

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS AMERICA, INC.,  
Petitioner,

v.

PRISUA ENGINEERING CORP.,  
Patent Owner.

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IPR2017-01188  
Patent 8,650,591 B2

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Before BARBARA A. PARVIS, STACEY G. WHITE, and  
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request for Rehearing  
of Final Written Decision on Remand  
*37 C.F.R. § 42.71(d)*

## I. INTRODUCTION

On January 14, 2021, we entered a Final Written Decision on Remand pursuant to 35 U.S.C. § 318(a). Paper 86 (“Final Dec.”). Therein, we concluded that Samsung Electronics America, Inc. (“Petitioner”) had shown by a preponderance of the evidence that claims 1–4 and 8 of U.S. Patent No. 8,650,591 B2 (Ex. 1001, “the ’591 patent”) owned by Prisia Engineering Corp. (“Patent Owner”) were unpatentable.

Patent Owner requests reconsideration of the Final Written Decision on Remand on the basis that we overlooked or misapprehended that this proceeding was unconstitutional. Paper 87 (“PO Reh’g Req.”). For reasons that follow, we do not modify our Final Written Decision, and we maintain our conclusion that Petitioner has shown by a preponderance of the evidence that claims 1–4 and 8 of the ’591 patent are unpatentable.

## II. STANDARD OF REVIEW

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 in a motion, an opposition, or a reply. *Id.* When reconsidering a decision on institution, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing

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relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004).

### III. ANALYSIS

Patent Owner raises for the first time in its Rehearing Request two constitutional challenges. First, Patent Owner asserts Administrative Patent Judges remain unconstitutionally appointed, citing *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019), *cert. granted sub nom. United States v. Arthrex, Inc.*, 141 S. Ct. 549 (Oct. 13, 2020). PO Reh'g Req. 2–7. Second, Patent Owner asserts “the Director’s decision to delegate the power to institute IPRs to the Board, as was done in this case, was administrative overreach, a violation of Congress’s mandate, and resulted in the violation of Patent Owner’s right to Due Process guaranteed by the Constitution.” *Id.* at 7–15.

Patent Owner made different arguments regarding unconstitutionality in the Preliminary Response (Paper 21) and Corrected Patent Owner Response (Paper 26). In particular, in its Corrected Patent Owner Response, Patent Owner argued “[a]s the petitioner in *Oil States* argues, *inter partes* review conflicts with the Supreme Court’s cases upholding the constitutional guarantees of a jury and an Article III court for patent invalidation.” Paper 26 (citing *Oil States Energy Servs., LLC v. Greene’s Energy Group, LLC*, No. 16-712 (U.S. Nov. 23, 2016); *see Order, Oil States Energy Servs., LLC v. Greene’s Energy Group, LLC*, No. 16-712 (U.S. June 12, 2017).

After consideration of the arguments and evidence presented by both parties, on October 18, 2018, we issued a Final Written Decision and held

that Petitioner had demonstrated by a preponderance of the evidence that claim 11 of the '591 patent was unpatentable, but Petitioner had failed to demonstrate by a preponderance of the evidence that claims 1–4 and 8 of the '591 patent were unpatentable. Paper 72. The Federal Circuit issued an opinion, affirming our determination with respect to claim 11, vacating our determination with respect to claims 1–4 and 8, and remanding for further proceedings. *Samsung Elecs. Am., Inc. v. Prisia Eng'r Corp.*, 948 F.3d 1342, 1355, 1359 (Fed. Cir. 2020).

We held a conference call with the parties on May 13, 2020 to discuss procedures on remand. *See, e.g.*, Paper 80. Patent Owner did not request briefing to assert its constitutionality challenges during that call or at any time following the Federal Circuit's decision to remand for further proceedings. *Id.*; *see also* Ex. 1032 ("Transcript of Conference Call Conducted May 13, 2020"). Patent Owner filed a Motion to Terminate for two different reasons, i.e., the stage of parallel district court litigation and the inability to construe the claims warranted termination. Paper 83. Patent Owner also did not assert any constitutionality challenges in its Motion to Terminate. *Id.*

Based on the full record in this proceeding, Patent Owner has not argued previously the constitutionality challenges it presents for the first time in its Rehearing Request. Indeed, in its Rehearing Request, Patent Owner does not point us to where its arguments were made previously. *See generally* PO Reh'g Req. We cannot have misapprehended or overlooked arguments or evidence that were not presented previously. For this reason alone, we deny Patent Owner's request for reconsideration.

Furthermore, the Federal Circuit's decision in *Arthrex* addressed the first challenge. *See* 941 F.3d at 1337. As Patent Owner acknowledges (PO Reh'g Req. 11–12), the second challenge also has been addressed. *See Ethicon Endo-Surgery, Inc. v. Covidien LP*, 812 F.3d 1023, 1028–1033 (Fed. Cir. 2016). Accordingly, we decline to consider Patent Owner's constitutional challenges any further.

#### IV. CONCLUSION

For the foregoing reasons, Patent Owner has not shown that we misapprehended or overlooked Patent Owner's arguments or evidence with respect to its constitutional challenges. For reasons given, we do not modify our Final Written Decision and we maintain our conclusion that Petitioner has shown by a preponderance of the evidence that claims 1–4 and 8 of the '591 patent are unpatentable.

#### V. ORDER

In consideration of the foregoing, it is hereby  
ORDERED that Patent Owner's Request for Rehearing is *denied*.

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