020? If not, when will it likely end?
- 6) Do the parties propose that we decide whether to exercise discretion under *NHK Spring* before the district court rules on the pending motion to stay? Have the parties informed (or will they inform) the district court of their position on this issue (i.e., that they are requesting that we wait or do not wait for such a decision)? Do the parties have an indication of when the district court may issue its decision on the pending motion to stay? And what do the parties request that we do if that decision does not issue by the end of this month?
- 7) If the district court denies the motion to stay as premature because no decisions on institution have issued in the above proceedings, how should that affect our exercise of discretion?
- 8) If the parties disagree regarding the likely date for the pretrial conference, start of trial, or any other date identified above, what have parties done to resolve that disagreement? Has either party sought clarification from the district court? If not, how do the parties propose that we resolve such disputes? and
- 9) Has Patent Owner asserted any claims in the litigation that Petitioner has not challenged in the above-identified IPRs? If so, what

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claims? How difficult or easy would it be to add additional claims?
Would merits decisions in the above-identified IPRs simplify issues
for trial in the litigation if additional claims are asserted? What
weight should be attributed to the possibility that additional claims
may be asserted in the litigation if there is no current attempt to do so?