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Paper 38
Entered: May 12, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MARVELL SEMICONDUCTOR, INC.,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

Case IPR2014-00553
Patent 6,754,195 B2

Before THOMAS L. GIANNETTI, JAMES A. TARTAL, and PATRICK M. BOUCHER, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge.*

DECISION
Patent Owner's Request for Rehearing
37 C.F.R. § 42.71(c)

I. BACKGROUND

On December 3, 2014, we instituted *inter partes* review of U.S. Patent No. 6,754,195 B2 ("the '195 patent") in IPR2014-00552 ("the related proceeding") on grounds that involve Webster.[1] Paper 17 ("Dec."). We

[1] U.S. Patent No. 7,274,652.

initially denied the Petition in this proceeding because we were not convinced that any of the additional grounds add substantively to the grounds on which we instituted *inter partes* review in the related proceeding. Dec. 18. Patent Owner subsequently contended in the related proceeding that Webster is disqualified as prior art to the '195 patent under 35 U.S.C. § 103(c). *See* Paper 19 ("Reh'g Dec.") 2. In light of this contention directed to Webster's availability as a prior art reference, Petitioner requested rehearing of our denial of the petition in this proceeding. Paper 18 ("Pet. Req. Reh'g"). We were persuaded by Petitioner's argument that "Patent Owner's pursuit of a 35 U.S.C. § 103(c) defense against Webster creates a substantive difference" between the grounds in the two proceedings, justifying reconsideration of our previous denial of the Petition. *See id.* 4–5.

On February 20, 2015, we granted the motion and instituted *inter partes* review. *Id.* The grounds involve Wu,[2] Böhnke,[3] IEEE 802.11a,[4] IEEE 802.11b,[5] and Jamal,[6] which are not subject to disqualification under 35 U.S.C. § 103(c). Reh'g Dec. 7.

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[2] Jean-Lien C. Wu, "An Adaptive Multirate IEEE 802.11 Wireless LAN" (IEEE 2001) (Ex. 1108).
[3] U.S. Patent No. 6,567,374 B1 (Ex. 1113).
[4] "Supplement to IEEE Standard for Information technology — Telecommunications and information exchange between systems — Local and metropolitan area networks — Specific requirements — Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) specifications: High-speed Physical Layer in the 5 GHZ Band" (IEEE 1999) (Ex. 1107).
[5] "Supplement to IEEE Standard for Information technology — Telecommunications and information exchange between systems — Local metropolitan area networks — Specific requirements — Part 11: Wireless

Patent Owner now requests rehearing of that decision on rehearing by an expanded panel. Paper 22 ("PO Req. Reh'g").

II. REQUEST FOR EXPANDED PANEL

Discretion to expand a panel rests with the Chief Judge, who, on behalf of the Director, may act to expand a panel on a suggestion from a judge or panel. *AOL Inc. v. Coho Sicensing LLC*, Case IPR2014-00771, slip op. at 2 (PTAB Mar. 24, 2015) (Paper 12) (informative). "[P]arties are not permitted to request, and panels do not authorize, panel expansion." *Id.* Furthermore, whether to expand the panel in an *inter partes* review matter involves "consideration of whether the issue is one of conflict with an authoritative decision of our reviewing courts or a precedential decision of the Board, or whether the issue raises a conflict regarding a contrary legal interpretation of a statute or regulation." *Id*. at 3. Petitioner's bases for requesting panel expansion do not fall within these parameters. *See* PO Req. Reh'g 7–8.

III. ANALYSIS

Patent Owner contends that we misapprehended or overlooked (1) "the fact that Petitioner did not address potential redundacy or the disqualification of Webster in its Petition"; and (2) that, during the February

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LAN Medium Access Control (MAC) and Physical Layer (PHY) specifications: Higher-Speed Physical Layer Extension in the 2.4 GHz Band" (IEEE1999) (Ex. 1106).

[6] Rahman Jamal *et al., Filters* (CRC Press 2000) (Ex. 1114).

10 conference call, "Patent Owner expressly addressed the issue of Petitioner's failure to identify what the Board 'misapprehended or overlooked' regarding the disqualification of the Webster reference." PO Req. Reh'g 6–7 (citations omitted). Patent Owner further contends that "[t]hree-judge panels should not grant rehearing to give petitioners a second means of attack when events in the orderly conduct of another instituted proceeding suggest that the instituted grounds may fail to invalidate the challenged patent." *Id.* at 3. We disagree with these characterizations.

Patent Owner contends that it is being "punished" for filing a preliminary response. PO Req. Reh'g 3, 5–6. We do not agree. Patent Owner is correct that patent owners are "not required to file a preliminary response at all, much less one that includes a particular argument" (PO Req. Reh'g 6). But once Patent Owner raised the § 103(c) issue with respect to Webster, including a request for additional discovery, it became apparent that the availability of Webster as a reference was in question and that the panel's initial disposition of the Petition would have to be revisited. Thus, the triggering event was not the filing of the Preliminary Response, but the raising of the § 103(c) defense to Webster. It was entirely appropriate for the Board to respond to this by granting the motion for rehearing. Such is particularly the case because the original decision not to institute on certain grounds resulted not from an identified defect in Petitioner's analysis but from the Board's effort to manage the number of instituted grounds in achieving the objective of "secur[ing] the just, speedy, and inexpensive resolution of every proceeding." *See* Dec. 18 (citing 37 C.F.R. § 42.1).

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that Patent Owner's Request for Rehearing is *denied.*

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