

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., and APPLE INC.,
Petitioner,

v.

ROSETTA-WIRELESS CORPORATION,
Patent Owner.

Case IPR2016-00622¹
Patent 7,149,511 B1

Before JUSTIN T. ARBES, PATRICK R. SCANLON, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* HUDALLA.

Opinion Dissenting filed by *Administrative Patent Judge* ARBES.

HUDALLA, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71(d)

¹ Case IPR2016-00616 has been consolidated with this proceeding.

I. INTRODUCTION

On September 19, 2017, Patent Owner, Rosetta-Wireless Corporation (“Rosetta”), filed a request for rehearing (Paper 49, “Req. Reh’g”) of our Final Written Decision (Paper 48, “Final Dec.”), in which the Majority held that Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Apple Inc. (collectively “Petitioner”) had shown by a preponderance of the evidence the unpatentability of claims 1–10, 19–22, 58–65, and 68–71 of U.S. Patent No. 7,149,511 B1 (Ex. 1001, “the ’511 patent”).² Final Dec. 72–73. For the reasons explained below, Rosetta’s request for rehearing is *denied*.

II. ANALYSIS

The party requesting rehearing has the burden of showing the decision should be modified, which includes specifically identifying all matters the party believes we misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply. *See* 37 C.F.R. § 42.71(d).

A. *Purported Violation of 35 U.S.C. § 318(a)*

Rosetta’s first argument relates to our Decision on Institution in IPR2016-00616. Rosetta highlights that Petitioner challenged claims 7 and 64 of the ’511 patent over Kimura in IPR2016-00616, but we did not institute *inter partes* review on the Kimura ground as to these claims. Req. Reh’g 2. As a result, Rosetta contends our Final Written Decision violates

² Judge Arbes filed a dissent.

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35 U.S.C. § 318(a), which states a Final Written Decision should be issued “with respect to the patentability of any patent claim challenged by the petitioner.” *Id.* Rosetta cites to a pending case before the U.S. Supreme Court that has taken up a similar issue. *Id.* (citing *SAS Institute Inc. v. Lee*, 137 S. Ct. 2160 (2017)). Accordingly, Rosetta contends our Final Written Decision “is invalid and must be vacated.” *Id.* at 3.

Rosetta never made arguments during trial about how any final written decision issuing in these proceedings would be “invalid” under § 318(a) based on a failure to institute *inter partes* review of claims 7 and 64 on the Kimura ground. Nor does Rosetta’s request for rehearing attempt to identify such arguments in the trial record. We additionally observe that neither party requested rehearing of our Decision on Institution in IPR2016-00616. As such, we could not have misapprehended or overlooked this issue.

Moreover, our Final Written Decision addressed the patentability of claims 7 and 64 challenged by Petitioner and, as such, included a decision with respect to the patentability of those claims in this consolidated proceeding. Final Dec. 72–73. Namely, the Majority determined, *inter alia*, that claims 7 and 64 are unpatentable under 35 U.S.C. § 103(a) over Goggin. *Id.* at 72. Although the challenge based on Kimura to claims 7 and 64 from the Petition in IPR2016-00616 was not addressed in our Final Written Decision, Rosetta does not argue persuasively that § 318(a) requires a final written decision to address every ground of unpatentability raised in a petition, or, as in this case, two consolidated petitions.

B. Purported Unconstitutionality of Inter Partes Review

With its second argument, Rosetta argues that a patent is a personal property right. Req. Reh’g 4–5. Thus, Rosetta contends “[i]nter partes review is an adjudicatory proceeding which, as in this case, may result in extinguishment of a patentee’s property rights by action of the Board and without the right to trial by jury.” *Id.* at 3. According to Rosetta, this violates the Seventh Amendment and Article III of the Constitution. *Id.* Rosetta cites to a pending case before the U.S. Supreme Court that has taken up this issue. *Id.* (citing *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 137 S. Ct. 2239 (2017)). Accordingly, Rosetta asks us to vacate our Final Written Decision. *Id.* at 6.

Rosetta never made arguments during trial about the purported unconstitutionality of *inter partes* review. Nor does Rosetta’s request for rehearing attempt to identify such arguments in the trial record. As such, we could not have misapprehended or overlooked this issue.

III. CONCLUSION

For the reasons above, we conclude that Rosetta has not met its burden of showing that we misapprehended or overlooked any of Rosetta's arguments regarding (1) a purported violation of 35 U.S.C. § 318(a) based on our decision not to institute *inter partes* review of claims 7 and 64 of the Kimura ground in IPR2016-00616, and (2) the purported unconstitutionality of *inter partes* review. We, therefore, *deny* Rosetta's request to vacate our Final Written Decision.

IV. ORDER

Accordingly, it is:

ORDERED that Rosetta's Request for Rehearing is *denied*.

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