

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.

Cases IPR2017-00353 (Patent 8,983,134 B2)
IPR2017-01218 (Patent 8,983,134 B2)¹

Before JONI Y. CHANG, MICHAEL R. ZECHER, SHEILA F. McSHANE,
and JESSICA C. KAISER, *Administrative Patent Judges*.²

KAISER, *Administrative Patent Judge*.

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

¹ The parties are not authorized to use this style heading.

² In IPR2017-00353, the panel consists of Judges Chang, Zecher, and Kaiser. In IPR2017-01218, the panel consists of Judges Chang and McShane, along with Judge Miriam L. Quinn.

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A conference call in these cases took place on January 12, 2018. The parties were represented by their respective counsel. The purpose of the call was to discuss Patent Owner's request for leave to file a motion to consolidate these cases under 35 U.S.C. § 315(d).

During the call, Patent Owner contended that overlapping issues in these cases counseled in favor of consolidation. Petitioner opposed. Upon consideration of the parties' arguments and the totality of the circumstances, we are not persuaded that a consolidation at this late stage would be efficient, or would facilitate just, speedy, and inexpensive resolution of these proceedings. 37 C.F.R. § 42.1(b). Consequently, Patent Owner's request is *denied*.

The Petitions in these cases were filed four months apart. *See* IPR 2017-00353, Paper 2 (filed Nov. 30, 2016) ("353 Pet."); IPR2017-01218, Paper 2 (filed Mar. 31, 2017) ("1218 Pet."). The Petitions challenged different claims of the same patent and relied on different, although overlapping, asserted prior art. 353 Pet. 3 (challenging claims 1 and 2 based on combinations of references called Gilbert, Hashima, and Ueno); 1218 Pet. (challenging claims 3–6 based on combinations of references called Gerhardt, Bassman, Gilbert, and Hashima). Petitioner explained that its Petitions were staggered because Patent Owner amended its infringement contentions in co-pending district court case to add new claims. 1218 Pet. 5.

In IPR2017-00353, we instituted review of claims 1 and 2 on two grounds: (1) obviousness over Gilbert and Hashima; and (2) obviousness over Ueno and Gilbert. IPR2017-00353, Paper 12, 29 (entered May 25, 2017). In IPR2017-01218, we instituted review of claim 3 on two grounds: (1) obviousness over Gerhardt and Bassman; and (2) obviousness over

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Gilbert, Gerhardt, and Hashima. IPR2017-01218, Paper 11, 29 (entered October 3, 2017). These institution decisions were mailed just over four months apart, and have proceeded on separate schedules.

On January 9, 2018, over nine months after the Petition in IPR2017-01218 was filed and over three months after trial in that *inter partes* review was instituted, Patent Owner first raised the issue of consolidation of that case with IPR2017-00353. Patent Owner did not provide a reasonable explanation as to why it could not have requested a consolidation earlier. Significantly, all of the substantive briefings for the instituted grounds in IPR2017-00353 are completed, as both the Patent Owner's Response and Petitioner's Reply have been filed; and this case is presently set for an oral hearing on February 21, 2018 (in less than six weeks).

During the conference call, Patent Owner proposed compressing the schedule in IPR2017-01218, so that both cases could be set for an oral hearing in April. As Petitioner noted, Petitioner would likely be prejudiced by the proposed compressed schedule, which would shorten Petitioner's time for preparing a Reply in IPR2017-01218, while Patent Owner already had a full opportunity to conduct its discovery and to file its Responses in both cases. We agree with Petitioner that, under the circumstances of these cases, consolidation is not appropriate.

In addition, the statutory deadline for a final written decision in IPR2017-00353 is May 25, 2018. Patent Owner's proposed schedule also would impose undue burden on the panel, as it would have less than two months from the oral hearing date to render that decision. During the conference call, Patent Owner suggested that the circumstances of these cases provide good cause for extending the statutory deadline for IPR2017-

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00353 under 35 U.S.C. § 316(a). We disagree because these cases can be resolved within the statutory deadlines without consolidation. In other words, at this stage, consolidation would not enhance, and would in fact detract from, the efficiency of the proceedings. In addition, not all cases with overlapping issues should be consolidated. Although these cases involve the same patent and some of the same references, they involve different claims and different instituted grounds.

For the foregoing reasons, it is

ORDERED that Patent Owner's request for authorization to file a motion for consolidation is *denied*;

FURTHER ORDERED that other than contemplated in the Scheduling Orders for these cases, no motions are authorized to be filed at this time; and

FURTHER ORDERED that each case will proceed on its current schedule.

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