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., SAMSUNG ELECTRONICS
AMERICA, INC., SAMSUNG TELECOMMUNICATIONS AMERICA,
LLC, and SAMSUNG AUSTIN SEMICONDUCTOR, LLC,

Petitioner,

v.

REMBRANDT WIRELESS TECHNOLOGIES, LP,
Patent Owner.

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Case IPR2015-00555
Patent 8,457,228 B2

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Before JAMESON LEE, HOWARD B. BLANKENSHIP, and
JUSTIN BUSCH, *Administrative Patent Judges.*

BLANKENSHIP, *Administrative Patent Judge.*

DECISION
Denial of Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Denial of Motion for Joinder
37 C.F.R. § 42.122

I. BACKGROUND

Samsung Electronics Co. Ltd., Samsung Electronics America, Inc., Samsung Telecommunications America, LLC, and Samsung Austin Semiconductor, LLC (collectively, "Petitioner") filed a petition requesting *inter partes* review of claim 21 of U.S. Patent No. 8,457,228 B2 ("the '228 patent") (Ex. 1301) under 35 U.S.C. §§ 311–319. *See* Paper 1 (Petition, or "Pet."). With the Petition, Petitioner filed a motion for joinder (Paper 3, "Mot. Join."), seeking to join with *Samsung Electronics Co.* v. *Rembrandt Wireless Technologies, LP,* Case IPR2014-00892 ("IPR '892"). Patent Owner Rembrandt Wireless Technologies, LP filed an opposition to the motion for joinder (Paper 9, "Opp.") and a preliminary response (*see* Paper 19, "Prelim. Resp."). Petitioner filed a reply to Patent Owner's opposition to the motion for joinder. Paper 10 ("Reply"). We have jurisdiction under 35 U.S.C. § 314.

For the reasons that follow, we deny the motion for joinder and do not institute an *inter partes* review as to the challenged claim of the '228 patent.

A. Related Proceedings

According to Petitioner, the '228 patent is involved in the lawsuit *Rembrandt Wireless Technologies, LP v. Samsung Electronics Co*, No. 2:13-cv-00213 (E.D. Tex. 2013). Pet. 1. The '228 patent also has been challenged in the following cases: *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, IPR2014-00889; *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP* , IPR2014-00890; *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP* , IPR2014-00891; *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP* ,

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IPR2014-00892; *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, IPR2014-00893; and *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, IPR2014-00895.

B. The '228 Patent

The '228 Patent issued from an application filed August 4, 2011, which claimed priority under 35 U.S.C. § 120 through a chain of intervening applications to an application filed December 4, 1998, and which further claimed priority under 35 U.S.C. § 119 to a provisional application filed December 5, 1997.

The technical field of the patent relates to data communications and modulators/demodulators (modems), and in particular to a data communications system in which a plurality of modems use different types of modulation in a network. Ex. 1301, col. 1, ll. 21–25; col. 1, l. 58 – col. 2, l. 23.

C. Challenged Claim

Claim 21, the sole claim that is challenged, is reproduced below along with base claim 1.

> 1. A master communication device configured to communicate with one or more slave transceivers according to a master/slave relationship in which a slave communication from a slave device to the master communication device occurs in response to a master communication from the master communication device to the slave device, the master communication device comprising:
> a master transceiver configured to transmit a first message over a communication medium from the master

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transceiver to the one or more slave transceivers, wherein the
first message comprises:

first information modulated according to a first
modulation method,

second information, including a payload portion,
modulated according to the first modulation method, wherein
the second information comprises data intended for one of the
one or more slave transceivers and

first message address information that is indicative
of the one of the one or more slave transceivers being an
intended destination of the second information; and

said master transceiver configured to transmit a second
message over the communication medium from the master
transceiver to the one or more slave transceivers wherein the
second message comprises:

third information modulated according to the first
modulation method, wherein the third information comprises
information that is indicative of an impending change in
modulation to a second modulation method, and

fourth information, including a payload portion,
transmitted after transmission of the third information, the
fourth information being modulated according to the second
modulation method, the second modulation method being of a
different type than the first modulation method, wherein the
fourth information comprises data intended for a single slave
transceiver of the one or more slave transceivers, and

second message address information that is
indicative of the single slave transceiver being an intended
destination of the fourth information; and

wherein the second modulation method results in a
higher data rate than the first modulation method.

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> 21. The master communication device as in claim 1,
> wherein the first information that is included in the first
> message comprises the first message address data.

D. Prior Art

Boer	US 5,706,428	Jan. 6, 1998	(Ex. 1304)
Siwiak	US 5,537,398	July 16, 1996	(Ex. 1324)

E. Asserted Ground of Unpatentability

Petitioner asserts the following ground of unpatentability as to claim 21 (Pet. 3): obviousness under 35 U.S.C. § 103(a) over Admitted Prior Art ("APA")[1], Boer, and Siwiak.

II. ANALYSIS

A. Background

In IPR '892, Petitioner asserted that claims 1–3, 5, and 10–21 of the '228 patent were unpatentable over APA and Boer. IPR '892, Paper 2 at 20–70. We did not institute an *inter partes* review of claim 21 based on that ground in IPR '892. We explained as follows:

> Claim 21, which depends directly from claim 1, recites
> that the first information that is included in the first message
> "comprises the first message address data." Petitioner maps the
> claimed "first information" as corresponding to header 218 of
> message 200 depicted in Figure 4 of Boer. Petitioner admits
> that Boer does not teach placing its address information in
> header 218 (Ex. 1304, Fig. 4). Boer teaches that DATA field

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[1] Petitioner asserts that Patent Owner made admissions in the '228 patent disclosure and in the prosecution history of a parent application regarding prior art. Pet. 12–14.

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