

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., and
SAMSUNG TELECOMMUNICATIONS AMERICA, LLC,
Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.
Patent Owner.

Case IPR2014-01366
Patent 6,108,704

Before KALYAN K. DESHPANDE, TRENTON A. WARD, and
BART A. GERSTENBLITH, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

DECISION
Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Telecommunications America, LLC (collectively, “Petitioner”) filed a request for rehearing (Paper 14, “Req. Reh’g”) of the Board’s Decision on Institution (Paper 12, “Dec.”) dated March 6, 2015, which instituted *inter partes* review of claims 1, 11, 12, 14, 16, 22, 23, 27, 30, and 31 of U.S. Patent No. 6,108,704. Petitioner contends that the Board “misapprehended the non-redundancy grounds based in part on Pitkin because of the pending claim construction issues.” Req. Reh’g 1. For the reasons stated below, Petitioner’s request is denied.

II. STANDARD OF REVIEW

Under 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.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). The request must identify, specifically, all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

III. DISCUSSION

We determined in our Decision on Institution that, although for the purposes of determining whether to institute *inter partes* review we applied the broadest reasonable interpretation (“BRI”) standard for construing the claims, we will mostly likely apply the claim construction standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), in any final written decision, assuming the ’704 patent has expired at the time of the final written decision,

should one be issued. Dec. 6. We instituted *inter parties* review of claims 1, 11, 12, 22, and 23 as obvious over Microsoft Manual¹ and NetBIOS² and claims 14, 16, 27, 30, and 31 as obvious over Microsoft Manual, NetBIOS, and Palmer.³ Dec. 16–20.

Petitioner contends that the uninstituted grounds based in part on Pitkin are not redundant to the grounds relying on Microsoft Manual and NetBIOS because “the claim constructions identified in the Decision are conditional and subject to change.” Req. Reh’g 3. Petitioner argues that Pitkin was asserted in the event 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.” *Id.*

We are not persuaded that we misapprehended or overlooked this argument because this argument was not raised until this rehearing request. Although 37 C.F.R. § 42.71(d) permits a party to file a request for rehearing, it is not an opportunity to submit new arguments. Petitioner acknowledges that the Board’s construction for “connected to the computer network” and “on-line status” is consistent with Petitioner’s proposed construction under the BRI standard and *Phillips*. Req. Reh’g 4; *see* Pet. 20–21, 24–30. Petitioner now presents the argument that if a narrowed construction is provided for these terms, then the asserted grounds relying in part on Pitkin are not redundant. This argument was not previously presented. Furthermore, Petitioner presents the same construction

¹ MICROSOFT WINDOWS NT 3.5, TCP/IP USER GUIDE (1994) (Ex. 1012, “Microsoft Manual”).

² THE OPEN GROUP, TECHNICAL STANDARD, PROTOCOLS FOR X/OPEN PC INTERWORKING: SMB, VERSION 2.0 (1992) (Ex. 1014, “NetBIOS”).

³ U.S. Patent No. 5,375,068, issued Dec. 20, 1994 (Ex. 1020, “Palmer”).

under both BRI and *Phillips*. Accordingly, under the same claim construction, we properly determined that the grounds relying in part on Pitkin are redundant.

We remind Petitioner that our initial determinations on claim construction were provided in order to determine whether to institute *inter partes* review of the claims. If we render a final decision, it will include a final construction of the claims based on the complete evidence in the record.

Petitioner further argues that for similar reasons, grounds relying on Palmer, or Palmer and Pinard, are not redundant with the grounds relying on Microsoft Manual and NetBIOS. Req. Reh'g 6–7. We are not persuaded that we misapprehended or overlooked these arguments for the same reasons discussed above.

IV. CONCLUSION

The Board denies the relief requested in the request for rehearing.

V. ORDER

Accordingly, it is hereby

ORDERED that Petitioner's request for rehearing is *denied*.

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