

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAXLINEAR, INC.,
Petitioner,

v.

CRESTA TECHNOLOGY CORPORATION,
Patent Owner.

Case IPR2015-00593
Patent 7,265,792 B2

Before PHILLIP J. KAUFFMAN, GREGG I. ANDERSON, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

DECISION
Denying Instituting *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. *Background*

Petitioner, MaxLinear, Inc., filed a Petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 1–17, 26, and 27 (the “challenged claims”) of U.S. Patent No. 7,265,792 B2 (Exhibit 1001, the “’792 patent”). See 35 U.S.C. § 311. Patent Owner, Cresta Technology Corporation, timely filed a Preliminary Response (Paper 8, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a).

We deny the Petition and do not institute *inter partes* review.

B. *Related Proceedings*

Patent Owner asserted the ’792 patent against Petitioner in *Cresta Technology Corporation v. Silicon Laboratories, Inc. et al.*, Case No. 1:14-cv-00079-RGA (D.Del), and International Trade Commission (ITC) Investigation No. 337-TA-910. Pet. 1; Ex. 1002; Ex. 1003.

Petitioner and Petitioner’s co-defendant in these proceedings, Silicon Laboratories, Inc., have filed the following petitions seeking *inter partes* review of the patents asserted by Patent Owner in the ITC Complaint:

IPR No.	Patent At Issue	Petitioner
2014-00728	7,075,585	Silicon Laboratories
2014-00809 ¹	7,265,792	Silicon Laboratories
2015-00591	7,075,585	MaxLinear
2015-00592	7,075,585	MaxLinear
2015-00593 ²	7,265,792	MaxLinear

¹ The “related proceeding.”

² The Petition at hand.

2015-00594	7,265,792	MaxLinear
------------	-----------	-----------

C. *Grounds*

Petitioner relies on the following references:

Thomson	EP 0696854 A1	Feb. 14, 1996	Ex. 1004
Favrat	US 2004/0061804 A1	Apr. 1, 2004	Ex. 1007
Balaban	US 6,369,857 B1	Apr. 9, 2002	Ex. 1008
Kerth	US 6,804,497 B2	Oct. 12, 2004	Ex. 1011
Oku	US 2002/0057366 A1	May 16, 2002	Ex. 1018
Gunter	US 4,782,385	Nov. 1, 1988	Ex. 1022
Patel	US 6,124,898	Sep. 26, 2000	Ex. 1023

Clay Olmstead and Mike Petrowski, *A Digital Tuner for Wideband Receivers*, DSP APPLICATIONS MAGAZINE, Sep. 1992 (Exhibit 1005) (“Harris”).

Al Lovrich and Ray Simar, Jr., *Implementation of FIR/IIR Filters with the TMS32010/TMS32020*, Application Report: SPRA003A (Texas Instruments, 1989) (Ex. 1006) (“TI App Note”).

Cirrus Logic, Product Bulletin CS92288 (2002) (Ex. 1015).

Cirrus Logic, Data Sheet CS4223/CS4224 (April 2000) (Ex. 1016).

Cirrus Logic, Data Sheet CS4954/CS4955 (April 1999) (Ex. 1017).³

³ Exhibits 1015–1017 are collectively referred to as “Cirrus Logic.”

Petitioner contends that the challenged claims are unpatentable under 35 U.S.C. § 103(a) over the following grounds (Pet. 6–7):

Reference(s)	Claim(s) Challenged
Thomson and Harris	1, 2, 4, 10, 11, and 26
Thomson, Harris, and Gunter	3
Thomson, Harris, and Cirrus Logic	5 and 6
Thomson, Harris, and Kerth	7 and 12
Thomson, Harris, Oku, and Kerth	13–17
Thomson, Harris, Kerth, and Cirrus Logic	8 and 9
Thomson, Harris, and Balaban	26 and 27

II. ANALYSIS

The Decision to Institute is discretionary. *See* 35 U.S.C. § 314(a); *see generally* *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, Case IPR2013-00324, slip op. at 4 (PTAB Nov. 21, 2013) (Paper 19) (“Congress did not mandate that an *inter partes* review must be instituted under certain conditions. Rather, by stating that the Director—and by extension, the Board—*may not* institute review *unless* certain conditions are met, Congress made institution discretionary.”). In particular, in a Decision to Institute under 35 U.S.C. § 325(d), the Board may take into account and reject a petition because the same or substantially the same prior art or argument was presented previously to the Office.

Each of the grounds advanced in the instant Petition was previously considered by the Board in the related proceeding.⁴ *See Silicon Laboratories, Inc. v. Cresta Technology Corporation*, Case IPR2014-00809, slip op. at 5–6 (PTAB Oct. 24, 2014) (Paper 10). Although, Petitioner supports its Petition with a Declaration of a different witness (Ex. 1009) than relied on by Silicon Labs in the

⁴ The Petition at hand does not assert some of the grounds asserted in the related proceeding.

related proceeding, we agree with Patent Owner that “the declaration is substantially identical to the [related proceeding’s] declaration.” Prelim. Resp. 3. Thus, we determine that the same or substantially the same prior art or arguments previously were presented to the Office.

Petitioner requests institution of an *inter partes* review “based on the previously instituted grounds in [the related] proceeding, but to hold those grounds in abeyance in the present proceeding until and unless a settlement of the [related] proceeding occurs, at which point Petitioner would continue to challenge those claims.” Pet. 8. We are not persuaded that Petitioner’s proposed course of action would be a prudent use of our discretion. See H.R. Rep. No. 112-98, pt.1, at 48 (2011) (“While this amendment is intended to remove current disincentives to current administrative processes, the changes made by it are not to be used as tools for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent. Doing so would frustrate the purpose of the section as providing quick and cost effective alternatives to litigation”). As Patent Owner observes, nothing in the statute or rules contemplates such a course of action, which would risk encouraging parties to engage in a pattern of duplicative filings that harass patent owners. See Prelim. Resp. 13.

The statutory structure of the America Invents Act includes a more appropriate mechanism for petitioners to assert grounds upon which *inter partes* review has already been instituted—a request for joinder under 35 U.S.C. § 315(c). Petitioner has not filed such a request, and, in light of the advanced stage of the related proceeding, we decline *sua sponte* to join Petitioner to the related proceeding.

For the foregoing reasons, we exercise the discretion granted under 35 U.S.C. § 325(d) to deny the Petition.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* and no *inter partes* review is instituted.

IPR2015-00593
Patent 7,265,792 B2

PETITIONER

Thomas J. Wimbiscus
Christopher C. Winslade
Gregory C. Schodde
Scott P. McBride
Ronald H. Spuhler
Wayne H. Bradley
McAndrews Held & Malloy
twimbiscus@mcandrews-ip.com
cwinslade@mcandrews-ip.com
gschodde@mcandrews-ip.com
smcbride@mcandrews-ip.com
rspuhler@mcandrews-ip.com
wbradley@mcandrews-ip.com

PATENT OWNER

Michael R. Fleming
Benjamin Haber
Irell & Manella LLP
mfleming@irell.com
bhaber@irell.com