

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 TELECOMMUNICATIONS AMERICA,  
LLC, and SAMSUNG AUSTIN SEMICONDUCTOR, LLC,

Petitioner,

v.

REMBRANDT WIRELESS TECHNOLOGIES, LP,  
Patent Owner.

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Case IPR2015-00114  
Patent 8,023,580 B2

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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 claims 2, 19, 49, 52, 53, and 59 of U.S. Patent No. 8,023,580 B2 (“the ’580 patent”) (Ex. 1201) 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 IPR2014-00518 (“IPR ’518”). Patent Owner Rembrandt Wireless Technologies, LP filed an opposition to the motion for joinder (Paper 8, “Opp.”) and a preliminary response (*see* Paper 10, “Prelim. Resp.”). Petitioner filed a reply to the motion for joinder. Paper 9 (“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 any of the challenged claims of the ’580 patent.

### A. Related Proceedings

According to Petitioner, the ’580 patent is involved in the following lawsuit: *Rembrandt Wireless Technologies, LP v. Samsung Electronics Co.*, No. 2:13-cv-00213 (E.D. Tex.). Pet. 1. The same parties and patent also are involved in *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, Case IPR2014-00514 (PTAB) (institution denied on Sept. 9, 2014); *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, Case IPR2014-00515 (PTAB) (institution denied on Sept. 9, 2014); *Samsung*

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*Electronics Co. v. Rembrandt Wireless Technologies, LP*, Case IPR2014-00518 (PTAB) (trial instituted on Sept. 23, 2014); and *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, Case IPR2015-00118 (PTAB).

### *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 modems use different types of modulation in a network. Ex. 1201, col. 1, ll. 19–23; col. 1, l. 56 – col. 2, l. 20.

### *C. Illustrative Claim*

Claim 49, the sole independent claim that is challenged, is reproduced below.

49. A computer-readable storage medium having computer executable instructions stored therein that when executed by a processor control a master transceiver, said computer executable instructions, comprising:

- first logic configured to transmit first information in a first modulation method for communication;
- second logic configured to transmit a first sequence to notify of a change from said first modulation method to a second modulation method;
- third logic configured to transmit second information in said second modulation method; and

fourth logic configured to transmit a second sequence after the second information is transmitted, wherein the second sequence is transmitted in the first modulation method and indicates that communication has reverted to the first modulation method.

*D. Prior Art*

Boer            US 5,706,428            Jan. 6, 1998            (Ex. 1204)

*E. Asserted Ground of Unpatentability*

Petitioner asserts the following ground of unpatentability as to claims 2, 19, 49, 52, 53, and 59 (Pet. 3): obviousness under 35 U.S.C. § 103(a) over Admitted Prior Art (“APA”)<sup>1</sup> and Boer.

## II. ANALYSIS

*A. Background*

In IPR ’518, Petitioner asserted that claims 2, 19, 49, 52, 53, and 59 of the ’580 patent were unpatentable over APA and Boer. IPR ’518, Paper 4 at 24–25, 27, 33–34, 36–44, 48–49, and 56–57. We did not institute an *inter partes* review of claims 2, 49, 52, 53, and 59 based on that ground in IPR ’518, and explained as follows:

Petitioner has not provided sufficient evidence or explanation in support of why the fact that Boer’s SIGNAL and SERVICE fields are always transmitted using DBPSK (the “first” modulation method) might demonstrate obviousness of the subject matter of claim 2. Petitioner has failed to show, in particular, how the SIGNAL and SERVICE fields might be

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<sup>1</sup> In this proceeding and in IPR ’518, Petitioner asserts that Patent Owner made admissions in the ’580 patent disclosure and in the prosecution history of a parent application regarding prior art. Pet. 6–8; IPR ’518, Paper 4 at 5–7.

deemed, as alleged, to “indicate” that communication from the master to the slave has reverted to the first modulation method, as recited in claim 2.

Independent claim 49, from which challenged claims 52 and 53 depend, recites a similar limitation with respect to how a sequence “indicates” that communication has reverted to the first modulation method. Petitioner relies, again, on Boer’s description of header 218 being always transmitted using the “first” modulation method. Petitioner’s asserted ground of obviousness with respect to claim 49, thus, fails for the same reasons as that of claim 2.

Claim 59, which depends from independent claim 58, also recites a third sequence that is transmitted in the first modulation method that “indicates” communication from the master to the slave has reverted to the first modulation method. Petitioner submits, correctly, that Boer teaches that the SIGNAL and SERVICE fields in the header “indicate which modulation method is used to transmit DATA field 218.” “When Boer is combined with the APA, it could therefore indicate that communication from the master to the slave has reverted to the first modulation method.” Mr. Goodman repeats that “it could therefore indicate” that communication has reverted to the first modulation method and concludes, “[t]herefore, it is my opinion that claim 59 is obvious in view of the prior art.” Although it appears that Petitioner attempts to provide more explanation in its challenge of dependent claim 59, as compared with that of claim 2 or 49, we are not persuaded there is a reasonable likelihood that Petitioner would prevail in its challenge of any of claims 2, 49, and 59.

IPR ’518, slip op. at 14–15 (PTAB Sept. 23, 2014) (Paper16) (citations to record omitted). Nor did we institute an *inter partes* review of claim 19 on the obviousness ground over APA and Boer because Petitioner’s allegation that station 18 (Ex. 1204, col. 2, ll. 19–27; Fig. 1) can receive a “first” (DBPSK) modulation method transmission failed to demonstrate the obviousness of the *transceiver* which, according to claim 1, sends

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