

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.
Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.
Patent Owner

INTER PARTES REVIEW OF U.S. PATENT NO. 6,108,704

Case IPR2014-01366 (Patent 6,108,704)

**PETITIONER'S REQUEST FOR REHEARING
UNDER 37 C.F.R. § 42.71(d)**

Mail Stop Patent Board
Patent Trial and Appeal Board
P.O. Box 1450
Alexandria, VA 22313-1450

I. INTRODUCTION

Pursuant to 37 CFR §42.71, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (“Petitioner”) respectfully requests rehearing of the Decision Instituting *Inter Partes* Review issued on March 6, 2015 (Paper 12, “Decision”) denying authorization of *inter partes* review of any claim of United States Patent No. 6,108,704 (“704 patent”) based upon any ground based in part on U.S. Patent No. 5,341,477 (“Pitkin”). The basis for this denial was the Board’s conclusion that grounds based in part on Pitkin are redundant to grounds relying on Microsoft Manual and NetBIOS.¹ Decision at 21-22.

Petitioner respectfully submits that the Board misapprehended the non-redundancy of grounds based in part on Pitkin because of the pending claim construction issues identified by the Board in its Decision. While the Board construed certain claim limitations using the broadest reasonable interpretation

¹ “Microsoft Manual” refers to MICROSOFT WINDOWS NT 3.5, TCP/IP User Guide (1994) (Ex. 1012 to the Petition), and “NetBIOS” refers to THE OPEN GROUP, Technical Standard, Protocols for X/Open PC Interworking: SMB, Version 2.0 (1992) (Ex. 1014 to the Petition) (“NetBIOS”).

(“BRI”) standard, the Decision indicates that these constructions are conditional and subject to change:

However, at the time of the final written decision, the ’704 patent will have expired, most likely, and we will apply the district court standard for claim construction as outlined in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). *Accordingly, Petitioner and Patent Owner should address the differences, if any, between the broadest reasonable construction and the construction applied by a district court so that we can address them when we render a final written decision.*

Decision at 6 (emphasis added). Thus, while the Decision applies a BRI standard, the final decision may apply the *Phillips* standard, which may result in a construction other than that identified in the Decision.

Petitioner asserted alternative grounds based in part of Pitkin in case the Board applied a more narrow construction. Because the Decision expressly stated it would consider more narrow constructions, instituting the grounds based in part on Pitkin will not result in any significant additional burden on the parties or on the Board. Further, no new argument or matter is introduced by instituting grounds

based in part on Pitkin, as such grounds are identified in the Petition. Petition² at 53-55.

II. STANDARD OF REVIEW

Pursuant to 37 C.F.R. § 42.71(c), [w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or ... a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co., Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988). The request must specifically identify all matters the party believes the Board “misapprehended or overlooked.” 37 C.F.R. § 42.71(d).

III. ARGUMENT

A. The grounds relying in part on Pitkin are not redundant.

The grounds based in part on Pitkin are not redundant of grounds relying upon Microsoft Manual and NetBIOS because the claim constructions identified in the Decision are conditional and subject to change. In fact, the grounds relying in part on Pitkin were identified in part for the possibility that Patent Owner’s proposed more narrow constructions for “connected to the computer network” and “on-line status” would be adopted by the Board, either in an institution decision or a final decision.

² Petition for *Inter Partes* Review of the ’704 patent (Paper 1) (“Petition”).

The Board provided constructions for certain claim limitations, including “connected to the computer network” and “on-line status”, Decision at 6-8, but left open the question as to the ultimate construction of this claim limitation and other claim limitations. Instead, the Board asked the parties to “address the differences, if any, between the broadest reasonable construction and the construction applied by a district court so that we can address them when we render a final written decision.” *See, infra*, at 2. Because the basis for denying institution of grounds based in part on Pitkin was that the Board construed “connected to the computer network” and “on-line status” broadly, the fact that these same constructions may change in a final decision renders grounds based in part on Pitkin non-redundant, as such grounds would become relevant in that situation.

More specifically, for the claim limitation “connected to the computer network” and “on-line status”, the Board found that this limitation “encompasses a processing unit that is ‘active and on-line at registration’” under the BRI standard. Decision at 6-8. This is consistent with Petitioner’s proposed construction under both the BRI standard and the *Phillips* standard and with determinations made in *Sipnet*.³ Decision at 8. In contrast, Patent Owner argues that this limitation should

³ *Sipnet EU S.R.O. v. Straight Path IP Group, Inc.*, IPR 2013-00246 (PTAB) (“*Sipnet*”).

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