

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 IPR2015-00118
Patent 8,023,580 B2

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

BUSCH, *Administrative Patent Judge*.

DECISION

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

Denial of Motion for Joinder
37 C.F.R. § 42.122

I. INTRODUCTION

Petitioner filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 23, 25, 29, 30, and 41 of U.S. Patent No. 8,023,580 B2 (Ex. 1301, “the ’580 patent”). Petitioner also timely filed a motion requesting joinder (Paper 3, “Mot. Join.”) of this proceeding to IPR2014-00519, in which we instituted an *inter partes* review of claims 32, 34, 38, 40, 43, 44, and 47 of the ’580 patent, but denied review of claims 23, 25, 29, 30, and 41. Mot. Join. 2. Patent Owner filed a Preliminary Response (Paper 10, “Prelim. Resp.”) and an Opposition to the Motion for Joinder (Paper 8, “Opp.”). Petitioner filed a Reply (Paper 9, “Reply”) to Patent Owner’s Opposition. We have jurisdiction under 35 U.S.C. § 314.

We have reviewed the aforementioned papers. For the reasons given below, we do not institute an *inter partes* review and we deny Petitioner’s Motion for Joinder.

A. Related Matters

Petitioner indicates that the ’580 patent was asserted against Petitioner in *Rembrandt Wireless Technologies, LP v. Samsung Electronics Co.*, No. 2:13-cv-00213 (E.D. Tex.). Pet. 1.

Petitioner seeks to join this proceeding to *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, Case IPR2014-00519 (PTAB) (trial instituted September 23, 2014) (hereinafter “IPR-519”), in which Petitioner challenged claims 23, 25, 29, 30, 32, 34, 38, 40, 41, 43, 44, and 47 of the ’580 patent, but no trial was instituted with respect to claims 23, 25, 29, 30, and 41. Pet. 1. The same parties and patent also are involved in *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, Case IPR2014-00514 (PTAB) (institution denied on Sept. 9, 2014); *Samsung Electronics Co. v. Rembrandt Wireless*

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Technologies, LP, Case IPR2014-00515 (PTAB) (institution denied on Sept. 9, 2014); *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, Case IPR2014-00518 (PTAB) (trial instituted on Sept. 23, 2014); and *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, Case IPR2015-00114 (PTAB). *Id.*

B. The '580 Patent (Ex. 1301)

The specification of the '580 patent describes “a data communications system in which a plurality of modulation methods are used to facilitate communication among a plurality of modem types.” Ex. 1301, 1:21–23. The '580 patent explains that the invention addresses the problem that conventional modem pairs can communicate successfully only when the modems use compatible modulation methods. *Id.* at 1:27–30, 1:45–47.

Of the challenged claims, only claim 23 is independent and is reproduced as follows:

23. A communications device, comprising:
a processor; and
a memory having stored therein executable instructions for execution by the processor, wherein the executable instructions direct transmission of a first data with a first modulation method followed by a second data with a second modulation method, wherein the first modulation method is different than the second modulation method, wherein the first data comprises an indication of an impending change from the first modulation method to the second modulation method, wherein the executable instructions direct transmission of a third data with the first modulation method after the second data, and wherein the third data indicates that communication has reverted to the first modulation method.

C. The Asserted Grounds & Prior Art

Petitioner asserts the following grounds of unpatentability under 35 U.S.C. § 103:

Evidence	Basis	Challenged Claim(s)
Boer ¹	§ 103(a)	23, 25, 30, and 41
Boer and APA ²	§ 103(a)	29

II. DISCUSSION

A. Background

In IPR-519, Petitioner asserted that claims 23, 25, 30, and 41 of the '580 patent are unpatentable as anticipated by Boer, that claims 23, 25, and 30 are unpatentable as obvious over Boer, and that claim 29 is unpatentable as obvious over Boer and APA. Pet. 1. We did not institute an *inter partes* review of claims 23, 25, 29, 30, and 41 as anticipated by Boer, and explained as follows³:

Boer's system may be capable of transmitting a first message's data field using either DQPSK or PPM/DQPSK followed, a subsequent message's header field using DBPSK, where the subsequent message's

¹ U.S. Patent No. 5,706,428 (filed Mar. 14, 1996, issued Jan. 6, 1998) (Ex. 1304) ("Boer").

² Petitioner alleges that Figures 1 and 2 of the '580 patent and the accompanying descriptions are admitted prior art. Pet. 37–38 (citing Ex. 1301, Figs. 1, 2, 2:16–20, 3:40–46) ("APA").

³ Institution of *inter partes* review with respect to the obviousness of claims 25 and 30 in view of Boer and claim 29 in view of Boer and APA was denied because claims 25, 29, and 30 depend from, and incorporate the limitations of, claim 23. Further, with respect to claim 29, Petitioner did not show that APA cures the deficiencies identified with respect to claim 23.

header field indicates that the subsequent message's data field will be transmitted using DBPSK. However, the Petition has not established that the specific series of transmissions as recited in independent claim 23 is explicitly disclosed by or necessarily present in Boer.

IPR-519, Dec. Inst. 8 (Paper 16); *id.* at 12–13.

We did not institute an *inter partes* review of claims 23, 25, and 30 as obvious in view of Boer, and explained as follows:

Petitioner presents no other argument regarding what aspects of Boer would need to be modified in order to meet the recited limitations and why. The underlying factual inquiries necessary for a proper obviousness analysis, as set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966), have not been discussed sufficiently. In particular, Petitioner has not submitted persuasive argument or evidence curing the deficiency identified with respect to its anticipation challenge.

Id. at 9.

Petitioner argues in the Petition in the instant proceeding that Boer explicitly teaches the limitations we found to be missing from Petitioner's challenges to claims 23, 25, 29, 30, and 41, as explained in our institution decision in IPR-519. Pet. 11–12. In this proceeding, notwithstanding Petitioner's arguments that Boer explicitly teaches the limitations, Petitioner presents challenges arguing why the limitations identified as not having been shown sufficiently as anticipated by Boer would have been obvious in view of Boer. Pet. 12–37. We do not reach the merits of Petitioner's new argument that the previously insufficiently shown limitations would have been obvious. Instead, for the reasons discussed below, we exercise our discretion under 35 U.S.C. § 325(d) to deny institution of *inter partes* review in this proceeding.

B. Relevant Law

A petitioner is not entitled to multiple challenges against a patent:

In determining whether to institute or order a proceeding under . . . 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) (titled: “MULTIPLE PROCEEDINGS”). Further, in construing our authority to institute *inter partes* review under 37 C.F.R. § 42.108, we are mindful of the guidance provided in § 42.1(b): “[37 C.F.R. § 42] shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.”

C. Analysis

On its face, it is more efficient for the parties and the Board to address a matter once rather than twice. The sole difference between what Petitioner presents in this proceeding and what Petitioner presented in IPR-519, with respect to the challenge of claims 23, 25, 29, 30, and 41 of the ’580 patent, is the presence of additional reasoning to support the assertion of unpatentability over the same prior art. Mot. Join. 1, 4; Opp. 1, 3, 9–10.

Petitioner is requesting, essentially, a second chance to address claims 23, 25, 29, 30, and 41. We, however, are not persuaded that a second chance would help “secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). Permitting second chances without constraint ties up the Board’s limited resources; we must be mindful not only of this proceeding, but of “every proceeding.” *Id.*; see also *ZTE Corp. v. ContentGuard Holdings, Inc.*, Case IPR2013-00454, slip op. at 5–6 (PTAB Sept. 25, 2013) (Paper 12) (“The Board is concerned about encouraging, unnecessarily, the filing of petitions which are partially inadequate.”). Accordingly, we look to see if this case presents a

circumstance that merits a second chance. *Cf. Ariosa Diagnostics v. Isis Innovation, Ltd.*, Case IPR2013-00250, slip op. at 2, 4 (PTAB Sept. 8, 2013) (Paper 25) (granting joinder when a new product was launched, leading to a threat of new assertions of infringement); *Microsoft Corp. v. Proxyconn, Inc.*, Case IPR2013-00109, slip op. at 3 (PTAB Feb. 25, 2014) (Paper 15) (additional claims had been asserted against Petitioner in concurrent district court litigation).

In this proceeding, however, we are not apprised of a reason that merits a second chance. Petitioner simply presents an argument now that it could have made in IPR-519, had it merely chosen to do so. In view of the above, and especially in light of the fact that, barring joinder, this Petition is time-barred under 35 U.S.C. § 315(b), we exercise our discretion under 35 U.S.C. § 325(d) to deny the Petition, because it presents merely “the same or substantially the same prior art or arguments” presented to us in IPR-519. As a consequence, Petitioner’s motion for joinder is dismissed as moot.

III. ORDER

In view of the foregoing, it is hereby:

ORDERED that no trial is instituted; and

FURTHER ORDERED that Petitioner’s motion for joinder is *dismissed*.

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