

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 IPR2015-00555
Patent 8,457,228 B2

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

BLANKENSHIP, *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. BACKGROUND

Samsung Electronics Co. Ltd., Samsung Electronics America, Inc., Samsung Telecommunications America, LLC, and Samsung Austin Semiconductor, LLC (collectively, “Petitioner”) filed a petition requesting *inter partes* review of claim 21 of U.S. Patent No. 8,457,228 B2 (“the ’228 patent”) (Ex. 1301) under 35 U.S.C. §§ 311–319. *See* Paper 1 (Petition, or “Pet.”). With the Petition, Petitioner filed a motion for joinder (Paper 3, “Mot. Join.”), seeking to join with *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, Case IPR2014-00892 (“IPR ’892”). Patent Owner Rembrandt Wireless Technologies, LP filed an opposition to the motion for joinder (Paper 9, “Opp.”) and a preliminary response (*see* Paper 19, “Prelim. Resp.”). Petitioner filed a reply to Patent Owner’s opposition to the motion for joinder. Paper 10 (“Reply”). We have jurisdiction under 35 U.S.C. § 314.

For the reasons that follow, we deny the motion for joinder and do not institute an *inter partes* review as to the challenged claim of the ’228 patent.

A. Related Proceedings

According to Petitioner, the ’228 patent is involved in the lawsuit *Rembrandt Wireless Technologies, LP v. Samsung Electronics Co.*, No. 2:13-cv-00213 (E.D. Tex. 2013). Pet. 1. The ’228 patent also has been challenged in the following cases: *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, IPR2014-00889; *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, IPR2014-00890; *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, IPR2014-00891; *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*,

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IPR2014-00892; *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, IPR2014-00893; and *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, IPR2014-00895.

B. The '228 Patent

The '228 Patent issued from an application filed August 4, 2011, which claimed priority under 35 U.S.C. § 120 through a chain of intervening applications to an application filed December 4, 1998, and which further 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. 1301, col. 1, ll. 21–25; col. 1, l. 58 – col. 2, l. 23.

C. Challenged Claim

Claim 21, the sole claim that is challenged, is reproduced below along with base claim 1.

1. A master communication device configured to communicate with one or more slave transceivers according to a master/slave relationship in which a slave communication from a slave device to the master communication device occurs in response to a master communication from the master communication device to the slave device, the master communication device comprising:

 a master transceiver configured to transmit a first message over a communication medium from the master

transceiver to the one or more slave transceivers, wherein the first message comprises:

first information modulated according to a first modulation method,

second information, including a payload portion, modulated according to the first modulation method, wherein the second information comprises data intended for one of the one or more slave transceivers and

first message address information that is indicative of the one of the one or more slave transceivers being an intended destination of the second information; and

said master transceiver configured to transmit a second message over the communication medium from the master transceiver to the one or more slave transceivers wherein the second message comprises:

third information modulated according to the first modulation method, wherein the third information comprises information that is indicative of an impending change in modulation to a second modulation method, and

fourth information, including a payload portion, transmitted after transmission of the third information, the fourth information being modulated according to the second modulation method, the second modulation method being of a different type than the first modulation method, wherein the fourth information comprises data intended for a single slave transceiver of the one or more slave transceivers, and

second message address information that is indicative of the single slave transceiver being an intended destination of the fourth information; and

wherein the second modulation method results in a higher data rate than the first modulation method.

21. The master communication device as in claim 1,
wherein the first information that is included in the first
message comprises the first message address data.

D. Prior Art

Boer	US 5,706,428	Jan. 6, 1998	(Ex. 1304)
Siwiak	US 5,537,398	July 16, 1996	(Ex. 1324)

E. Asserted Ground of Unpatentability

Petitioner asserts the following ground of unpatentability as to claim 21 (Pet. 3): obviousness under 35 U.S.C. § 103(a) over Admitted Prior Art (“APA”)¹, Boer, and Siwiak.

II. ANALYSIS

A. Background

In IPR ’892, Petitioner asserted that claims 1–3, 5, and 10–21 of the ’228 patent were unpatentable over APA and Boer. IPR ’892, Paper 2 at 20–70. We did not institute an *inter partes* review of claim 21 based on that ground in IPR ’892. We explained as follows:

Claim 21, which depends directly from claim 1, recites that the first information that is included in the first message “comprises the first message address data.” Petitioner maps the claimed “first information” as corresponding to header 218 of message 200 depicted in Figure 4 of Boer. Petitioner admits that Boer does not teach placing its address information in header 218 (Ex. 1304, Fig. 4). Boer teaches that DATA field

¹ Petitioner asserts that Patent Owner made admissions in the ’228 patent disclosure and in the prosecution history of a parent application regarding prior art. Pet. 12–14.

214 (Fig. 4), which is deemed to correspond to the “second information,” contains a destination address.

Petitioner submits that the ’228 patent “admits” that placing address information in the training sequence of a message is prior art. Petitioner does not indicate how such an admission might be relevant to claim 21. The ’228 patent teaches that in a multipoint system the address of the trib with which the master is establishing communication is also transmitted during the training interval. The “training signals” that are exchanged during the training interval, however, are “sequences of signals of particular subsets of all signals that can be communicated via the agreed upon common modulation method.” Petitioner does not identify any teaching of placing address data in the message header.

Petitioner concludes that “[a] person having ordinary skill in the art would have been motivated to combine the APA with Boer due to the similarities between the packet structures and because where the address fields are placed is a matter of design choice.” Petitioner has not identified a teaching in the applied prior art of placing address data in the header of a message. Nor has Petitioner provided evidence sufficient to demonstrate that the ordinary artisan would have considered placing the address data as claimed to be a mere matter of “design choice.” Petitioner’s conclusory allegation of “design choice” does not provide the required “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007).

IPR ’892, slip op. at 13–15 (PTAB Dec. 10, 2014) (Paper 8) (citations to record omitted).

We do not reach the merits of Petitioner’s additional reasoning in the instant Petition as to why Petitioner asserts that the subject matter of claim 21 would have been obvious over the combination of APA, Boer, and Siwiak. 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. Principles of 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. Discussion

The difference between what Petitioner presents in this proceeding and what Petitioner presented in IPR ’892 with respect to claim 21 of the ’228 patent is that Petitioner now offers Siwiak as support for the asserted obviousness of placing address data in a message header as taught by Boer. Pet. 24–57; Mot. Join. 5–6. Petitioner, however, presents no argument or evidence that Siwiak was not known or available to it at the time of filing IPR ’892. In fact, Petitioner applied Siwiak in proposed grounds of rejection against claim 21 of the ’228 patent in another petition filed the same day as that in the IPR ’892 proceeding. *See* IPR2014-00889, Paper 2 at 58–60. On this record, we exercise our discretion and “reject the petition” because “the

same or substantially the same prior art” previously was “presented to the Office” in the IPR ’892 proceeding. 35 U.S.C. § 325(d); *see also Unilever, Inc., v. The Proctor & Gamble Co.*, Case IPR2014-00506, slip op. at 6 (PTAB July 7, 2014) (Paper 17) (informative) (seven new references added to six that were applied in earlier petition).

Petitioner is requesting, essentially, a second chance to challenge the claims. 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 in cases like this one 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.”); *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) *and* Paper 4 at 3; *Microsoft Corp. v. Proxyconn, Inc.*, Case IPR2013-00109, slip op. at 3 (PTAB Feb. 25, 2014) (Paper 15) (granting joinder when 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 arguments now that it could have made in IPR ’892, had it merely chosen to do so. In view of the foregoing, 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

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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 ’892. As a consequence, Petitioner’s motion for joinder is dismissed as moot.

III. ORDER

In view of the foregoing, it is

ORDERED that Petitioner’s motion for joinder is *dismissed*; and

FURTHER ORDERED that no trial is instituted.

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