

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD., SAMSUNG ELECTRONICS
AMERICA, INC., SAMSUNG TELECOMMUNICATIONS AMERICA,
LLC, and SAMSUNG AUSTIN SEMICONDUCTOR, LLC,
Petitioner,

v.

REMBRANDT WIRELESS TECHNOLOGIES, LP,
Patent Owner.

Case IPR2014-00514
Patent 8,023,580 B2

Before JAMESON LEE, HOWARD B. BLANKENSHIP, and
JUSTIN BUSCH, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. BACKGROUND

Samsung Electronics Co. Ltd., Samsung Electronics America, Inc.,
Samsung Telecommunications America, LLC, and Samsung Austin

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Semiconductor, LLC (collectively, “Petitioner”) request *inter partes* review of claims 1, 2, 4, 5, 10, 13, 19–22, 49, 52–54, 57–59, 61, 62, 66, 70, and 76–79 of U.S. Patent No. 8,023,580 B2 (“the ’580 patent”) (Ex. 1001) under 35 U.S.C. §§ 311–319. Paper 4 (Corrected Petition, or “Pet.”). Rembrandt Wireless Technologies, LP (Patent Owner) filed a preliminary response (Paper 14, “Prelim. Resp.”) provided by 37 C.F.R. § 42.107. We have jurisdiction under 35 U.S.C. § 314.

For the reasons that follow, we do not institute an *inter partes* review as to any of the challenged claims of the ’580 patent.

Related Proceeding

According to Petitioner, the ’580 patent is involved in the following lawsuit: *Rembrandt Wireless Tech., LP v. Samsung Elect. Co. LTD.*, No. 2:13-cv-00213 (E.D. Tex. 2013). Pet. 2. The ’580 patent has also been challenged in the following cases: IPR2014–00515; IPR2014–00518; and IPR2014–00519.

The ’580 Patent

The ’580 Patent issued from an application filed August 19, 2009, which claimed priority, through a chain of intervening applications, under 35 U.S.C. § 120 to an application filed December 4, 1998, and which claimed priority under 35 U.S.C. § 119 to a provisional application filed December 5, 1997.

The technical field of the patent relates to data communications and modulators/demodulators (modems), and in particular to a data communications system in which a plurality of modems use different types

of modulation in a network. Ex. 1201, col. 1, ll. 19-23; col. 1, l. 56 – col. 2, l. 20.

Illustrative Claim

Claim 58 is illustrative.

58. A communication device capable of communicating according to a master/slave relationship in which a slave message from a slave to a master occurs in response to a master message from the master to the slave, the device comprising:

a transceiver, in the role of the master according to the master/slave relationship, capable of transmitting using at least two types of modulation methods, wherein the at least two types of modulation methods comprise a first modulation method and a second modulation method, wherein the second modulation method is of a different type than the first modulation method, and wherein the transceiver is configured to transmit messages with:

a first sequence, in the first modulation method, that indicates at least which of the first modulation method and the second modulation method is used for modulating a second sequence, wherein, in at least one message, the first sequence indicates an impending change from the first modulation method to the second modulation method, and wherein the at least one message is addressed for an intended destination of the second sequence, and

the second sequence, modulated in accordance with the modulation method indicated by the first sequence and, in the at least one message, modulated using the second modulation method, wherein the second sequence is transmitted after the first sequence.

Prior Art and Other Evidence Included with Petition

Boer et al. US 5,706,428 Jan. 6, 1998 (Ex. 1016)
("Boer")

IEEE P802.11, *Draft Standard for Wireless LAN, Medium Access Control (MAC) and Physical Layer (PHY) Specification*, P802.11D4.0, May 20, 1996 (Ex. 1005) ("Draft Standard")

Declaration of Robert O'Hara, Mar. 11, 2014 (Ex. 1004).

Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 3):

Evidence	Basis (35 U.S.C.)	Claims
Draft Standard	§ 102(b)/103(a)	1, 2, 4,5, 10, 13, 19-22, 49, 52-54, 57-59, 61, 62, 66, 70, and 76-79
Draft Standard and Boer	§ 103(a)	1, 2, 4,5, 10, 13, 19-22, 49, 52-54, 57-59, 61, 62, 66, 70, and 76-79

II. ANALYSIS

A. Asserted Anticipation and Obviousness Grounds Based on Draft Standard

The dispositive issue in this proceeding is whether Draft Standard, on which both of Petitioner's asserted grounds of unpatentability rely, is a printed publication.

B. Overview of Draft Standard (Ex. 1005)

Draft Standard is an unapproved draft of a proposed IEEE [Institute of Electrical and Electronics Engineers] Standard. Ex. 1005, i.¹ The purpose of the proposed standard was “[t]o provide wireless connectivity to automatic machinery, equipment [, or] stations that require rapid deployment, which may be portable, or hand-held or which may be mounted on moving vehicles within a local area” and “[t]o offer a standard for use by regulatory bodies to standardize access to one or more frequency bands for the purpose of local area communication.” *Id.* at 1.

C. Declaration of Robert O’Hara (Ex. 1004)

Mr. Robert O’Hara was an editor of the IEEE 802.11-1997 standard. Ex. 1004 ¶ 1; Ex. 1005, iii. Mr. O’Hara states that drafts of the 802.11-1997 standard, including Draft Standard, were available to members of the 802.11 Working Group for download from the 802.11 Working Group’s server. Ex. 1004 ¶ 9. According to Mr. O’Hara, announcements were sent to the Working Group’s e-mail list when drafts became available, and a person could be added to the Working Group’s e-mail list by providing an e-mail address to the chair of the Working Group. *Id.* ¶¶ 9-10. Mr. O’Hara states that there “were no restrictions on who could attend the 802.11 Working Group’s meetings [or] on who could provide an e-mail address” and that, according to his “recollection,” anyone who made a request to be added to the e-mail list would be added. *Id.* ¶ 10.

¹ In this decision, we refer to the original pagination of Draft Standard rather than the Exhibit page number.

Mr. O'Hara states that the copies of the drafts of the Standard available on the Working Group's servers were password-protected files, and that the members of the e-mail list were provided with passwords to access the documents, either as part of an announcement of a new draft or via "another way." *Id.* ¶ 11. According to Mr. O'Hara, the passwords were intended to limit distribution to "interested individuals, as opposed to the entire [I]nternet." *Id.* Mr. O'Hara also states that attending an 802.11 Working Group meeting or asking for access prior to a meeting demonstrated sufficient interest such that that person would receive the password necessary to access the drafts on the Working Group's server. *Id.*

Further, according to Mr. O'Hara, each of the 802.11 standard drafts, including Draft Standard, would have been discussed at the Working Group meetings and made available to all attendees. *Id.* ¶ 12. Mr. O'Hara also states that the meetings were not limited to IEEE members but were open to the general public. *Id.*

D. Analysis of Whether Draft Standard Is a Printed Publication

We look to the underlying facts to make a legal determination as to whether a document is a printed publication. *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1364 (Fed. Cir. 2014). The determination of whether a document is a "printed publication" under 35 U.S.C. § 102(b) involves a case-by-case inquiry into the facts and circumstances surrounding its disclosure to members of the public. *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004). Public accessibility is a key question in determining whether a document is a printed publication and is determined on a case-by-case basis. *Suffolk Techs.*, 752 F.3d at 1364. To qualify as a printed

publication, a document “must have been sufficiently accessible to the public interested in the art.” *In re Lister*, 583 F.3d 1307, 1311 (Fed. Cir. 2009).

The O’Hara Declaration is the only extrinsic evidence that Petitioner submits in support of its position that Draft Standard is a printed publication. *See* Pet. 12-13. Petitioner asserts that Draft Standard “was completed on May 20, 1996, and was available to *anyone who wanted to view it* on May 23, 1996.” Pet. 12 (citing Ex. 1004 ¶¶ 4, 5, 10, and 12) (emphasis added). Petitioner indicates, initially, that this availability resulted in a publication date of May 23, 1996. *Id.* Petitioner also argues that Draft Standard “was available to any interested parties” no later than July 8, 1996, because it “was available to all members of the 802.11 Working Group’s email list” and discussed and distributed at an 802.11 Working Group meeting held July 8–12, 1996. *Id.* at 13. Thus, Petitioner concludes that this alleged distribution and availability to any interested parties by July 8, 1996 renders Draft Standard a “printed publication” under 35 U.S.C. § 102(b). *Id.*

Notably absent, however, from the Petition and Mr. O’Hara’s declaration are any assertions or evidence in support of the availability of Draft Standard to individuals other than members of the 802.11 Working Group and those who already knew about Draft Standard or the July 8–12 meeting of the 802.11 Working Group. We do not find sufficient argument or evidence to indicate that the July 8–12 meeting of the 802.11 Working Group (or any other 802.11 Working Group meeting) was advertised or otherwise announced to the public. Nor do we find sufficient argument or evidence that any individual who was not already a member of, or otherwise aware of, the 802.11 Working Group would have known about Draft

Standard such that he or she would have known to request a copy or ask to be added to an email list for access to the document.

“A given reference is ‘publicly accessible’ upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.* 511 F.3d 1186, 1194 (Fed. Cir. 2008) (quoting *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006)). Although Mr. O’Hara declares that “[t]here were no restrictions on who could attend the 802.11 Working Group’s meetings” (Ex. 1004 ¶ 10) and that the meetings “were open to the general public” (*id.* ¶ 12), Petitioner has not presented persuasive argument or evidence regarding how members of the potentially interested public would have been made aware of these meetings. Similarly, although Mr. O’Hara declares that an individual could provide the chair with an e-mail address to be added to the Working Group’s e-mail list (*id.* ¶ 10), the petition has not established how an individual would have known to attend a meeting or contact the chair in order to be added to the e-mail list.

Based on the evidence before us, we find that the purpose of the 802.11 Working Group’s storage of drafts of the standard on a server is similar to the placement of a file on an “FTP server solely to facilitate peer review in preparation for later publication,” which the U.S. Court of Appeals for the Federal Circuit found weighed against public accessibility of the file. *SRI Int’l*, 511 F.3d at 1197. In *SRI*, even though the “paper was ‘posted’ on an open FTP server and might have been available to anyone with FTP know-how and knowledge of the” subdirectory in which it resided, the

Federal Circuit found the fact that the paper was not publicized suggested an absence of public availability. *Id.* In this case, the submitted evidence does not show that the 802.11 Working Group's server was an open server and, to the extent that it was, the evidence shows that the documents were password protected. Ex. 1004 ¶ 11.

Moreover, notwithstanding Mr. O'Hara's statement that passwords were distributed to the 802.11 Working Group e-mail list (*id.*), the fact that an interested individual needed to contact IEEE in order to obtain a password or other means of accessing Draft Standard (and needed to know who to contact in the first place) weighs against public accessibility. *Cf. Kyocera Wireless Corp. v. Int'l Trade Comm'n*, 545 F.3d 1340, 1351 (finding facts weighed towards public accessibility because "[t]he specifications themselves were visible to any member of the interested public without requesting them from an ETSI member"). Mr. O'Hara states that the drafts of the 802.11 standards, including Draft Standard, were (and still are) protected by passwords in order to limit distribution to "interested individuals, as opposed to the entire [I]nternet." Ex. 1004 ¶ 11. However, as previously discussed, the record does not contain persuasive evidence showing how an individual not already in, or already familiar with, the 802.11 Working Group would have known of the existence of the Draft Standard, the 802.11 Working Group meetings, or the 802.11 Working Group itself. Therefore, we are not persuaded that such an individual, exercising reasonable diligence, would be able to change his status from an anonymous member of "the entire [I]nternet" to an "interested individual."

Therefore, based on the evidence Petitioner provided, we conclude Petitioner has not made a sufficient showing that Draft Standard was a

printed publication as of July 1996 or earlier, as alleged, i.e., that Draft Standard was available as of July 1996 or earlier to an ordinarily skilled individual, exercising reasonable diligence, who might have been interested in the subject matter of Draft Standard.

E. Asserted Grounds of Unpatentability

Because Petitioner has not met its burden in establishing that Draft Standard is a “printed publication” and, thus, prior art, Petitioner has not shown a reasonable likelihood of prevailing on the grounds asserted.

III. CONCLUSION

The Petition fails to demonstrate a reasonable likelihood of prevailing on the grounds that the challenged claims are anticipated by, or obvious over, Draft Standard or obvious over Draft Standard and Boer.

IV. ORDER

In consideration of the foregoing, it is
ORDERED that the petition is denied as to all challenged claims and no trial is instituted.

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