

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.
Petitioner,

v.

ATI TECHNOLOGIES ULC
Patent Owner.

Case IPR2015-01620
Patent 7,095,945 B1

PATENT OWNER PRELIMINARY RESPONSE

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

I. INTRODUCTION 1

II. BACKGROUND 5

 A. '945 patent overview5

 B. Claim 215

III. A PERSON OF ORDINARY SKILL IN THE ART (“POSA”)..... 6

IV. LG’s Petition is procedurally barred 7

 A. LG’s second Petition is time barred and LG does not deserve a second bite at the apple.7

 B. The second Petition and LG’s first Petition are entirely redundant.9

V. LG STILL FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD THAT IT WILL PREVAIL 12

 A. Overview of Hatanaka.....12

 B. All of LG’s obviousness grounds against claim 21 are deficient.20

 1. Deficiencies of Hatanaka. 21

 2. It would not have been obvious to combine Hatanaka and Hoogenboom to arrive at claim 21, because the combination would have required significant reconstruction..... 30

 3. Anderson does not teach “a first clock recovery module ... wherein the first clock recovery module is to generate a clock at the output ... before the select packets are stored in the storage device.” 34

VI. CONCLUSION..... 39

Exhibit List

Exhibit Number	Document Description
2001	Invalidity Contentions served by Counsel for LG Electronics, Inc. <i>et al.</i> , dated October 2, 2014, Case No. 3:14-cv-1012-SI
2002	Exhibit I-01 (945) US5517250 - Hoogenboom Service Chart
2003	IPR2015-00321, Institution Decision, Paper No. 20
2004	“A consumer digital VCR for digital broadcasting” by Hatanaka et al. (1998)
2005	“A consumer digital VCR for advanced television” by Okamoto et al. (1993)
2006	“A consumer digital VCR for digital broadcasting” by Okamoto et al. (1995)

I. INTRODUCTION

Patent Owner, ATI Technologies ULC (hereafter “Patent Owner”), hereby respectfully submits this Patent Owner Preliminary Response. This filing is timely under 35 U.S.C. §§ 311–319 and 37 C.F.R. § 42.120, because it was filed by November 6, 2015.

This is the second of two IPR petitions that Petitioner LG Electronics, Inc. (hereafter “LG”) has filed against Patent Owner’s U.S. Patent 7,095,945 (“the ‘945 patent”¹). The Board should deny institution, because: (i) this Petition is time-barred; (ii) this Petition is redundant; and (iii) LG still has not shown a reasonable likelihood that it would prevail with respect to claim 21.

First, the Board should exercise its discretion and deny LG’s second Petition against the ’945 patent, because LG is time-barred from bringing this Petition under 35 U.S.C. § 315(b). This Petition was filed more than a year after LG was served with a complaint alleging infringement of the ’945 Patent. On July 24, 2015, more than sixteen months after Patent Owner served LG with the complaint (and after previously failing in its challenge of claim 21 in IPR2015-00321), LG filed this second Petition for *inter partes* review of the ’945 Patent. Paper 2. LG also filed a motion to join this proceeding with IPR2015-00321. Paper 3. Patent Owner opposed that motion. Paper 7. LG seeks joinder in an effort to circumvent

¹ IPR2015-00321 was filed on December 10, 2014.

the § 315(b) one-year statutory bar.

The Board should exercise its discretion and deny this second Petition. The Board has repeatedly denied joinder where a petitioner attempts, as is the case here, to use a prior institution decision as a roadmap to remedy unsuccessful challenges advanced in a first petition. The Board has been especially critical of such tactics by petitioners when the follow up petition would be time-barred under § 315(b), absent joinder. *See, e.g., Medtronic, Inc. et al. v. Endotach LLC*, IPR2014-00695, Paper 18, pp. 3-4 (P.T.A.B. Sept. 25, 2014).

Second, LG's second Petition and first Petition are redundant. LG has already failed to get trial instituted on three grounds of rejection against claim 21 in its first Petition. LG now proposes two more grounds of rejection without explaining how this second Petition is not an improper circumvention of the IPR rules. Hence, consistent with previous Board rulings, the Board should also find this second Petition redundant.

Finally, after failing in its initial challenge of claim 21, LG still has not established a reasonable likelihood of prevailing with any of its new proposed grounds against claim 21. LG has not shown how Hatanaka in combination with either Hoogenboom or Anderson renders claim 21 obvious. Although LG has advanced Hoogenboom and Anderson specifically to address the shortcomings identified in its first Petition against the '945 patent, Hatanaka still suffers from

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.