

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

IMAGE PROCESSING TECHNOLOGIES LLC,  
Patent Owner.

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Case IPR2017-00336  
Patent 6,959,293 B2

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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)*

Petitioner filed a Petition requesting an *inter partes* review of claims 1, 18, 19, 22, and 29 (“the challenged claims”) of U.S. Patent No. 6,959,293 B2 (Ex. 1001). Paper 2 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 6.

In its Petition, Petitioner asserts the following grounds of unpatentability (Pet. 3):

Challenged Claims	Basis	References
1, 18, 19, 22, and 29	§ 103(a)	Pirim alone <sup>1</sup> or in combination with Tomitaka
1, 18, 19, 22, and 29	§ 103(a)	Rogers and Gilbert
1, 18, 19, 22, and 29	§ 103(a)	Tomitaka and Rogers

Upon review of the Petition and Preliminary Response, we determined that the information presented in the Petition established that there was a reasonable likelihood that Petitioner would prevail with respect to challenging claim 22, but not with respect to challenging claims 1, 18, 19, and 29. Paper 15, 53. Consequently, on May 25, 2017, we entered an Institution Decision, instituting an *inter partes* review only as to claim 22, but not with respect to claims 1, 18, 19, and 29, and for the sole ground that claim 22 is unpatentable under § 103(a) as obvious over Pirim. *Id.*

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 Institute Inc. v. Iancu*, 2018 WL 1914661, at \*10 (U.S. Apr. 24, 2018). In light of the Guidance on the

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<sup>1</sup> Petitioner’s substantive analysis for claim 22 relies upon Pirim alone. Pet. 49–51.

Impact of SAS on AIA Trial Proceedings posted on April 26, 2018 (at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>), we modify our Institution Decision to institute on *all of the challenged claims* and *all of the grounds* presented in the Petition.

On May 1, 2018, a conference call was held between respective counsel for the parties and Judges Chang, Zecher, and Kaiser, to discuss whether the parties would request additional briefing and/or schedule adjustments based on SAS. We discussed the procedural posture of the instant proceeding, noting that an oral hearing was held on February 21, 2018, and the final written decision is due in less than a month, on May 25, 2018, unless the 1-year statutory time period is extended. Upon inquiry, both parties affirmatively waived additional briefing and schedule adjustments.

In consideration of the foregoing, it is hereby:

ORDERED that our Institution Decision (Paper 15) is modified to include review of all of the challenged claims and all of the grounds presented in the Petition (Pet. 3, 49–51):

<b>Challenged Claims</b>	<b>Basis</b>	<b>References</b>
22	§ 103(a)	Pirim alone
1, 18, 19, and 29	§ 103(a)	Pirim in combination with Tomitaka
1, 18, 19, 22, and 29	§ 103(a)	Rogers and Gilbert
1, 18, 19, 22, and 29	§ 103(a)	Tomitaka and Rogers

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