

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NVIDIA CORP.,
Petitioner,

v.

SAMSUNG ELECTRONICS CO., LTD.,
Patent Owner.

Case IPR2015-01315
Patent 6,819,602 B2

Before JAMESON LEE, PATRICK R. SCANLON, and JUSTIN BUSCH,
Administrative Patent Judges.

SCANLON, *Administrative Patent Judge.*

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

A conference call in the above-captioned proceeding was held on October 22, 2015, including the panel and respective counsel for Petitioner and Patent Owner. Petitioner requested the call to seek guidance from the Board in light of the Federal Circuit's recent decision in *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 2015 WL 5166366 (Fed. Cir. Sept. 4, 2015).

During the call, Petitioner stated that, for a prior art patent reference to be entitled to the filing date of an earlier provisional application, *Dynamic Drinkware* adds a requirement of mapping the claims of the patent reference back to the provisional application. Petitioner contended that this additional requirement represents a change in the law and cited *In re Giacomini*, 612 F.3d 1380 (Fed. Cir. 2010), *Ex parte Yamaguchi*, 88 USPQ2d 1606 (BPAI 2008) (precedential), and *VMware, Inc. v. Clouding, Corp.*, Case IPR2014-01305 (PTAB Feb. 6, 2015) (Paper 13) in support of this contention. Petitioner further stated it relied on MPEP § 2136.03(III) and did not map the claims of the Lai patent (U.S. Patent No. 7,032,092 B2; Ex. 1003) to the Lai provisional application (U.S. Provisional Application No. 60/328,284; Ex. 1004) in its Petition.

Because of this alleged change in the law, Petitioner requested authorization to file a non-argumentative claim chart mapping the claims of the Lai patent to the Lai provisional application. Petitioner noted that, in another proceeding, the Board permitted a petitioner to submit briefing regarding the impact of *Dynamic Drinkware* and a claim chart showing where the related provisional application provides written description support for the claims of a patent reference. *See Cisco Systems, Inc., v.*

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Capella Photonics, Inc., Case IPR2014-01166 (PTAB Sept. 18, 2015)
(Paper 28).

Patent Owner disagreed with Petitioner's position and cited *Apple, Inc. v. OpenTV, Inc.*, Case IPR2015-00969 (PTAB Sept. 23, 2015) (Paper 8) as a case in which the Board determined it was necessary for the petitioner to show in the petition that a patent reference was entitled to the filing date of its corresponding provisional application. Patent Owner stated that it did not believe *Dynamic Drinkware* set forth a new requirement, citing *In re Wertheim*, 646 F.2d 527 (CCPA 1981).

Patent Owner also argued that, because it has already filed the Preliminary Response, allowing Petitioner to submit the requested claim chart would be tantamount to permitting Petitioner to file a reply to the Preliminary Response. Patent Owner asserted that such a reply would be improper because the statute requires the Board's decision to be based on the Petition. Patent Owner added that the requested claim chart would increase the size of the Petition beyond the 60-page limit and would be prejudicial to Patent Owner because a response to the claim chart would require additional time and resources.

After considering both parties' positions, we authorized Petitioner to file, within three business days, a claim chart showing where the Lai provisional application provides written description support for the claims of the Lai patent. The claim chart may not include any argument or explanatory text and shall not exceed five pages. We also authorized Patent Owner to file a 5-page response to Petitioner's claim chart within three business days from the date that Petitioner files its claim chart.

The Board's precedential decision in *Ex parte Yamaguchi* appears to at least give the impression that Petitioner need not account for support in an ancestral provisional application of a patent reference for any claimed subject matter in that reference. Accordingly, we deem it appropriate to afford Petitioner an opportunity to provide the claim chart it seeks to submit.

It is

ORDERED that Petitioner's request for authorization to file a non-argumentative claim chart is *granted* to the extent described above;

FURTHER ORDERED that Petitioner's claim chart shall not exceed 5 pages and must be filed within three business days; and

FURTHER ORDERED that Patent Owner is authorized to file a 5-page response to Petitioner's claim chart within three business days from the date that Petitioner files its claim chart.

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