

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 IPR2017-00353  
Patent 8,983,134 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 and 2 (“the challenged claims”) of U.S. Patent No. 8,983,134 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. 2–3):

| References          | Basis    | Claims  |
|---------------------|----------|---------|
| Gilbert and Hashima | § 103(a) | 1 and 2 |
| Hashima and Ueno    | § 103(a) | 1 and 2 |
| Ueno and Gilbert    | § 103(a) | 1 and 2 |

On May 25, 2017, we entered an Institution Decision, instituting an *inter partes* review as to all of the challenged claims based on only the following two grounds: (1) obviousness ground based on Gilbert and Hashima; and (2) obviousness ground based on Ueno and Gilbert. Paper 12, 29-30.

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 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 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 12) is modified to include review of all of the grounds presented in the Petition (Pet. 2–3):

| <b>References</b>   | <b>Basis</b> | <b>Claims</b> |
|---------------------|--------------|---------------|
| Gilbert and Hashima | § 103(a)     | 1 and 2       |
| Hashima and Ueno    | § 103(a)     | 1 and 2       |
| Ueno and Gilbert    | § 103(a)     | 1 and 2       |

IPR2017-00336  
Patent 6,959,293 B2

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