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Paper 50
Date: September 17, 2020

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.

IPR2016-00908
Patent 5,796,183

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

JIVANI, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision on Remand
Determining Some Challenged Claims Unpatentable
35 U.S.C. §§ 314, 318

I. INTRODUCTION

A. Background and Summary

Samsung Electronics Co., Ltd., ("Petitioner") sought *inter partes* review of claims 37–41, 43, 45, 47, 48, 61–67, 69, 83–86, 88, 90, 91, 94, 96, 97, 99, 101, and 102 of U.S. Patent No. 5,796,183 (Ex. 1001, "the '183

patent"), owned by UUSI, LLC d/b/a Nartron ("Patent Owner"). Paper 2 ("Petition" or "Pet."). Patent Owner filed a Preliminary Response. Paper 10 ("Prelim. Resp."). Upon consideration of the Petition and Preliminary Response, we instituted an *inter partes* review of claims 40, 41, 43, 45, 47, 48, 61–67, 69, 83–86, 88, 90, 91, 94, 96, 97, 99, 101, and 102 (the "Earlier Instituted Claims") pursuant to 35 U.S.C. § 314. Paper 12 ("Decision on Institution" or "Dec. on Inst."). We did not institute, however, an *inter partes* review of claims 37–39 at that time because we determined Petitioner had not established a reasonable likelihood that it would prevail with respect to those claims. *Id.*

Petitioner sought rehearing of our decision denying review of claims 37–39 because, according to Petitioner, we erred in our construction of the term "supply voltage," as recited in independent claim 37. Paper 14, 1. Having considered Petitioner's arguments for rehearing, we denied its request and maintained our preliminary construction of the term "supply voltage," as recited in claim 37. Paper 17, 5–7.

During the trial, Patent Owner filed a Patent Owner Response (Paper 21, "PO Resp."), and Petitioner filed a Reply thereto (Paper 24, "Reply"). An oral hearing was conducted on June 22, 2017. The record contains a transcript of the hearing (Paper 34). 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 United States Court of Appeals for the Federal Circuit, which vacated our Decision and remanded the matter to us. *Samsung Elecs. Co. v. UUSI, LLC*, 775 F. App'x 692 (Fed. Cir. 2019). As to the earlier instituted claims, the Court instructed that we

should 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 [I]/Caldwell to arrive at the claimed invention." *Id*. at 697. The Court further instructed us to "consider the patentability of claims 37, 38, and 39" (*id.*) 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 fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

Pursuant to the Federal Circuit's instruction in this case and in light of *SAS Inst., Inc.*, we modified our Decision on Institution to institute review of claims 37–39 of the '183 patent as obvious over Ingraham I, Caldwell, and Gerpheide. Paper 40. We further held a teleconference on August 15, 2019, with respective counsel for the parties, to hear their proposals on how to proceed with this trial. Paper 41, 2. Having considered the parties' proposals, we authorized the parties to submit concurrent briefs and subsequent responses addressing the following issues (*id.* at 6):

(1) the Federal Circuit's determination in the context of the Earlier Instituted Claims that "the claims are not limited to situations in which different frequencies are provided to different rows" and that "[a] reasonable expectation of success thus only requires that different frequencies be provided to the entire pad;"

(2) whether Petitioner has shown that there would have been a reasonable expectation of success in combining the teaching of Gerpheide with the teachings of Ingraham I, Caldwell, and Wheeler (in certain instances) to arrive at the inventions of the Earlier Instituted Claims;

(3) our construction in our Decision on Institution of the term "supply voltage," as recited in independent claim 37; and

(4) whether Petitioner has shown by a preponderance of the evidence that claims 37–39 are rendered obvious over the asserted combination of Ingraham I, Caldwell, and Gerpheide.

On October 3, 2019, Petitioner submitted its Opening Brief on Remand (Paper 43, "Pet. Br.") and Patent Owner submitted its Opening Brief on Remand (Paper 44, "PO Br."). The parties filed cross responses on October 17, 2019. Paper 45 ("PO Remand Resp."); Paper 46 ("Pet. Remand Resp.").

On December 11, 2019, with our prior authorization, Petitioner filed a brief addressing Patent Owner's statements in co-pending proceeding IPR2019-00358, which reviews certain claims of the '183 patent. Paper 47. Patent Owner filed an opposition thereto on December 13, 2019. Paper 49.

We have jurisdiction under 35 U.S.C. § 6(b). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) as to the patentability of the challenged claims before us on remand. Based on the complete trial record, Petitioner has shown by a preponderance of the evidence that claims 40, 41, 43, 45, 47, 48, 61–67, 69, 83–86, 88, 90, 91, 94, 96, 97, 99, 101, and 102 are unpatentable. Petitioner has failed to show by a preponderance of the evidence that claims 37–39 are unpatentable.

B. Real Parties in Interest

Petitioner identifies Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc., as real parties in interest. Pet. 1. Patent Owner identifies only itself, namely UUSI, LLC d/b/a/ Nartron, as a real party interest. Paper 7, 1. Neither party contests these identifications.

C. Related Matters

The '183 patent has been subject to two reexaminations: *Ex Parte* Reexamination Control Nos. 90/012,439, certificate issued April 29, 2013

("Reexam 1") and 90/013,106, certificate issued June 27, 2014 ("Reexam 2"). Claims 37–39 were added during Reexam 1, where the Earlier Instituted Claims were added during Reexam 2. Ex. 1006, 2–3; Ex. 1007, 27–28.

Claims 37–39, 94, 96–99, 101–109, and 115–117 of the '183 patent are the subject of an *inter partes* review pending before this Board on grounds applying art not at issue in this proceeding. *Apple, Inc. v. UUSI, LLC d/b/a Nartron*, IPR2019-00358, Paper 12 at 11–12 (PTAB Aug. 5, 2019) (Decision on Institution). Further, claims 27, 28, 32, 36, 83–88, and 90–93 of the '183 patent are the subject of an *inter partes* review pending before this Board on grounds applying art not at issue in this proceeding. *Apple, Inc. v. UUSI, LLC d/b/a Nartron*, IPR2019-00359, Paper 12 at 12 (PTAB Aug. 5, 2019) (Decision on Institution).

The '183 patent is the subject of ongoing litigation between the parties in the Western District of Michigan: *UUSI, LLC d/b/a Nartron v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc*., Case No. 1:15-cv-00146-JTN, originally filed on February 13, 2015 (W.D. Mich.) (the "District Court litigation"). Pet. 1. The District Court litigation is stayed and administratively closed until resolution of this *inter partes* review. Order, Case No. 1:15-cv-00146-JTN, Dkt. No. 137 (filed Jan. 13, 2017).

D. The '183 Patent

The '183 patent, titled "CAPACITIVE RESPONSIVE ELECTRONIC SWITCHING CIRCUIT," was filed January 31, 1996, and issued August 18, 1998. Ex. 1001, codes [22], [45], [54]. The '183 patent has expired. Pet. 11; Prelim. Resp. 7.

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