UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

REMBRANDT WIRELESS TECHNOLOGIES, LP,
Patent Owner.

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Case IPR2014-00519
Patent 8,023,580 B2

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

BUSCH, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. BACKGROUND

Samsung Electronics Co. Ltd., Samsung Electronics America, Inc., Samsung Telecommunications America, LLC, and Samsung Austin Semiconductor, LLC (collectively, "Petitioner") filed a request for *inter partes* review of claims 23, 25, 29, 30, 32, 34, 38, 40, 41, 43, 44, and 47 of U.S. Patent No. 8,023,580 B2 ("the '580 patent," Ex. 1301) under 35 U.S.C. §§ 311–319. The Board instituted an *inter partes* review of claims 32, 34, 38, 40, 43, 44, and 47. Paper 16 ("Dec. on Inst.").

Subsequent to institution, Patent Owner Rembrandt Wireless Technologies, LP, filed a Notice of Filing a Disclaimer (Paper 26), indicating that Patent Owner filed a disclaimer under 35 U.S.C. § 1.321(a) disclaiming claims 32, 34, 40, 43, and 44. Therefore, the trial is terminated with respect to claims 32, 34, 40, 43, and 44. *See* 37 C.F.R. §§ 42.72, 42.73. Patent Owner also filed a patent owner response (Paper 25, "PO Resp."). Petitioner filed a reply to the Patent Owner Response (Paper 34, "Pet. Reply").

Oral hearing was held on April 24, 2015.[1]

The Board has jurisdiction under 35 U.S.C. § 6(c). This final written decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 38 and 47 of the '580 patent are unpatentable.

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[1] The record includes a transcript of the oral hearing. Paper 48.

A. Related Proceedings

According to Petitioner, the '580 patent is involved in the following district court proceeding: *Rembrandt Wireless Technologies, LP v. Samsung Electronics Co.*, No. 2:13-cv-00213 (E.D. Tex. 2013). Pet. 2. The '580 patent also has been challenged in the following cases: *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP* , IPR2014-00514 (not instituted); *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, IPR2014-00515 (not instituted); and *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, IPR2014-00518 (final decision issuing concurrently).

B. The '580 Patent

The '580 patent issued from an application filed August 19, 2009, 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 uses different types of modulation in a network. Ex. 1301, 1:19–23, 1:56–2:20.

C. Illustrative Claim

Illustrative claim 38 and claim 32, from which claim 38 depends, are reproduced below:

32. 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 transmission of the second data is according to a particular quantity of data.

38. The device of claim 32, wherein the memory has stored therein program code for a multipoint communications protocol.

D. Prior Art

Boer   US 5,706,428   Jan. 6, 1998   (Ex. 1304)

E. Asserted Ground of Unpatentability

The Board instituted *inter partes* review on the asserted grounds that claims 32, 34, 40, 43, and 44 of the '580 patent are unpatentable as anticipated by Boer and claims 38 and 47 are unpatentable as obvious over Admitted Prior Art ("APA") and Boer. Dec. on Inst. 16. Patent Owner's

disclaimer, discussed above, leaves the anticipation ground as the only ground at issue in this proceeding.

II. ANALYSIS

A. Prior Art

1. Admitted Prior Art

Petitioner contends that the '580 patent's disclosed multipoint communication systems (or master/slave systems), depicted in Figures 1 and 2 and described in column 3, line 40 through column 4, line 50, constitutes material that may be used as prior art against the patent under 35 U.S.C. § 103(a). We agree. Figure 1 of the patent is labeled as "Prior Art." Pet. 6; Ex. 1301, Fig. 1. Further, the '580 patent's specification refers to "prior art" multipoint communication system 22 comprising master modem or transceiver 24, which communicates with a plurality of tributary modems ("tribs") or transceivers 26. Pet. 6; Ex. 1301, 3:40–44. Further, the '580 patent describes Figure 2 as illustrating the operation of the multipoint communication system of (prior art) Figure 1. Pet. 7; Ex. 1301, 3:9–10.

2. Boer

Boer describes a wireless LAN that includes first stations that operate at 1 or 2 Mbps (Megabits per second) data rate and second stations that operate at 1, 2, 5, or 8 Mbps data rate. Ex. 1304, Abstract.

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