

Parallel Petitions on The Same Challenged Patent Instituted Where One Petition Was Based on An Earlier Related Patent That Lacked Written Description Support For The Later Challenged Claims

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[Samsung Electronics Co., Ltd. v. Acorn Semi, LLC, IPR2020-01207, Paper 21 \(PTAB Feb. 10, 2021\);](#)

[Samsung Electronics Co., Ltd. v. Acorn Semi, LLC, IPR2020-01282, Paper 20 \(PTAB Feb. 10, 2021\)](#)

Before: McNamara, Kenny, Moore.

Samsung brought two petitions challenging the same patent. The challenged patent issued from a large family of related applications. In the 1207 petition, Samsung argued that although all of the specifications in the priority family disclosed a species within the genus recited in the challenged claims, the genus lacked written description support prior to an application filed on February 7, 2011. Yet because all of the specifications in the priority family disclose a species within the claimed genus, that meant another patent from the priority family that issued in 2007 was 102(b) prior art and would anticipate the challenged claims if they were not entitled to their earliest claimed priority date. In the 1282 petition, Samsung assumed the challenged patent was entitled to its earliest claimed priority date and asserted anticipation of the challenged claims by other prior art references that were unrelated to the family of the challenged patent. The Board instituted trial in both proceedings.

Regarding the priority date issue in the 1207 petition, the challenged claims recited a metal oxide interface layer in a semiconductor material through which a metal electrical contact is electrically connected. The priority specifications described an embodiment with a TiO_2 spacer layer. Although TiO_2 is a metal oxide, those specifications never provided the more general disclosure of an interface layer comprised of a “metal oxide.” In other words the specifications disclosed the species of an interface layer comprised of TiO_2 , but not the genus of an interface layer comprised of a generic metal oxide.

On the current record, the Board was persuaded that the species disclosure of a TiO_2 interface layer did not provide written description support for the genus of metal oxide interface layers. This was because the specification noted that TiO_2 has a “tunnel barrier” of less than 1eV, which made it suitable for use as a spacer layer, but evidence showed that this “tunnel barrier” property of TiO_2 is not characteristic of or representative of metal oxides as a class. In addition, another patent that was incorporated by reference into the priority specifications described metal oxides as insulators. That is, materials that current does not flow through, which is exactly opposite to the recited interface layer, which essentially recited current flowing through the interface layer. This evidence, combined with the fact that the specification contained no discussion of using metal oxide layers generally, convinced the PTAB

that the priority application prior to the February 2011 application lacked written description support for the genus claim. Once the Board found that the challenged genus claims were not entitled to a pre-2001 priority date for lack of an earlier written description, there was no dispute that the claims were anticipated by the species disclosure in the 2007 patent from the same family.

In addition to disputing Samsung's priority date challenge, Acorn also argued that the grounds in the 1207 petition were really a written description challenge in disguise and should be denied institution because the Board lacks statutory authority to consider invalidity for lack of written description. The Board quickly shot down this argument, citing prior proceedings based on similar challenges.

Acorn also argued that the petitions should be dismissed under the Board's discretionary authority. The Board disagreed.

Acorn argued for dismissal under *Fintiv* because the parallel district court trial was scheduled to occur only two months after the institution decision and well before the final written decision deadline. In addition, Samsung originally only offered a stipulation to not assert any instituted grounds in the district court trial. Acorn argued this was unfair because if only one petition were instituted, that would mean Samsung could assert the grounds from the non-instituted petition. After Acorn made this argument in its preliminary response, Samsung provided a reply brief that broadened the stipulation to cover all the grounds in both petitions. Samsung would go on to broaden this stipulation a third time after the *Sotera Wireless* decision was made precedential. In that final broadened stipulation, Samsung stipulated that it would not assert in the district court any grounds it raised or reasonably could have raised in the petitions. Acorn argued that it was unfair for Samsung to offer successively broader stipulations like this, but the Board disagreed and allowed Samsung to move forward under the final, broadest stipulation. After deciding which stipulation applied, the Board declined to exercise its discretionary authority in either proceeding, finding that the stipulation and the strength of the grounds of the 1207 petition and certain grounds in the 1282 petition outweighed the earlier district court trial date, especially because other trials were scheduled around the same time in the district court and because of the possibility of pandemic related delays.

In addition to this *Fintiv* argument, Acorn also argued that the petitions were not really based on alternative priority dates because Samsung was asserting 102(b) references in each petition. According to Acorn, the Trial Practice Guide suggests that, in situation like this, parallel petitions are only warranted where the patent owner could, but refuses to, simplify issues via stipulation. But, according to Acorn, there was no possible stipulation that would narrow the issues here short of a stipulation that the claims were invalid for lack of written description. The Board disagreed. The Board held that these petitions did, in fact, turn on different priority dates, which the Trial Practice Guide acknowledges can be a basis for instituting parallel petitions. And, in any case, the Trial Practice Guide does not provide that parallel petitions are only proper in cases where patent owner refuses to narrow issues via stipulation.

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Related Locations

Chicago

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Related Topics

Discretionary Authority

Institution Granted

Institution Denied

Anticipation

Priority Date

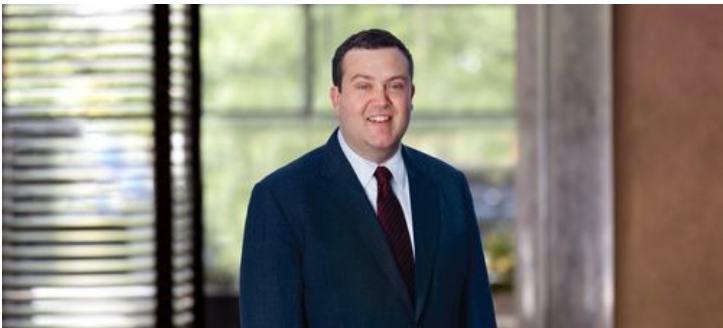
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