

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 May 25, 2017, we entered an Institution Decision, instituting an *inter partes* review only as to claim 22 of U.S. Patent No. 6,959,293 B2 (Ex. 1001, “the ’293 patent”), but not with respect to claims 1, 18, 19, and

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29 and for the sole ground that claim 22 is unpatentable under 35 U.S.C. § 103(a) as obvious over Pirim.¹ Paper 15, 53.

On February 6, 2018, Patent Owner requested authorization to file a motion to terminate *ex parte* reexamination Control No. 90/014,056 (“the ’056 Reexamination”), arguing that Petitioner’s Reexamination Request was its third challenge to the ’293 patent and used our Institution Decisions in the instant proceeding and Case IPR2017-01189 (“the ’189 IPR”) as a “roadmap” to bolster previously unsuccessful arguments. Paper 31, 2. Petitioner countered that its Petitions and Reexamination Request do not amount to harassment of Patent Owner. *Id.* at 3. For the reasons stated in our prior Order, we agreed with Petitioner, and declined to exercise our discretion to authorize Patent Owner to file a motion to terminate the ’056 Reexamination. *Id.* at 3–5.

On April 24, 2018, the United States Supreme Court 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*, 138 S. Ct. 134 (2018). In light of the Guidance on the Impact of SAS on AIA Trial Proceedings, we modified our Institution Decision to institute on all of the challenged claims and all of the grounds presented in the Petition, including claims 1, 18, 19, and 29. Paper 37.

On May 9, 2018, we entered a Final Written Decision, determining that Petitioner has demonstrated by a preponderance of the evidence that claim 22 is unpatentable, but not that claims 1, 18, 19, and 29 are unpatentable. Paper 38.

¹ WO 99/36893, issued July 22, 1999 (Ex. 1005).

On May 31, 2018, a conference call was held between respective counsel for the parties and Judges Chang, Zecher, and Kaiser. During the conference call, Patent Owner renewed its request for leave to file a motion to terminate the '056 Reexamination. For the reasons stated below, Patent Owner's request is *denied*.

Like its prior request, Patent Owner urged us to exercise our discretion under 35 U.S.C. § 315(d)² to terminate the '056 Reexamination. *See* Paper 31, 2. In support of its argument, Patent Owner again cited to 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) (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.).

Patent Owner's reliance on these cases is misplaced here. For the same reason stated in our prior Order (Paper 31, 3–4), we are not convinced that Petitioner's IPR Petitions and Request for Reexamination amount to

² 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).

harassment of Patent Owner. 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. As Petitioner explained, the challenged claims in the instant proceeding are those initially asserted by Patent Owner in the related district court case,³ 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 was not an attempt to perfect the instant Petition, as the '189 IPR Petition was filed before the entry of the Institution Decision in the instant proceeding. 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*.

In addition, as noted in our prior Order, Petitioner's Reexamination Request challenges only claim 1 based on different grounds. Paper 31, 4. Because claims 1, 18, 19, 22, and 29 were denied institution initially, Patent Owner's Response did not include any argument or expert testimony as to these claims. Paper 37, 2 (noting that both parties affirmatively waived briefing as to these newly instituted claims). Hence, Petitioner did not have the advantage of the Patent Owner's Response or the cross-examination of Patent Owner's expert regarding claim 1 at the time of filing the Request for Reexamination. Moreover, merely notifying the Examiner in the '056 Reexamination of our claim construction in this instant proceeding (Paper

³The '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.

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15, 10) does not amount to using our Institution Decision as a “roadmap” to bolster previously unsuccessful arguments, as Patent Owner alleges.

We also are not convinced by Patent Owner’s argument that the ’056 Reexamination causes unnecessary delay to the related district court case, which has been stayed in view of the proceedings before the Office. As Patent Owner conceded during the conference call, Patent Owner requested an extension of time for filing a response to the Examiner’s Office Action that was mailed on March 26, 2018. Furthermore, in the related district court case, Patent Owner also asserted two other patents, U.S. Patent Nos. 6,717,518 B1 and 8,983,134 B2, which are involved in two other IPR proceedings, Cases IPR2017-01190 and IPR2017-01218, respectively. The final written decisions for these IPR proceedings are not due until October 3, 2018.

Upon consideration of the totality of the circumstances, we once again decline to exercise our discretion to authorize Patent Owner to file a motion to terminate the ’056 Reexamination.

ORDER

In view of the foregoing, it is

ORDERED that Patent Owner’s renewed request for authorization to file a motion to terminate the ’056 Reexamination is *denied*.

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