

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*.

DECISION

Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71(d)

Patent Owner requests rehearing of the Order (Paper 39), denying Patent Owner's renewed request for authorization to file a motion to terminate *ex parte* reexamination Control No. 90/014,056 ("the '056 Reexamination"). Paper 40, "Req. Reh'g." Patent Owner also "suggests

that an expanded panel be convened (SOP 1, rev. 14, § III.C).” *Id.* at 3. For the reasons discussed below, Patent Owner’s Request for Rehearing is *denied*, and its suggestion to convene an expanded panel is *denied*.

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify specifically all matters we misapprehended or overlooked, and the place where each matter was previously addressed. *Id.* When rehearing an interlocutory decision, a panel will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(b); *see also Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329 (Fed. Cir. 2018) (“The Board’s administration of its rules for trial proceedings is reviewed for an abuse of discretion.”). The Board abuses its discretion if the decision: (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 442 (Fed. Cir. 2015) (quoting *Abrutyn v. Giovanniello*, 15 F.3d 1048, 1050–51 (Fed. Cir. 1994)).

Here, in its Request for Rehearing, Patent Owner contends that we overlooked or misapprehended Patent Owner’s arguments that *NVIDIA*¹ factors set forth in *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, slip op. 15–16 (PTAB Sept. 6, 2017) (Paper 19) (precedential) (hereinafter “*General Plastic*”) should be applied and that such factors weigh heavily in favor of termination of the ’056 Reexamination. Req. Reh’g. 1–3.

¹ *NVIDIA Corp. v. Samsung Elec. Co.*, Case IPR2016-00134 (PTAB May 4, 2016) (Paper 9) (hereafter, “*NVIDIA*”).

As we noted in our Order (Paper 39, 3), however, *General Plastic* makes clear that the Board “exercised [its] discretion not to institute pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a)”² each of the follow-on petitions for *inter partes* review. Section 6(a) of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 314. The amended 35 U.S.C. § 314(a) is reproduced below.

35 U.S.C. 314 Institution of inter partes review.

(a) THRESHOLD.—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a), institution of *inter partes* review is discretionary. This discretion, however, is limited to instituting, or declining to institute, an *inter partes* review, not for terminating an *ex parte* reexamination as Patent Owner suggests. In fact, nothing in 35 U.S.C. § 314(a) or 37 C.F.R. § 42.108(a) provides the Director authorization to terminate an *ex parte* reexamination. In its Request for Rehearing, Patent Owner does not explain, nor can we discern, how we abused our discretion when we declined to exercise our discretion under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a) to authorize Patent Owner to file a motion to terminate the '056 Reexamination. *See generally* Req. Reh'g.

² **37 C.F.R. § 42.108 Institution of *inter partes* review.**

(a) When instituting *inter partes* review, the Board may authorize the review to proceed on all or some of the challenged claims and on all or some of the grounds of unpatentability asserted for each claim.

In addition, Patent Owner argues that we overlooked its “policy” argument that “unexplained follow-on [ex parte reexamination requests] allow a Petitioner to hold back or intentionally seek out ‘different’ art in order to gain a tactical advantage and delay the resolution of post-grant proceedings (not to mention co-pending litigation), thereby frustrating Congress’s and the Board’s policy of speedy and inexpensive resolution (37 C.F.R. § 41.1(b)).” Req. Reh’g. 2–3.

However, in our Order (Paper 39), we explained that “[f]or the same reason stated in our prior Order (Paper 31, 3–4), we are not convinced that Petitioner’s [*inter partes* review] Petitions and Request for Reexamination amount to harassment of Patent Owner.” Paper 39, 3–4. Further, we noted Petitioner did not have the advantage of the Patent Owner’s Response or the cross-examination of Patent Owner’s expert at the time of filing the Request for Reexamination, and merely notifying the Examiner in the ’056 Reexamination of our claim construction in this instant proceeding does not amount to using our Institution Decision as a “roadmap” to bolster previously unsuccessful arguments, as Patent Owner alleges. *Id.* at 4–5. Moreover, we were not convinced by Patent Owner’s argument that the ’056 Reexamination causes unnecessary delay to the related district court case because, 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.

Therefore, we squarely addressed Patent Owner’s “policy” argument in our prior Order (Paper 39). We are not persuaded that we misapprehended or overlooked Patent Owner’s argument, as Patent Owner

alleges in its Request for Rehearing. A request for rehearing is not an opportunity to express disagreement with a decision.

To further support its “policy” argument, Patent Owner also contends: (1) “under the STRONGER bills (S.1390 § 105; H.R. 5340 § 105) introduced in 2017–2018, follow-on [ex parte reexamination requests] would be barred outright after the one-year bar date”; and (2) although Petitioner relied on Manual of Patent Examining Procedure (MPEP) § 2210 during the conference call held on May 31, 2018, to argue that 35 U.S.C. § 315(e) estoppel does not apply to the ’056 Reexamination, “the Board may not have appreciated that MPEP does not cite legal authority for this proposition.” Req. Reh’q. 3.

However, these are new arguments, and a request for rehearing is not an opportunity to submit new arguments. *See* 37 C.F.R. § 42.71(d). We could not have misapprehended or overlooked arguments that were not made previously. Notably, during the conference call held on May 31, 2018, with the Board, Patent Owner did not direct our attention to any pending legislation. Nor does Patent Owner explain in its Request for Rehearing, how pending legislation is relevant to our determination here *prior to* that legislation’s enactment. Moreover, Patent Owner does not contend that it raised any § 315(e) estoppel argument during any of the conference calls with the Board.

In any event, MPEP § 2210 states that “[t]he estopped provisions of AIA 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1) are based on *inter partes* review and post grant review, respectively, and they only prohibit the filing of a subsequent request for *ex parte* reexamination, once estoppel attaches; there is no estoppel as to the Office maintaining an existing *ex parte*

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