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 IPR2015-00118
Patent 8,023,580 B2

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

BUSCH, *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. INTRODUCTION

Petitioner filed a Petition (Paper 1, "Pet.") requesting an *inter partes* review of claims 23, 25, 29, 30, and 41 of U.S. Patent No. 8,023,580 B2 (Ex. 1301, "the '580 patent"). Petitioner also timely filed a motion requesting joinder (Paper 3, "Mot. Join.") of this proceeding to IPR2014-00519, in which we instituted an *inter partes* review of claims 32, 34, 38, 40, 43, 44, and 47 of the '580 patent, but denied review of claims 23, 25, 29, 30, and 41. Mot. Join. 2. Patent Owner filed a Preliminary Response (Paper 10, "Prelim. Resp.") and an Opposition to the Motion for Joinder (Paper 8, "Opp."). Petitioner filed a Reply (Paper 9, "Reply") to Patent Owner's Opposition. We have jurisdiction under 35 U.S.C. § 314.

We have reviewed the aforementioned papers. For the reasons given below, we do not institute an *inter partes* review and we deny Petitioner's Motion for Joinder.

A. Related Matters

Petitioner indicates that the '580 patent was asserted against Petitioner in *Rembrandt Wireless Technologies, LP v. Samsung Electronics Co.*, No. 2:13-cv-00213 (E.D. Tex.). Pet. 1.

Petitioner seeks to join this proceeding to *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, Case IPR2014-00519 (PTAB) (trial instituted September 23, 2014) (hereinafter "IPR-519"), in which Petitioner challenged claims 23, 25, 29, 30, 32, 34, 38, 40, 41, 43, 44, and 47 of the '580 patent, but no trial was instituted with respect to claims 23, 25, 29, 30, and 41. Pet. 1. The same parties and patent also are involved in *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, Case IPR2014-00514 (PTAB) (institution denied on Sept. 9, 2014); *Samsung Electronics Co. v. Rembrandt Wireless*

Technologies, LP, Case IPR2014-00515 (PTAB) (institution denied on Sept. 9, 2014); *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, Case IPR2014-00518 (PTAB) (trial instituted on Sept. 23, 2014); and *Samsung Electronics Co. v. Rembrandt Wireless Technologies, LP*, Case IPR2015-00114 (PTAB). *Id.*

B. The '580 Patent (Ex. 1301)

The specification of the '580 patent describes "a data communications system in which a plurality of modulation methods are used to facilitate communication among a plurality of modem types." Ex. 1301, 1:21–23. The '580 patent explains that the invention addresses the problem that conventional modem pairs can communicate successfully only when the modems use compatible modulation methods. *Id.* at 1:27–30, 1:45–47.

Of the challenged claims, only claim 23 is independent and is reproduced as follows:

> 23.   A communications device, comprising:
> a processor; and
>   a memory having stored therein executable instructions for execution by the processor, wherein the executable instructions direct transmission of a first data with a first modulation method followed by a second data with a second modulation method, wherein the first modulation method is different than the second modulation method, wherein the first data comprises an indication of an impending change from the first modulation method to the second modulation method, wherein the executable instructions direct transmission of a third data with the first modulation method after the second data, and wherein the third data indicates that communication has reverted to the first modulation method.

C. The Asserted Grounds & Prior Art

Petitioner asserts the following grounds of unpatentability under

35 U.S.C. § 103:

Evidence	Basis	Challenged Claim(s)
Boer[1]	§ 103(a)	23, 25, 30, and 41
Boer and APA[2]	§ 103(a)	29

II. DISCUSSION

A. Background

In IPR-519, Petitioner asserted that claims 23, 25, 30, and 41 of the '580

patent are unpatentable as anticipated by Boer, that claims 23, 25, and 30 are

unpatentable as obvious over Boer, and that claim 29 is unpatentable as obvious

over Boer and APA. Pet. 1. We did not institute an *inter partes* review of claims

23, 25, 29, 30, and 41 as anticipated by Boer, and explained as follows[3]:

> Boer's system may be capable of transmitting a first
> message's data field using either DQPSK or
> PPM/DQPSK followed, a subsequent message's header
> field using DBPSK, where the subsequent message's

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[1] U.S. Patent No. 5,706,428 (filed Mar. 14, 1996, issued Jan. 6, 1998) (Ex. 1304) ("Boer").

[2] Petitioner alleges that Figures 1 and 2 of the '580 patent and the accompanying descriptions are admitted prior art. Pet. 37–38 (citing Ex. 1301, Figs. 1, 2, 2:16–20, 3:40–46) ("APA").

[3] Institution of *inter partes* review with respect to the obviousness of claims 25 and 30 in view of Boer and claim 29 in view of Boer and APA was denied because claims 25, 29, and 30 depend from, and incorporate the limitations of, claim 23. Further, with respect to claim 29, Petitioner did not show that APA cures the deficiencies identified with respect to claim 23.

> header field indicates that the subsequent message's data field will be transmitted using DBPSK. However, the Petition has not established that the specific series of transmissions as recited in independent claim 23 is explicitly disclosed by or necessarily present in Boer.

IPR-519, Dec. Inst. 8 (Paper 16); *id.* at 12–13.

We did not institute an *inter partes* review of claims 23, 25, and 30 as obvious in view of Boer, and explained as follows:

> Petitioner presents no other argument regarding what aspects of Boer would need to be modified in order to meet the recited limitations and why. The underlying factual inquiries necessary for a proper obviousness analysis, as set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966), have not been discussed sufficiently. In particular, Petitioner has not submitted persuasive argument or evidence curing the deficiency identified with respect to its anticipation challenge.

Id. at 9.

Petitioner argues in the Petition in the instant proceeding that Boer explicitly teaches the limitations we found to be missing from Petitioner's challenges to claims 23, 25, 29, 30, and 41, as explained in our institution decision in IPR-519. Pet. 11–12. In this proceeding, notwithstanding Petitioner's arguments that Boer explicitly teaches the limitations, Petitioner presents challenges arguing why the limitations identified as not having been shown sufficiently as anticipated by Boer would have been obvious in view of Boer. Pet. 12–37. We do not reach the merits of Petitioner's new argument that the previously insufficiently shown limitations would have been obvious. Instead, for the reasons discussed below, we exercise our discretion under 35 U.S.C. § 325(d) to deny institution of *inter partes* review in this proceeding.

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