

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

IMAGE PROCESSING TECHNOLOGIES LLC,
Patent Owner.

Case IPR2017-00336
Patent 6,959,293 B2

Before JONI Y. CHANG, MICHAEL R. ZECHER, and
JESSICA C. KAISER, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

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

On February 6, 2018, a conference call was held between respective counsel for the parties and Judges Chang, Zecher, and Kaiser. The purpose of the conference call was to discuss Patent Owner’s request for leave to file a motion to terminate *ex parte* reexamination Control No. 90/014,056 (“the ’056 Reexamination”), which involves only claim 1 of U.S. Patent No. 6,959,293 B2 (Ex. 1001, “the ’293 patent”). Patent Owner also requested an expedited briefing schedule if we authorize the motion. For the reasons stated below, Patent Owner’s requests are *denied*.

During the conference call, Patent Owner urged us to exercise our discretion under 35 U.S.C. § 315(d)¹ to terminate the ’056 Reexamination. Patent Owner argued that the ’056 Reexamination is Petitioner’s third challenge to the ’293 patent, using our Institution Decisions in the instant proceeding and Case IPR2017-01189 (“the ’189 IPR”) as a “roadmap” to bolster previously unsuccessful arguments. In support of its argument, Patent Owner cites two Board decisions, *Ariosa* and *General Plastic*. *Ariosa Diagnostics, Inc. v. Illumina, Inc.*, Case IPR2014-01093, slip op. at 13–16 (PTAB May 24, 2016) (Paper 81) (The panel exercised its discretion to terminate three reexaminations filed by a party after entering a final written decision against that same party in one of the IPR proceedings that involved the same claims.); *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, slip op. at 15–19 (PTAB Sept. 6, 2017) (Paper 19)

¹ Under 35 U.S.C. § 315(d), “[n]otwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an inter partes review, if another proceeding or matter involving the patent is before the Office, *the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.*” 35 U.S.C. § 315(d) (emphases added).

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(precedential) (The panel exercised its discretion under 35 U.S.C. § 314(a) to deny the follow-on petitions filed by the same petitioner that challenged the same claims as those involved in the first set of petitions.).

Petitioner countered that its Petitions and Request for Reexamination do not amount to harassment of patent owner. We agree with Petitioner.

Unlike *Ariosa* and *General Plastic* each of which involves the *same claims* in multiple proceedings, the two IPR Petitions filed by Petitioner here involve *different claims*. Indeed, the instant Petition challenges claims 1, 18, 19, 22, and 29, whereas the '189 IPR involved claims 2–17, 20, 21, and 23–28. Petitioner explained that the challenged claims of the instant Petition are those initially asserted by Patent Owner in the related District Court proceeding,² whereas the challenged claims in the '189 IPR are those subsequently asserted by Patent Owner in amended infringement contentions.

More importantly, unlike the particular facts in *Ariosa* and *General Plastic*, the '189 IPR Petition clearly was not an attempt to perfect the Petition filed in the instant proceeding. Notably, Petitioner filed the '189 IPR Petition on March 15, 2017, *before* we entered the Institution Decision on May 25, 2017, in the instant proceeding. In contrast, the follow-on petitions in *General Plastic* were filed *after* the decisions denying the first set of petitions. Therefore, Petitioner here did not have the benefit of our Institution Decision at the time of filing the '189 IPR Petition, much less the advantage of the Patent Owner's response or the cross-examination of Patent Owner's expert, as in *Ariosa*.

² The '293 patent is involved in *Image Processing Techs., LLC v. Samsung Elecs. Co.*, Case No. 2:16-cv-00505-JRG (E.D. Tex.). Paper 4, 2.

Additionally, in *Ariosa*, the panel terminated the three reexaminations *after* the entry of a final written decision under 35 U.S.C. § 318(a) which concluded that the petitioner had failed to demonstrate that the same challenged claims are unpatentable; under 35 U.S.C. § 315(e), the petitioner “may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.” Here, in contrast, we have not yet entered a final written decision in the instant proceeding, and we denied institution in the ’189 IPR.

Futhermore, the Request filed in the ’056 Reexamination challenges only claim 1 based on *different grounds*—e.g., asserting claim 1 is unpatentable over Hirota³ alone. Ex. 3001, 3, 14–15.⁴ Hirota was not asserted in either the instant proceeding or the ’189 IPR. Petitioner also explained that the Request for Reexamination did not use our Institution Decision as a “roadmap,” but merely adopted our claim constructions set forth in the Institution Decisions, using the broadest reasonable interpretation standard as in both IPR proceedings. Moreover, we did not institute the instant proceeding as to claim 1, and Petitioner did not challenge claim 1 in the ’189 IPR. Therefore, even if we had entered a final written decision in either IPR proceeding, Petitioner would not have been precluded from maintaining the ’056 Reexamination with respect to claim 1 under 35 U.S.C. § 315(e)(1), as in *Ariosa*.

³ U.S. Patent No. 6,118,895 issued on September 12, 2000.

⁴ Decision Ordering Reexamination entered on January 26, 2018, in the ’056 Reexamination. Our citations refer to the original page numbers on the upper right corner.

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Upon consideration of the totality of the circumstances, we decline to exercise our discretion to authorize Patent Owner to file a motion to terminate the '056 Reexamination. Consequently, no expedited briefing schedule regarding this issue is authorized.

ORDER

In view of the foregoing, it is

ORDERED that Patent Owner's request for authorization to file a motion to terminate the '056 Reexamination is *denied*; and

FURTHER ORDERED that Patent Owner's request for an expedited briefing schedule for such a motion is *denied*.

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