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Paper No. 57
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDERSECRETARY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

ASCEND PERFORMANCE MATERIALS OPERATIONS LLC,
Petitioner,

v.

SAMSUNG SDI CO., LTD.,
Patent Owner.

IPR2020-00349
Patent 9,819,057 B2

Before ANDREW HIRSHFELD, *Commissioner for Patents, Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.*

ORDER

Samsung SDI Co., Ltd. ("Patent Owner") requests Director review of the Patent Trial and Appeal Board ("Board") Final Written Decision determining all challenged claims of U.S. Patent No. 9,819,057 B2 ("the '057 patent") unpatentable (Paper 53, "Decision" or "Dec."). Paper 54; Ex. 3100. In the Final Written Decision, the Board found claims 1–5 and 13–17 unpatentable as anticipated by the Shimura[1] reference and as having been obvious over the Fujii[2] and Yamada[3] references. *See* Dec. 37 (summary table setting forth the Board's unpatentability conclusions). Patent Owner argues that Director review is appropriate because: (1) the Board "erred in failing to separately consider species claims 5 and 17" of the '057 patent, which are entitled to the provisional priority date and which antedate the Shimura reference; (2) the Board's obviousness ground of unpatentability over the Fujii and Yamada references "materially differed" from the ground asserted in the Petition; (3) the Board "improperly ignored the [specification of] the '057 patent" and the prosecution history in reaching its conclusion of obviousness over Fujii and Yamada; and (4) the Board overlooked Patent Owner's arguments against Yamada when considering the obviousness ground of unpatentability. Paper 54, 5, 8, 12, 14–15.

I have considered Patent Owner's request. I determine that Director review should be granted as to Patent Owner's first argument because "[p]atent claims are awarded priority on a claim-by-claim basis based on the disclosure in the priority applications," *Lucent Techs., Inc. v. Gateway, Inc.*, 543 F.3d 710, 718 (Fed. Cir. 2008), and the Board's Decision did not specifically address claims 5 and 17. Dec. 19–20. The case is thus remanded to the Board to address whether claims 5

[1] WO 2012-029388, published March 8, 2012 (Ex. 1004; Ex. 1005 (English translation)).
[2] EP 2 120 279 A1, published November 18, 2009 (Ex. 1006).
[3] US 2011/0311864 A1, published December 22, 2011 (Ex. 1026).

and 17 of the ’057 patent are entitled to the September 7, 2012, priority date of the provisional application and to address the patentability of claims 5 and 17 in view of the appropriate filing date, in light of the existing record. Director review is denied as to Patent Owner’s second through fourth arguments.

Accordingly, based on the foregoing, it is:

ORDERED that the Board’s Final Written Decision (Paper 53) is vacated; and

FURTHER ORDERED that the Board shall issue a new final written decision that also addresses whether claims 5 and 17 of the ’057 patent are entitled to the September 7, 2012, priority date of the provisional application and the patentability of claims 5 and 17 in view of the appropriate filing date.

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