

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

VIRGINIA INNOVATION SCIENCES, INC.,
Patent Owner.

Case IPR2014-00557
Patent 8,135,398 B2

Before MICHAEL W. KIM, BRIAN J. McNAMARA,
and MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

DECISION TO INSTITUTE AND GRANT OF MOTION FOR JOINDER
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Samsung Electronics Co., Ltd. (“Petitioner”) filed a corrected Petition requesting an *inter partes* review of claims 58 and 63 of U.S. Patent No. 8,135,398 B2 (Ex. 1001, “the ’398 Patent”). Paper 1 (“Pet.”). The Petition includes a Motion for Joinder under 37 C.F.R. § 42.122 (Paper 3; “Motion for Joinder”). Virginia Innovation Sciences, Inc. (“Patent Owner”) filed an Opposition to Joinder (Paper 8; “Opposition”), but did not file a Preliminary Response by the accelerated due date of May 15, 2014, set forth in an order dated April 24, 2014 (Paper 9). We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a) which provides as follows:

THRESHOLD.—The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Upon consideration of the Petition, we determine that the information presented by Petitioner has established that there is a reasonable likelihood that Petitioner would prevail in showing the unpatentability of claims 58 and 63 of the ’398 Patent. Accordingly, we institute an *inter partes* review on claims 58 and 63. We also grant the Motion for Joinder.

A. Related Proceedings

Petitioner and Patent Owner indicate that Patent Owner asserted the ’398 Patent against Petitioner in *Virginia Innovation Sciences, Inc. v. Samsung Electronics Co., Ltd.*, Case No. 2:12-cv-00548-MSD-DEM (E.D.

Case IPR2014-00557
Patent 8,135,398 B2

Va.), filed October 4, 2012. Pet. 1; Paper 7, 2. Petitioner and Patent Owner also have identified the following related and pending *inter partes* reviews: *Samsung Electronics Co., Ltd. v. Virginia Innovation Sciences, Inc.*, Case IPR2013-00569 (U.S. Patent No. 8,145,268 B2); *Samsung Electronics Co., Ltd. v. Virginia Innovation Sciences, Inc.*, Case IPR2013-00570 (U.S. Patent No. 8,224,381 B2); *Samsung Electronics Co., Ltd. v. Virginia Innovation Sciences, Inc.*, Case IPR2013-00571 (U.S. Patent No. 8,135,398 B2). Pet. 1; Paper 7, 2.

B. The '398 Patent

The subject matter of the '398 Patent relates to systems and methods for providing multimedia content to and from various devices. Ex. 1001, 1:47–49. “Empowered by the next generation of wireless technology, cellular networks can provide users with access to information from the Internet such as video on demand, video conferences, databases, etc.” Ex. 1001, 1:51–54. Use of cellular phones is, thus, no longer limited to voice transmission. Ex. 1001, 1:54–55.

Such next generation wireless technology allows a user to engage in communications using various devices, and also allows the user to enjoy content in various vehicles. Ex. 1001, 2:66–3:2. For example, the user no longer merely watches television. Ex. 1001, 3:2–3. “Instead, the user may use their home computer, television, MP3, PDA, cellular phone or various hybrid devices to enjoy content.” Ex. 1001, 3:3–5. “This content also arrives from a variety of sources, not just broadcast television as in the past.” Ex. 1001, 3:5–6. According to the '398 Patent, although it may be desirable

to have more options, some consumers may feel overwhelmed trying to manage everything. Ex. 1001, 3:6–8. Thus, the '398 patent proposes solutions to problems that cause diminished user enjoyment of various devices and corresponding content due to the complications of trying to manage content and interface with a variety of devices that are not necessarily compatible. Ex. 1001, 3:9–13. According to the '398 Patent, one such solution, mobile terminal signal conversion, is set forth in Figure 9, reproduced below:

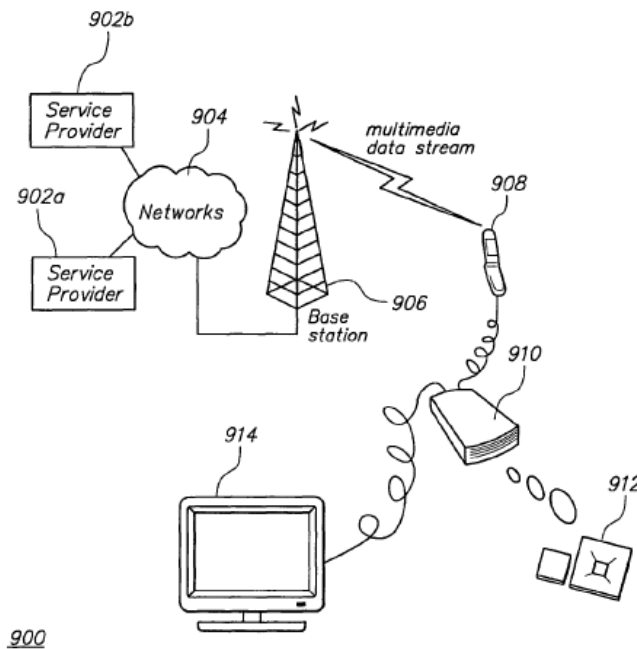


Figure 9 illustrates a schematic diagram of a system in which mobile signal conversion may reside.

Specifically, multimedia information may be provided by any number of service providers 902a-b and delivered through network 904 to base station 906 to accommodate transmission of the multimedia information to cellular phone 908, among other devices. Ex. 1001, 14:66–15:4. Mobile

terminal signal conversion module (MTSCM) 912 resides within separate housing 910, outside cellular phone 908. Ex. 1001, 15:19–21. MTSCM 912 processes signals to accommodate reproduction by an external device, such as external display system 914. Ex. 1001, 15:25–26. Specifically, a multimedia signal is transmitted to cellular phone 908 through network 904. Ex. 1001, 15:26–28. MTSCM 912 receives the multimedia signal from cellular phone 908, by, for example, a cable connection. Ex. 1001, 15:36–51. MTSCM 912 processes the multimedia signal to provide a converted video signal that has a display format and/or signal power level appropriate for external display terminal 914 that is separate from cellular phone 908. Ex. 1001, 15:52–55. The display format and/or signal power level of external display terminal 914 may be different from that of cellular phone 908. Ex. 1001, 15:55–58.

C. Illustrative Claim

The '398 Patent includes 93 claims, of which claims 58 and 63 are challenged. Claims 58 and 63 depend ultimately from independent claim 15. Independent claim 15 is reproduced as follows:

15. A wireless terminal apparatus for converting and sending of content to devices, the apparatus comprising:
 - a processor; and
 - a memory, the memory storing program code executable by a processor to perform operations comprising:
 - receiving a multimedia content item originated from a source located outside a designated location and destined for a destination device located within the designated location, wherein the multimedia content item is received through a wireless communication network by the wireless terminal

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.