

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAXLINEAR, INC.,
Petitioner,

v.

CRESTA TECHNOLOGY CORPORATION,
Patent Owner.

Case IPR2015-00591
Patent 7,075,585 B2

Before PHILLIP J. KAUFFMAN, GREGG I. ANDERSON, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

On January 28, 2015, MaxLinear, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–3, 5, 10, 13, 14, and 16–19 of U.S. Patent No. 7,075,585 B2 (“the ’585 patent”). Cresta Technology Corporation (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”) on May 16, 2015.

We deny the Petition and do not institute an *inter partes* review.

B. Related Proceedings

Patent Owner has asserted the ’585 patent against Petitioner in the following two actions: *Cresta Technology Corp. v. Maxlinear, Inc.*, 1:14-cv-00079-RGA (D. Del.); and *Certain Television Sets, Television Receivers, Television Tuners, and Components Thereof*, Inv. No. 337-TA-910 (ITC). Pet. 1; Paper 4, 2.

Petitioner’s co-defendant/co-respondent, Silicon Laboratories, Inc. (“Silicon Labs”) filed a petition for *inter partes* review of the ’585 patent in IPR2014-00728 (“the related proceeding”). We instituted trial on certain claims of the ’585 patent in the related proceeding on October 24, 2014. Pet. at 2.

C. Asserted Grounds

Petitioner relies on the following references. Pet. 4–5.

Thomson	EP 0696854 A1	Feb. 14, 1996	Ex. 1004
Balaban ¹	US 6,369,857 B1	Apr. 9, 2002	Ex. 1008
Kerth	US 6,804,497 B2	Oct. 12, 2004	Ex. 1011

Clay Olmstead and Mike Petrowski, *A Digital Tuner for Wideband Receivers*, DSP APPLICATIONS MAGAZINE (Sept. 1992) (Ex. 1005) (“Harris”)

Prior art shown in Figure 1 of the ’585 patent and related description (Ex. 1001)

Petitioner challenges claims 1–3, 5, 10, 13, 14, and 16–19 of the ’585 patent on the following grounds. Pet. 5–6.

Reference(s)	Basis	Claim(s) Challenged
Thomson	§ 102(b)	1, 2, 5, and 16–19
Thomson and Harris	§ 103(a)	1, 2, 5, 10, and 16
Thomson and prior art shown in the ’585 patent	§ 103(a)	1, 2, 5, 10, and 16
Thomson, Harris, and prior art shown in the ’585 patent	§ 103(a)	1, 2, 5, 10, and 16
Thomson and Kerth	§ 103(a)	3
Thomson, Harris, and Kerth	§ 103(a)	3
Thomson, Harris, and Balaban	§ 103(a)	13, 14, and 19

¹ Petitioner does not identify Balaban in its summary of references at pages 4–5 of the Petition, but identifies Balaban in its summary of challenges at page 6 and addresses Balaban in its argument at pages 42–46.

II. ANALYSIS

The Director, and, by extension, the Board, has broad discretion to deny a petition for *inter partes* review that raises substantially the same prior art or arguments previously presented to the Office:

In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

35 U.S.C. § 325(d). Each of the grounds advanced by Petitioner was previously considered by the Board in the related proceeding. *See Silicon Labs, Inc. v. Cresta Tech. Corp.*, Case IPR2014-00728, slip op. at 5 (PTAB Oct. 24, 2014) (Paper 9). Petitioner’s arguments differ only in minor respects from the arguments considered in the related proceeding.² Indeed, Petitioner acknowledges that the instant Petition “is substantially identical to the Petition of [the related proceeding].” Pet. 8. Although Petitioner supports its Petition with a declaration of a different witness (Ex. 1009) than

² For example, in addressing claim 13, Silicon Labs argued in the related proceeding that “Thomson inherently discloses to a [person of ordinary skill in the art] a standard selection circuit that generates [a] ‘Television Standard’ based on the format of the received television signal.” *Silicon Labs*. at 22–23. Petitioner recharacterizes that argument to avoid reference to inherency, but otherwise advances similar reasoning: “A [person of ordinary skill in the art] would understand Thomson as disclosing a standard or formal selection circuit that generates this ‘Television Standard’ based on the standard or format of the received television signal.” Pet. 42.

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relied on by Silicon Labs in the related proceeding, we agree with Patent Owner that “the declaration is substantially identical to the [related proceeding’s] declaration.” Prelim. Resp. 2. Thus, we determine that the same or substantially the same prior art or arguments previously were presented to the Office.

Petitioner requests institution of an *inter partes* review “based on the previously instituted grounds in [the related] proceeding, but to hold those grounds in abeyance in the present proceeding until and unless a settlement of the [related] proceeding occurs, at which point Petitioner would continue to challenge those claims.” Pet. 8. We are not persuaded that Petitioner’s proposed course of action would be a prudent use of our discretion. *See* H.R. Rep. No. 112-98, pt.1, at 48 (2011) (“While this amendment is intended to remove current disincentives to current administrative processes, the changes made by it are not to be used as tools for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent. Doing so would frustrate the purpose of the section as providing quick and cost effective alternatives to litigation”). As Patent Owner observes, nothing in the statute or rules contemplates such a course of action, which would risk encouraging parties to engage in a pattern of duplicative filings that harass patent owners. *See* Prelim. Resp. 11.

The statutory structure of the America Invents Act includes a more appropriate mechanism for petitioners to assert grounds upon which *inter*

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partes review has already been instituted—a request for joinder under 35 U.S.C. § 315(c). Petitioner has not filed such a request, and, in light of the advanced stage of the related proceeding, we decline *sua sponte* to join Petitioner to the related proceeding.

For the foregoing reasons, we exercise the discretion granted under 35 U.S.C. § 325(d) to deny the Petition.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* and no *inter partes* review is instituted.

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PETITIONER:

Thomas J. Wimbiscus
Christopher C. Winslade
Gregory C. Schodde
Scott P. McBride
Ronald H. Spuhler
Wayne H. Bradley
McANDREWS HELD & MALLOY
twimbiscus@mcandrews-ip.com
cwinslade@mcandrews-ip.com
gschodde@mcandrews-ip.com
smcbride@mcandrews-ip.com
rspuhle@mcandrews-ip.com
wbradley@mcandrews-ip.com

PATENT OWNER:

Michael R. Fleming
Benjamin Haber
IRELL & MANELLA LLP
mfleming@neifeld.com
bhaber@irell.com