

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD,
Petitioner,

v.

UUSI, LLC d/b/a NARTRON,
Patent Owner.

Case IPR2016-00908
Patent 5,796,183

Before THOMAS L. GIANNETTI, CARL M. DEFRANCO, and
KAMRAN JIVANI, *Administrative Patent Judges*.

JIVANI, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

INTRODUCTION

In a decision dated June 12, 2019, the United States Court of Appeals for the Federal Circuit remanded this case to us to consider the patentability of claims 37–39 of U.S. Patent No. 5,796,183 (the “’183 patent”). *Samsung Electronics Co., Ltd., v. UUSI, LLC, DBA Nartron*, 2018-1310 *10 (Fed. Cir. June 18, 2019). This Order is being entered pursuant to those instructions.

BACKGROUND AND ANALYSIS

Among its challenges in this proceeding, Petitioner challenged claims 37–39 of the ’183 patent as obvious over *Ingraham I*, *Caldwell*, and *Gerpheide*.¹ Pet. 3.

We determined in our Decision on Institution (Paper 12) that Petitioner had demonstrated a reasonable likelihood of prevailing on its challenges to various other claims of the ’183 patent, but not on its challenge to claims 37–39.² Dec. on Inst. 31. In particular, we determined, “based on the context of the supply voltage limitation in [independent claim 37], that one of ordinary skill in the art would understand the term . . . ‘supply voltage’ as referring to a supply voltage of the oscillator.” Dec. on Inst. 9. We further found that Petitioner had identified the 15V supply voltage for microcomputer 80, generated by *Ingraham I*’s power supply 70, as meeting the claimed supply voltage. *Id.* at 15. We determined that this identification

¹ *Ingraham*, U.S. Patent No. 5,087,825, issued Feb. 11, 1992, (Ex. 1007, “*Ingraham I*”); *Caldwell*, U.S. Patent No. 5,594,222, issued Jan. 14, 1997 (Ex. 1009, “*Caldwell*”); and *Gerpheide et al.*, U.S. Patent No. 5,565,658, issued Oct. 15, 1996 (Ex. 1012, “*Gerpheide*”).

² We instituted review of claims 40, 41, 43, 45, 47, 48, 61–67, 69, 83–86, 88, 90, 91, 94, 96, 97, 99, 101, and 102. Inst. Dec. 31.

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was insufficient because “[t]he supply voltage limitation of claim 37 . . . refers to a supply voltage of the claimed oscillator, not the claimed microcontroller.” *Id.* Thus, we originally declined to institute review of claim 37 and its dependent claims 38 and 39 in light of our construction of the claimed supply voltage as “refer[ring] to the supply voltage of the oscillator.” *Id.*

After institution, we proceeded through trial and an oral hearing was conducted on June 22, 2017.

On December 13, 2017, we entered a Final Written Decision concluding that Petitioner had not shown by a preponderance of the evidence that the instituted claims were unpatentable. Paper 35, 24. Petitioner appealed our Decision to the Federal Circuit, which vacated our Decision and remanded the matter back to us to “consider whether Samsung has shown that there would have been a reasonable expectation of success in combining the teaching of Gerpheide with the teachings of Ingraham/Caldwell to arrive at the claimed invention.” *Samsung Electronics Co., Ltd., v. UUSI, LLC, DBA Nartron*, 2018-1310, at *9 (Fed. Cir. June 18, 2019). The Court further instructed us to “consider the patentability of claims 37, 38, and 39” (*id.* at 10) because, on April 24, 2018, the Supreme Court of the United States held that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018).

Pursuant to the Federal Circuit’s instruction in this case and in light of *SAS Inst., Inc.*, we modify our Decision on Institution to institute review of claims 37–39 of the ’183 patent as rendered obvious over Ingraham I, Caldwell, and Gerpheide.

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ORDER

IT IS, therefore,

ORDERED that our Institution Decision (Paper 12) is modified to include institution of *inter partes* review of claims 37–39 of the '183 patent as obvious over Ingraham I, Caldwell, and Gerpheide.

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PETITIONER:

Naveen Modi
Joseph Palys
Chetan Bansal
PAUL HASTINGS LLP
naveenmodi@paulhastings.com
josephpalys@paulhastings.com
chetanbansal@paulhastings.com

PATENT OWNER:

Stephen Underwood
GLASER, WEIL, FINK, HOWARD
AVCHEN, & SHAPIRO LLP
sunderwood@glaserweil.com