

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD,
SAMSUNG ELECTRONICS AMERICA, INC., and
SAMSUNG SEMICONDUCTOR, INC.,
Petitioner,

v.

IMPERIUM (IP) HOLDINGS,
Patent Owner.

Case IPR2015-01231
Patent 6,271,884 B1

Before JAMES B. ARPIN, BART A. GERSTENBLITH, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Semiconductor, Inc. (collectively, “Petitioner”) filed a Request for Rehearing (Paper 16, “Req. Reh’g”) of the Decision Denying Institution of *Inter Partes* Review of U.S. Patent No. 6,271,884 B1 (Ex. 1001, “the ’884 patent”) (Paper 15, “Dec.”), dated December 2, 2015. Petitioner raised eight grounds in its Petition, but requests reconsideration of the denial of institution only with respect to the first six grounds—the grounds for which Petitioner relied, at least in part, upon Hashimoto.¹ Petitioner contends that we overlooked or misapprehended its argument that Hashimoto discloses “adjusting the overall system gain by adjusting the integration time while maintaining the integration time at an integral multiple of the period of the periodic intensity,” as recited in claim 1,² and “an overall gain control block that adjusts an overall system gain by adjusting the integration time while maintaining the integration time at an integral multiple of the period of the periodic intensity,” as recited in claim 14.³ Req. Reh’g 2–3. For the reasons stated below, Petitioner’s request is *denied*.

I. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus., Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567

¹ U.S. Patent No. 6,567,123 B1, issued May 20, 2003 (Ex. 1004).

² Petitioner refers to this limitation as “limitation [1.3].” Req. Reh’g 2.

³ Petitioner refers to this limitation as “limitation [14.3].” *Id.* at 3.

(Fed. Cir. 1988) (citations omitted). The request must identify, specifically, all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed previously in a motion, opposition, or reply. 37 C.F.R. § 42.71(d).

II. DISCUSSION

In our Decision Denying Institution, we determined that Petitioner had not shown a reasonable likelihood of prevailing in showing that Hashimoto discloses or suggests limitations [1.3] and [14.3]. Dec. 13–16. In particular, we remarked that Petitioner’s claim charts did not include citations or quotations addressing these limitations directly. *Id.* at 14, 16. Rather, we noted that for limitation [1.3], Petitioner cited to ten different figures and twelve different portions of Hashimoto, one of which includes a span of seven columns of Hashimoto’s specification. *Id.* at 15 n.7. For limitation [14.3], we noted that Petitioner cited to nine different figures and eleven different textual portions of Hashimoto, one of which also includes a span of seven columns of Hashimoto’s specification. *Id.* at 16 n.8. Additionally, we reviewed and remarked upon the Neikirk Declaration, specifically, paragraph 74, upon which Petitioner also relied. *Id.* at 14 n.6. Paragraph 74 of the Neikirk Declaration does not elaborate upon or otherwise explain how one of ordinary skill in the art would understand the cited text or figures of Hashimoto to disclose or suggest limitations [1.3] and [14.3]. *Id.* Accordingly, we concluded that, on the record before us, Petitioner had not established a reasonable likelihood of prevailing on its asserted grounds based upon Hashimoto. *See, e.g., id.* at 16.

In the Rehearing Request, Petitioner draws our attention to claim charts included as “Appendix C” to the Neikirk Declaration.⁴ *See, e.g.*, Req. Reh’g 3. Petitioner contends we overlooked or misapprehended Petitioner’s citation to several pages of Dr. Neikirk’s claim charts. *Id.* at 4–7. Petitioner asserts that Dr. Neikirk’s claim charts quote and explain how Hashimoto’s column 9 and Figure 6 disclose limitations [1.3] and [14.3]. *Id.*

Hashimoto’s specification consists of sixteen figures and eighteen columns of text, including recited claims. Ex. 1004. Petitioner’s claim charts for limitations [1.3] and [14.3] in the Petition both include string citations that refer to at least nine figures and every column of Hashimoto with the exception of column 15, without explanation or identification of the significance of each of those figures or text. Pet. 31, 38. And although Petitioner includes, within those string citations, a citation to “7:6-14:4,” a seven-column passage that encompasses, among much else, the specific text from column 9 that Petitioner now points to in its request for rehearing, Petitioner did not explain or attach appropriate significance in the Petition to that seven-column citation or any portion thereof. *Id.* at 31, 38.⁵ Petitioner

⁴ Although our Decision Denying Institution did not address expressly the appropriateness of Petitioner’s inclusion of 146 pages of claim charts as Appendix C of Dr. Neikirk’s Declaration, the Board has not given weight to claim charts of similar length included with a declaration yet not included or argued in the petition itself. *See, e.g., Deere & Co. v. Richard Gramm*, Case IPR2015-00898, slip op. at 33–34 (Paper 7) (PTAB Sept. 23, 2015) (discounting 135 pages of claim charts, included with an expert declaration but not included in the Petition, for purposes of determining whether to institute an *inter partes* review). Accordingly, although we address Petitioner’s arguments, we do not condone such practice.

⁵ Similarly, the string citation in the claim chart for limitation [1.3] refers to “Figs. 1, 3-11,” and the string citation in the claim chart for limitation [14.3]

also cited paragraph 74 of Dr. Neikirk's Declaration. *Id.* at 31, 38.

Paragraph 74 of the Neikirk Declaration does not cite to or expressly rely upon columns 7 through 14 of Hashimoto or Figure 6, nor does Paragraph 74 cite to or expressly rely upon Dr. Neikirk's Appendix C claim charts. Ex. 1003 ¶ 74. Additionally, Petitioner cited twenty-three pages and seventeen pages of Dr. Neikirk's Appendix C claim charts for limitations [1.3] and [14.3], respectively. Pet. 31, 38. Petitioner did not explain or attach appropriate significance to these citations in the claim charts included in the Petition or otherwise in the Petition.

As we explained in the Decision Denying Institution, "Petitioner's additional citations beyond those for which it provides parentheticals do not assist us in understanding Petitioner's position." Dec. 15 n.7. Petitioner's overinclusive approach, citing nearly every column and ten figures of Hashimoto for a single element of the claims, while failing to explain clearly how column 9 and Figure 6 allegedly disclose limitations [1.3] and [14.3], is inconsistent with Petitioner's obligation, under 37 C.F.R. § 42.22(a)(2), to "includ[e] a detailed explanation of the significance of the evidence" upon which it relied. As the Board stated previously, "[a] brief must make all arguments accessible to the judges, rather than ask them to play archeologist with the record." *Securus Techs., Inc. v. Global Tel*Link Corp.*, Case IPR2015-00153, slip op. at 8 (Paper 12) (PTAB May 1, 2015) (quoting *DeSilva v. DiLeonardi*, 181 F.3d 865, 867 (Fed. Cir. 1999)). In light of Petitioner's failure to explain or attach appropriate significance to the

refers to "Figs. 1, 3-10," again without explaining or attaching appropriate significance to those figures, let alone Figure 6 now relied upon by Petitioner.

evidence that it now highlights in its Request for Rehearing, we are not persuaded that we overlooked or misapprehended Petitioner's argument or evidence with respect to limitations [1.3] and [14.3].

III. ORDER

Accordingly, it is hereby ORDERED that Petitioner's request for rehearing is *denied*.

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For PETITIONER:

J. Steven Baughman
Christopher J. Harnett
Megan F. Raymond
Ropes & Gray LLP
steven.baughman@ropesgray.com
christoper.harnett@ropesgray.com
megan.raymond@ropesgray.com

For PATENT OWNER:

Wayne M. Helge
James T. Wilson
Davidson, Berquist, Jackson & Gowdey, LLP
whelge@dbjg.com
jwilson@dbjg.com