

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. AND
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

KP INNOVATIONS 2, LLC,
Patent Owner.

IPR2025-00101
Patent 10,499,168 B2

Before JAMESON LEE, MIRIAM L. QUINN, and
LISA A. MURRAY, *Administrative Patent Judges*.

Opinion of the Board filed by *Administrative Patent Judge Lee*.

Opinion Dissenting filed by *Administrative Patent Judge Murray*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 18–21 (the “challenged claims”) of Patent 10,499,168 B2 (“the ’168 Patent”). Paper 1 (“Pet.”). KP Innovations 2, LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). Upon consideration of the Petition as well as the Preliminary Response, we exercise discretion under 35 U.S.C. § 314(a) to deny institution.

II. BACKGROUND

A. *Real Parties in Interest*

Petitioner identifies Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. as real parties in interest. Pet. 2. Patent Owner identifies KP Innovations 2 LLC as a real party in interest. Paper 4.

B. *Related Matters*

The parties identify the following litigation as related matter:

KP Innovations 2, LLC v. Samsung Electronics Co., Ltd., Case No. 1-24-cv-00170-DII (W.D. Tex.) (filed Feb. 19, 2024).

Pet. 2; Paper 4, 2.

C. *The ’168 Patent*

The ’168 patent issued from Application No. 12/658,496, filed Feb. 8, 2010, which is a division of Application 10/057, 131, now Patent No. 7,792,676. Ex. 1001, codes (21), (22). The ’168 patent also claims priority to Provisional Application No. 60/243,162, filed Oct. 25, 2000. *Id.* at codes (60), (62).

The '168 Patent is directed to providing real-time or near real-time interpreting services for utilization on a network. Ex. 1001, 1:16–18. It facilitates “communication for the hearing impaired or disabled” where “use of live interpreters is inconvenient or relatively neither cost nor time effective.” *Id.* at 1:20–23.

Claims 18–21 are reproduced below:¹

[18p]. A communication service device operable with a communication network, comprising:

[18a] at least one user communication device configured to receive and transmit information over the communication network;

[18b] the at least one user communication device comprising a housing having a first side and a second side,

[18c] at least one first input device and first display device configured to allow the at least one user to input and output visual information wherein the at least one first input device and first display device resides on the first side of the housing,

[18d] at least one second input device configured to input visual information wherein the at least one second input device resides on the second side of the housing;

[18e] wherein the first and second input devices and first display devices are carried by the housing in an orientation to allow the at least one user to access the at least one first input device and first display device from the first side of the housing at the same time as the at least one second input device from the second side of the housing.

¹ The bracketed headings correspond to those used by Petitioner to reference the claim elements. *See* Pet. 13–37. We use the same headings here for ease of reference, understanding, and consistency.

[19a]. The communication service device as claimed in claim 18, wherein the first side of the housing and the second side of the housing face mutually opposite directions.

[20a]. The communication services device as claimed in claim 18, wherein the first input device comprises a first camera, and where the second input device comprises a second camera.

[21a]. The communication services device as claimed in claim 19 includes, a second display device residing on the second side of the housing.

Ex. 1001, 22:31–62.

D. The Applied Prior Art and Declarations

Petitioner relies on the following references:

Name	Patent Document/Publication	Exhibit
Okaya ²	US Pat. No. 5,808,663	1006
Nagasawa ³	US Pat. No. 6,782,281 B1	1007
Härmä ⁴	WO 01/31893 A1	1008

Petitioner also relies on the Declaration of Sandeep Chatterjee, Ph.D.

Ex. 1004. Patent Owner relies on the Declaration of Luke Theogarajan, Ph.D. Ex. 2001.

² Issued September 15, 1998.

³ Issued August 4, 2004, based on Application 09/706,080, filed Nov. 3, 2000. Ex. 1007, codes (21), (22), (45).

⁴ Published May 3, 2001. Ex. 1008, code (43).

E. The Asserted Grounds of Unpatentability

Petitioner asserts that the challenged claims of the '168 patent are unpatentable based on the following grounds (Pet. 15):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
18–21	102 ⁵	Okaya
18–21	103(a)	Okaya
18–20	103(a)	Härmä
18–21	103(a)	Nagasawa and Härmä

F. Priority Date

Petitioner asserts that the subject matter of claims 18–21 is not disclosed in Provisional Application No. 60/243,162 and therefore the challenged claims are not entitled to the provisional filing date of Oct. 25, 2000. Pet. 4–5. According to Petitioner, the earliest priority date the challenged claims are entitled to is Oct. 25, 2001. *Id.* at 5. With October 25, 2001, as the earliest priority date of the '168 patent, Petitioner relies on Nagasawa and Härmä as prior art under pre-AIA 35 U.S.C. § 102(e).

Patent Owner responds only that “[n]either the patent examiner during examination of the application nor the PTAB on appeal raised any issues with the priority claim . . . of the '168 Patent.” Prelim. Resp. 11. Because we exercise discretion to deny the Petition under 35 U.S.C. § 314(a), even

⁵ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. §§ 102 and 103. Because the '930 patent claims priority to an application filed before March 16, 2013 (the effective date of the amendments), the pre-AIA version of the statute applies.

assuming that all references applied by Petitioner are prior art to the challenged claims, we need not further address the priority date issue.

III. ANALYSIS

A. *Level of Ordinary Skill in the Art*

Petitioner asserts that a person of ordinary skill in the art would have been “a person with a B.S. degree in electrical engineering, computer engineering, or equivalent training or job experience, along with 1–2 years of experience in the field of real-time or near-real-time telecommunications (e.g., video-based telephony), network computing, computer architecture and design, including desktop and/or mobile computing applications and/or user interface design.” Pet. 11 (citing Ex. 1004 ¶¶ 54–57).

Patent Owner asserts that “a person of ordinary skill in the art would need to know how to utilize electrical components of the system but would not necessarily need to be an expert on the design of communication service devices. A person of ordinary skill in the art would need to know how configurations for transmitting and receiving information over a network are created and implemented in devices.” Prelim. Resp. 12. Patent Owner’s stated positions are consistent with Petitioner’s articulation of the level of ordinary skill in the art which refers to “1–2 years of experience in the field of real-time or near-real-time telecommunications (e.g., video based telephony).”

We adopt Petitioner’s statement of the level of ordinary skill in the art. It is supported by the testimony of Dr. Chatterjee and not disputed by Patent Owner. Further, it appears consistent with what is reflected by the content of the applied prior art. *Cf. Okajima v. Bourdeau*, 261 F.3d 1350,

1354–55 (Fed. Cir. 2001) (the applied prior art may reflect an appropriate level of skill).

B. Claim Interpretation

We use the same claim construction standard that would be used to construe a claim in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b). The claim construction standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc) is applicable.

Claim terms are generally given their ordinary and customary meaning as would be understood by one with ordinary skill in the art in the context of the specification, the prosecution history, other claims, and extrinsic evidence including expert and inventor testimony, dictionaries, and learned treatises, although extrinsic evidence is less significant than the intrinsic record. *Phillips*, 415 F.3d at 1312–17. Usually, the specification is dispositive, and it is the single best guide to the meaning of a disputed term. *Id.* at 1315.

If an inventor acts as his or her own lexicographer, the definition must be set forth in the specification with reasonable clarity, deliberateness, and precision. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998). Only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Realtime Data, LLC v. Iancu*, 912 F.3d 1368 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only

to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

Petitioner asserts: “[T]he Board need not construe any term because the prior art invalidates the claims under any plausible construction.” Pet. 12. Petitioner has not proposed an express construction for any claim term.

Patent Owner asserts that “[t]he term ‘receive and transmit information’ [in claim 18] means real-time or near real-time audio and visual information.” Prelim. Resp. 15–16. Patent Owner further argues that “Petitioner accepts Patent Owner’s construction because the construction is a plausible construction, and Petitioner stated that they believe their art invalidates the claims under any plausible constructions.” *Id.* at 16.

For purposes of this Decision, however, we need not decide whether to adopt Patent Owner’s proposed construction.

*C. Alleged Anticipation of Claims 18–21 by Okaya
and Obviousness of Claims 18–21 over Okaya*

1. Overview of Okaya (Exhibit 1006)

Okaya discloses “a multimedia carousel for use in video conferencing and multimedia applications.” Ex. 1006, 2:6–8. Figure 1 of Okaya is reproduced below:

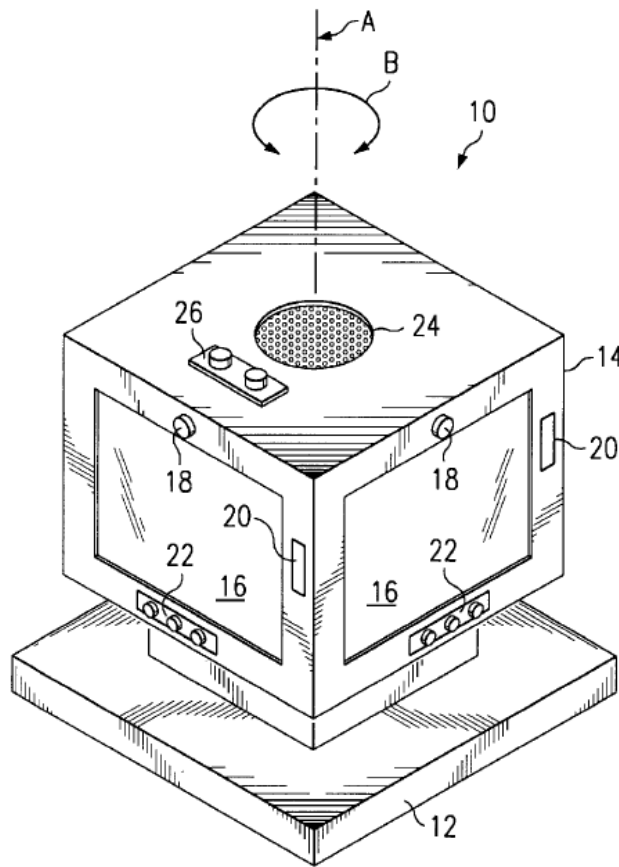


Fig. 1

Figure 1 shows a perspective view of an embodiment of Okaya's multimedia carousel. *Id.* at 2:39–40.

As shown in Figure 1, carousel 10 includes base 12 and media unit 14 connected to base 12, and media unit 14 is freely rotatable about vertical axis A through the center of media unit 14 and base 12 as indicated by arrow B. *Ex. 1006*, 2:49–53. Each of four outwardly facing sides of carousel 10, only two of which are shown, includes display panel 16, camera 18, microphone 20, and display control panel 22. *Id.* at 2:53–60. Speaker 24, a single speaker, is disposed on top of media unit 14 and audio control panel 26 is disposed proximate the speaker. *Id.* at 2:60–65.

Okaya describes that “multimedia carousel 10 includes several input and output terminals for integrating with a multimedia computer or video conferencing system.” Ex. 1006, 3:1–4. Figure 2 of Okaya is reproduced below:

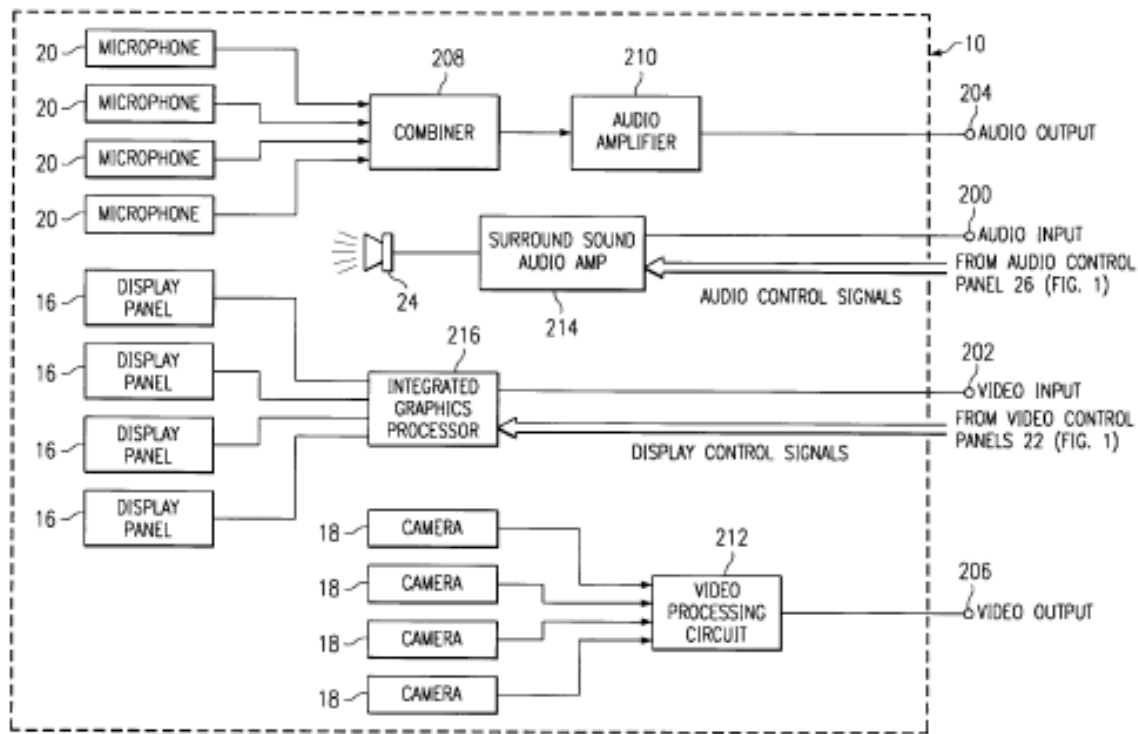


Fig. 2

Figure 2 is a block diagram of the system components of carousel 10. *Id.* at 2:41–42.

Audio signals produced by microphones 20 are input into combiner 208 which combines the signals into an integrated signal, and that integrated signal is provided to audio amplifier 210 which amplifies the signal. Ex. 1006, 3:13–18. The amplified signal is made available at audio output terminal 204 to, for example, a video conferencing system. *Id.* at 3:19–21. Video signals from cameras 18 are processed by video processing circuit

212 and then made available at video output terminal 206 to, for example, a video conferencing system. *Id.* at 3:21–24.

Audio signals received at audio input terminal 200 from, for example, a computer executing a multimedia application, or a video conferencing system, are input to audio amplifier 214 and then provided to speaker 24. Ex. 1006, 3:25–31. Video signals received at video input terminal 202 from, for example, a computer executing a multimedia application or a video conferencing system are processed by graphic processor 216 and then provided to display panels 16. *Id.* at 3:31–37.

Okaya describes: “In this manner, video and audio output produced by a multimedia computer or received from a remote video conferencing terminal can be displayed and broadcast using the multimedia carousel 10 to participants seated around the carousel.” *Id.* at 3:38–42.

Okaya describes a sample scenario of how multimedia carousel 10 is used:

One scenario in which the multimedia carousel 10 might be especially useful is one in which a product team would like to make a formal proposal to an outside vendor regarding a new product. One member of the product team comes to the meeting with a presentation of the outline of the proposal prepared using a multimedia application such as PowerPoint. Using the multimedia carousel 10 in conjunction with her notebook PC, which is connected to the video input terminal 202 and audio input terminal 200 via its video and audio I/O ports, respectively, she makes her presentation to the product team seated around the multimedia carousel 10. The team members discuss, make changes and, in general, get “on the same page” regarding the proposal they would like to make. Once they have accomplished this, the product team calls up the outside vendor using their Zoom Video or plain old telephone system (“POTS”) video conferencing card and/or peripheral. The product team then presents their product to the vendor via a video conferencing

system. After the presentation, the cameras 18 are switched on and the proposal is discussed. The product team's leader speaks first, triggering the camera 18 in front of him, and his image instantly appears on the vendor's display panel (not shown). At any time during the discussion or presentation, the media unit 14 may be rotated relative to the base 12 to enable participants to get a better view of what is being presented on the display panels 16 or to ensure that particular participants are within the line of sight of one of the cameras 18. The discussion continues as other members of the product team make additional comments, triggering the camera 18 closest to the speaker such that the team member's image is displayed on the vendor's display panel. In this manner, the voice activated cameras 18 capture it all.

Ex. 1006, 3:43–4:7.

2. *Independent Claim 18*

We focus on Petitioner's treatment of limitation [18a], which is determinative: "at least one user communication device configured to receive and transmit information over the communication network."

Petitioner combines its discussion of anticipation by Okaya and obviousness over Okaya. Pet. 13–38. Petitioner begins its analysis for limitation [18a] as follows:

Okaya discloses a multimedia carousel intended to permit communication via a network. *See supra* 18[p]. *Okaya's* carousel, either alone or integrated with a multimedia computer and/or video conferencing system, permits up to four users to simultaneously communicate with a remote vendor over a network. *Id.*; EX1006, Fig. 2, 3:22-42, 3:56-4:14; Ex. 1004 ¶ 94.

Id. at 16. Via the above-quoted assertions, Petitioner identifies *Okaya's* multimedia carousel 10, either alone or integrated with a computer or a videoconferencing system, as the claimed communication device of limitation [18a]. Consistent with that understanding, Petitioner further explains:

[Okaya's] cameras capture images of each user [around the carousel], which are transmitted from the carousel over a network to the remote vendor's computer to display a split-screen showing each image. EX1006, 3:22-25, 3:62-65 ("The product team's leaders speaks first, . . . and his image instantly appears on the vendor's display panel."), 4:7-15 ("[T]he images captured by all of the cameras 18 [on the four sides of carousel 10] could be simultaneously displayed in a 'split screen' type of arrangement on the vendor's display panel."); 3:56-59 (disclosing video calling over a POTS network). A POSITA [person of ordinary skill in the art] would have understood that images from cameras 18 (on the carousel) are transmitted to the remote vendor's display via a connected PC/video conferencing system and intervening nodes as routed along the communication network. EX1004, ¶¶95-96. *Okaya* teaches that video conferencing involves "face-to-face" conversations, consistent with the POSITA's understanding that video conferencing includes sending and receiving of video data over a network. EX1006, 1:12-22; EX1004, ¶96.

Id. at 16–17. To complete the analysis, Petitioner asserts that "a POSITA would have known how to implement the multimedia carousel with known multimedia PCs and videoconferencing systems." *Id.* at 18.

Regarding the alleged anticipation by *Okaya*, Petitioner has not adequately shown that *Okaya* discloses that the audio and video outputs of carousel 10 connect to a communication network without the intervening use of a computer or video conferencing system to which the carousel is connected. *Okaya* specifically describes that "the multimedia carousel 10 includes several input and output terminals for integrating with a multimedia computer or video conferencing system." Ex. 1006, 3:1–4. The specific scenario described in *Okaya*, in column 3, lines 43 to 61, also has carousel 10 connected to a notebook PC. Thus, Petitioner's arguments based on carousel 10 itself as the device of limitation [18a] is inadequate. *See also*

Prelim. Resp. 18 (citing Ex. 2001 ¶¶ 52, 53) (“The *Okaya* device is not a standalone device that can connect to a network” and “*Okaya* does not include any networking capability”), 26 (citing Ex. 2001 ¶¶ 72, 73), 29–30 (citing Ex. 2001 ¶ 76).

There is nothing in *Okaya* persuasively disclosing or even suggesting that any of its audio or video inputs/outputs are network-ready ports or implemented in a way that makes the audio and video streams ready for network transmission to or from *Okaya*’s carousel. *See e.g.*, Ex. 2001 ¶¶ 78, 79. And we find unpersuasive Petitioner’s argument that the standardized connections substantiate its allegation of combinability with a computer or video conferencing. Pet. 17–18. Petitioner focuses on equipping the PC with software for conducting the video or audio conference, with *Okaya*’s carousel performing merely as a peripheral, with basic Input/Output ports, such as video and audio connectors. *Id.* (citing Ex. 1004 ¶¶ 86–89).

Also regarding the alleged anticipation by *Okaya*, Petitioner has not adequately explained why carousel 10, together with the separate personal computer or separate video conferencing system to which it is connected by input/output lines, constitutes the at least one “device.”⁶ As shown in

⁶ Here we note that the ’168 patent contains claims directed to the “communication services device” while other claims are directed to “user computer” and “provider computer” setting forth that there is a difference between the meanings of “device” and “computer.” *Compare* claim 1, Ex. 1001, 19:47–20:14 with claim 18, Ex. 1001, 22:32–52. And the ’168 patent describes separate embodiments in which the configuration of the “computers” (*see e.g., id.* at Fig. 2) is distinct from the configuration of a “device” (*see e.g., id.* at Fig. 3). *Id.* at Figs. 2, 3; 19:17–45 (describing the “device” embodiments explaining that such a device contains, within the housing, the user computers).

Okaya's Figure 1, carousel 10 is a stand-alone peripheral unit *not* incorporated into any other apparatus. On this record, we have no reason to regard carousel 10 in combination with some other apparatus, such as a separate personal computer or separate video conferencing system, as one "device."

Regarding obviousness over Okaya, Petitioner's stated positions on limitation [18a] fare no better. Petitioner provides no explanation of why one of ordinary skill in the art would have wanted to merge or combine Okaya's carousel 10 and Okaya's separate personal computer and/or videoconferencing system *into one device*. Petitioner also does not explain how that could be done by one of ordinary skill in the art. For instance, Petitioner does not identify the structure of any such videoconferencing system or personal computer with which the structure of Okaya's carousel 10 would be combined, and what the resulting *device* would look like. Finally, we find conclusory Petitioner's explanation (for the preamble of the claim) that the multimedia carousel, or its combination with the computer/video conference system comprises the claimed communication service device. Pet. 14. The explanation focuses on generally connecting the Okaya carousel ports to a computer; but that explanation is silent as to how both of these structures comprise the claimed "device."

For the foregoing reasons, Petitioner has not shown a reasonable likelihood that it would prevail in establishing that claim 18 is anticipated by Okaya, and Petitioner also has not shown a reasonable likelihood that it would prevail in establishing that claim 18 would have been obvious over Okaya.

3. *Dependent Claims 19–21*

Claims 19–21 each depend, directly or indirectly, from claim 18.

Ex. 1001, 22:53–62. The same deficiencies discussed above for claim 18 equally apply to claims 19–21. Thus, Petitioner has not shown a reasonable likelihood that it would prevail in establishing that any of claims 19–21 is anticipated by Okaya. Petitioner also has not shown a reasonable likelihood that it would prevail in establishing obviousness of any of claims 19–21 over Okaya.

D. Alleged Obviousness of Claims 18–21 over Nagasawa and Härmä

1. *Overview of Nagasawa (Exhibit 1007)*

Nagasawa discloses a folding portable telephone having a folding main body. Ex. 1007, 1:24–29. A display and certain operation means are provided on the outer surface of the main body, with which a user can play and display a pocket game while the phone is in the folded position. *Id.* at 1:38–43. Figures 1A and 1B are reproduced below:

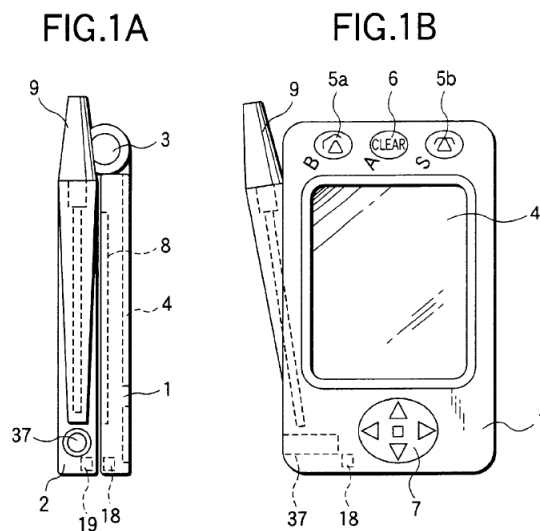


Figure 1A is a side view of the folding portable telephone according to a first embodiment of Nagasawa with the main body (case body 1) folded. *Id.*

at 2:30–32. Figure 1B is a front view of the folding telephone of that first embodiment with the main body folded. *Id.* at 2:33–35.

Figures 2A and 2B are reproduced below:

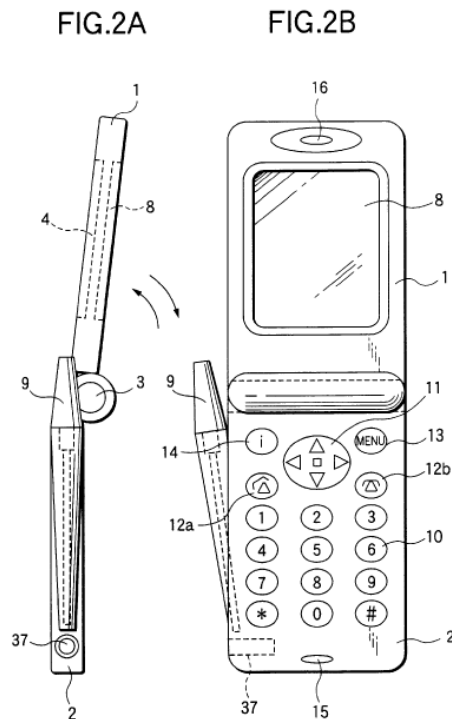


Figure 2A is a side view of the folding portable telephone according to the first embodiment of Nagasawa with the main body (case body 1) unfolded. *Id.* at 2:36–38. Figure 2B is a front view of the folding telephone of the first embodiment with the main body unfolded. *Id.* at 2:40–42.

As shown in Figures 1A and 2A, “[a] first case body 1 and a second case body 2 are coupled via a hinge 3 so that the first case body 1 and the second case body 2 are coupled via a hinge 3 so that the first case body 1 and the second case body 2 can be folded or unfolded via the hinge 3.” Ex. 1007, 3:51–53. First display 4 is provided on the outer surface of first case body 1. *Id.* at 3:53–55. In the near proximity of first display 4 are provided a call button 5a, a call release button 5b, a clear button 6, and a so-

called navigation key 7 (these are shown in Figures 1A and 1B above). *Id.* at 3:54–57. “When the folding portable telephone apparatus according to the invention is used as a pocket game machine, the call start button 5*a* is used as a so-called B button for a pocket game, the call release button 5*b* as a so-called start (S) button, and the clear button as a so-called A button.” *Id.* at 3:60–65.

On the inner surface of case body 1 is provided second display 8. Ex. 1007, 3:66–67. Unfolding case body 1 causes text and graphics information to be displayed on second display 8 while first display 4 maintains its state assumed prior to unfolding of the main body 1. *Id.* at 4:11–16.

Case body 2 provides ten-digit keypad 10, navigation key 11 including arrow keys and a center select key, call start key 12*a*, call release key 12*b*, menu key 13, and a non-voice radio communication service start key 14 (shown in Figures 2A and 2B above). Ex. 1007, 4:17–25. Microphone 15 is provided in the lower section of case body 2, and speaker 16 is provided in the upper section of case body 1. *Id.* at 4:25–28.

2. *Overview of Härmä (Exhibit 1008)*

Härmä discloses a mobile phone including two cameras with different capturing directions. Ex. 1008, code (57). Härmä explains that mobile phones are often used for capturing still pictures and video clips, as well as for video conferencing. *Id.* at 1:4–5. Härmä describes that the requirements for using the phone to capture still pictures and video clips are contradictory to the requirements for using the phone in video conferencing, because in the former case the capturing direction is away from the user and in the latter case the capturing direction is towards the user. *Id.* at 1:7–10. Härmä states:

“The mobile phone according to the invention is characterised in that in addition to a first camera, it comprises a second camera with a capturing direction essentially different from the capturing direction of the first camera.” *Id.* at 1:25–28.

Figures 1a and 1b are reproduced below:

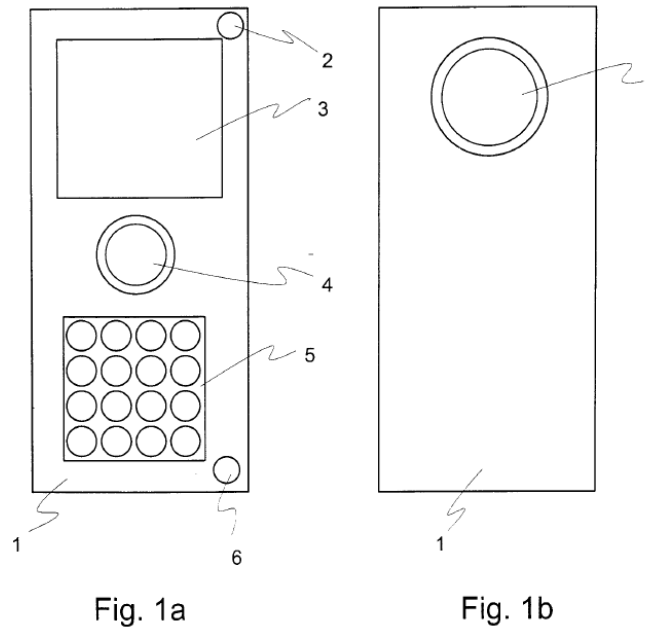


Figure 1a is a schematic illustration of the front view of a first embodiment of Härmä’s mobile phone. Ex. 1008, 4:15–16. Figure 1b is a schematic illustration of the rear view of the first embodiment of Härmä’s mobile phone. *Id.* at 4:24–25.

On its front side facing the user, mobile phone 1 includes speaker 2, display 3, first camera 4, keypad 5, and microphone 6. Ex. 1008, 5:17–20. On its rear side, facing away from the user, mobile phone 1 includes second camera 7. *Id.* at 4:24–27.

Figure 3a of Härmä is reproduced below:

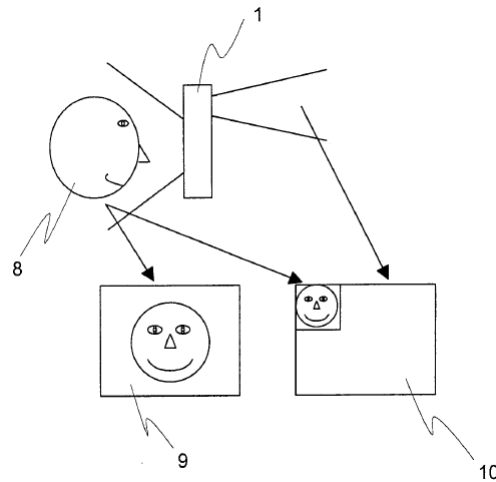


Fig. 3a

Figure 3a is a schematic illustration of one way to use mobile phone 1.

Ex. 1008, 5:7–8. Härmä describes:

In the usage illustrated in the drawing, the first camera is directed towards the user 8, so that the user is placed near the mobile phone 1. On the display, there can be seen an essentially screen-size image 9 of the user, or an image 10, where the user's image is seen as a smaller picture in addition to the image captured by the other camera, i.e., on the display there is seen a split-screen image composed of the images of the first and second camera.

Id. at 5:9–14.

3. Independent Claim 18

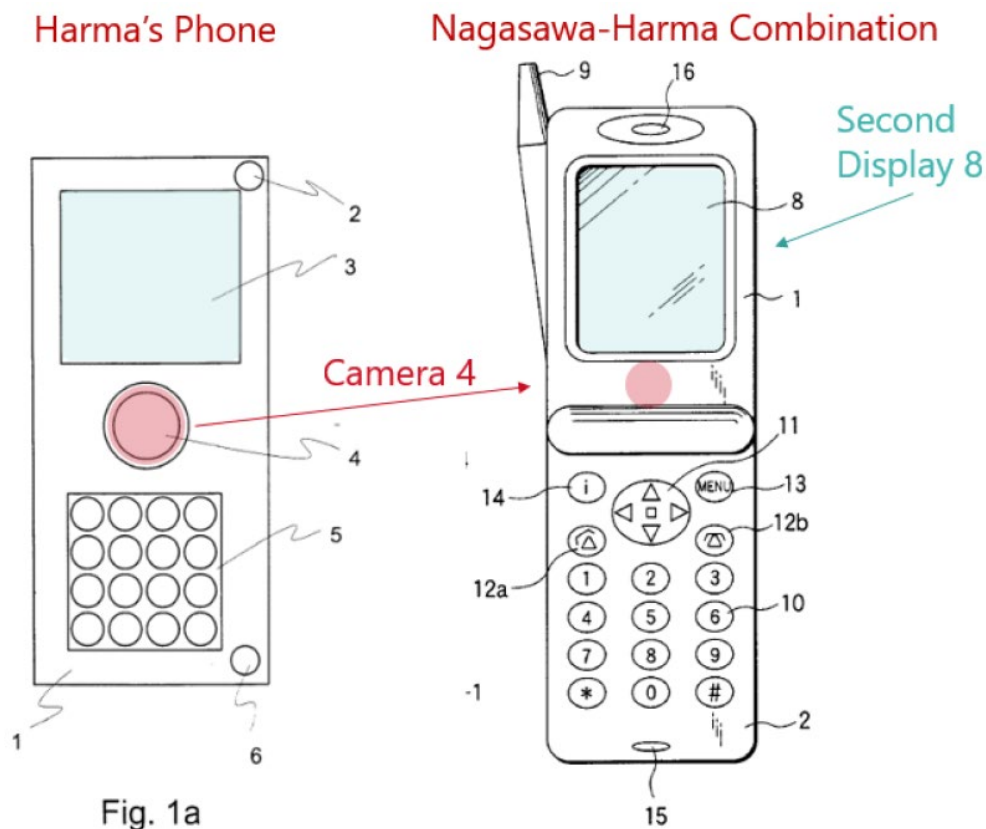
We focus on limitations [18c] and [18d]:

[18c] at least one first input device and first display device configured to allow the at least one user to input and output visual information wherein the at least one first input device and first display device resides on the first side of the housing,

[18d] at least one second input device configured to input visual information wherein the at least one second input device resides on the second side of the housing;

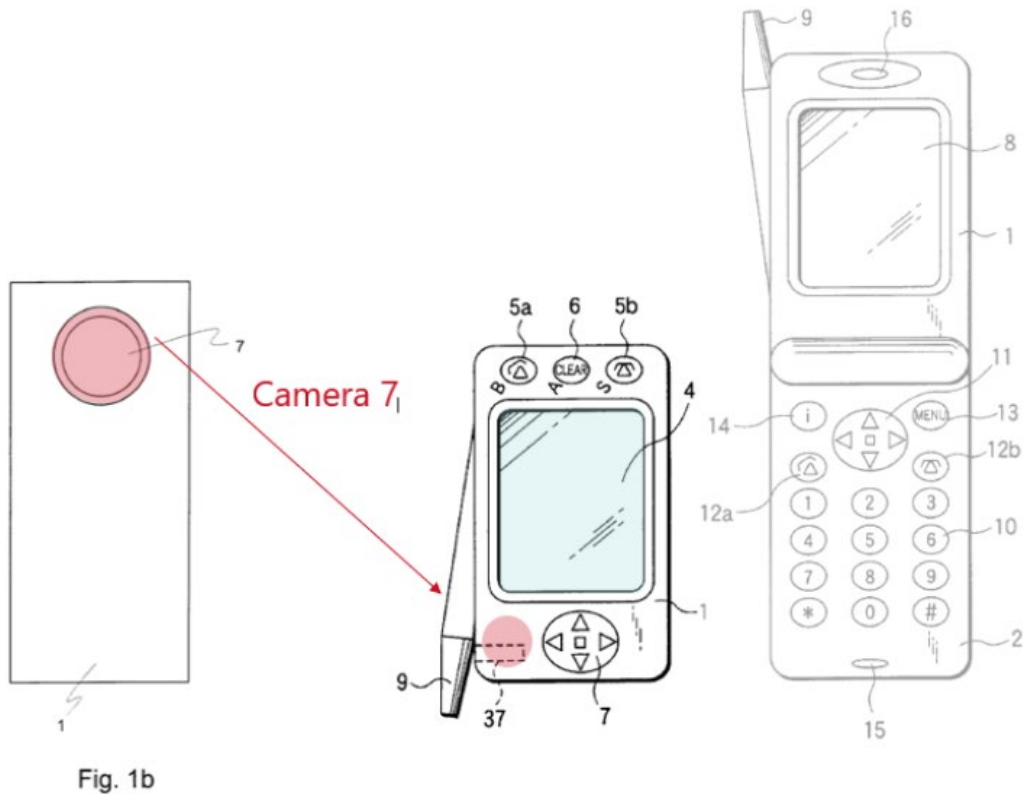
Ex. 1001, 22:37–45.

Petitioner asserts that it would have been obvious for one of ordinary skill in the art to modify Nagasawa to include the first and second cameras described by Härmä. Pet. 78. Specifically, Petitioner asserts that it would have been obvious to one of ordinary skill in the art “to incorporate a camera from the **first side** of *Härmä* into a **first side** of *Nagasawa*.” *Id.* at 72 (emphasis in original). Petitioner illustrates the resulting structure with the following depiction on page 76 of the Petition:



The depiction shows on the left a first side of Härmä's phone, and on the right a first or inward facing side of Nagasawa's case body 1 (when the phone is in the unfolded position), with a camera added to the bottom center of that first side, including a red arrow pointing from Härmä's camera to Nagasawa's added camera, both cameras highlighted in red.

Petitioner further illustrates the resulting structure with the following depiction on page 78 of the Petition:



The depiction shows on the left the second side of Härmä's phone (camera highlighted in red), in the middle the second or outward facing side of Nagasawa's case body 1 when its phone is in the folded position, with an added camera (highlighted in red), and on the right a front view of Nagasawa's phone in an unfolded position (shadow view), including a red arrow pointing from Härmä's camera to Nagasawa's added camera.

Regarding motivation to combine, Petitioner explains that Nagasawa “adds a second display to the outer surface of a foldable telephone, which allows gaming when the phone is folded,” and that Härmä adds a second camera to the phone to enhance “capturing still pictures and video clips.” Pet. 51. Petitioner further explains: “The POSITA would have been

motivated to combine these multimedia enhancements into a single device to obtain the benefits of both of these multimedia features and would have expected success in doing so, as the devices would continue to perform their described functions with predictable benefits described in the references when combined into a single device.” *Id.* More specifically, Petitioner asserts:

[T]he POSITA would have been motivated to implement the two cameras facing different directions, taught by *Härmä*, in the base system of *Nagasawa* to obtain the enhanced two-camera features described by *Härmä*. EX1004, ¶173. They would have provided the system of *Nagasawa* discussed above (*e.g.*, a foldable phone with two displays), with the added benefits of two cameras taught by *Härmä*, one on each side of the device. EX1004, ¶173.

Id. at 55–56.

For reasons discussed below, we find Petitioner’s reasoning to be insufficient for one of ordinary skill in the art to add two cameras to *Nagasawa*’s case body 1, one on each side of case body 1.

Petitioner does not adequately address the issue of sufficient spacing on *Nagasawa*’s case body 1, which includes two back-to-back mounted displays 4 and 8 (Figure 1A), to include two additional cameras, one facing inward and the other facing outward, particularly as one side of case body 1 is used for gaming (Fig. 1B, Ex. 1007, 3:53–65). In *Nagasawa*’s fifth embodiment, which includes a camera for video conferencing, the camera is placed in the hinge connecting case bodies 1 and 2, and not within case body 1. That is an indication that there is not enough room in *Nagasawa*’s case body 1 to incorporate a camera, much less two cameras as Petitioner has proposed to meet limitations [18c] and [18d]. *Nagasawa*’s Figure 12B is reproduced below:

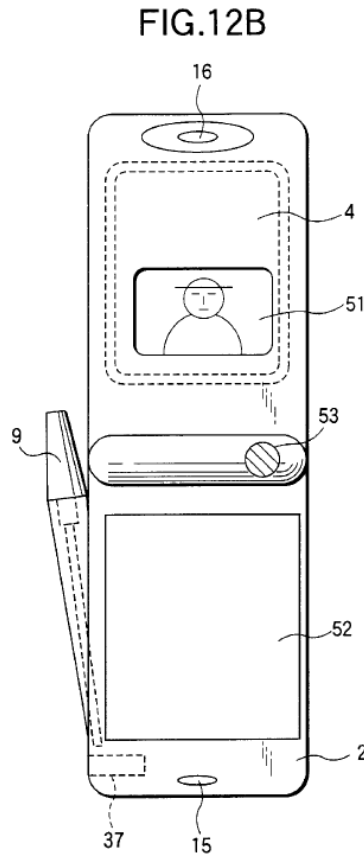


Figure 12B is a front view of a fifth embodiment of Nagasawa’s foldable phone in the unfolded position. Ex. 1007, 3:24–26. Nagasawa describes: “Video conference display may be provided where the photo sticker 51 is to be affixed in order to provide folding portable apparatus equipped with a small-sized TV camera 53 at the hinge.” *Id.* at 7:36–39. Nagasawa’s design already dictates where a camera would be mounted, and omits discussion of any other locations of that camera, much less a placement of it on the phone case body. *Id.*

Additionally, Dr. Theogarajan testifies: “A person using [Nagasawa’s] pocket game would cover any camera placed on the outer surface of the first case body. Any camera placed in such a position would be abused with dirt and oil from a game player’s hand.” Ex. 2001 ¶ 145. We credit the testimony. It further undermines Petitioner’s proposed

addition of two cameras to Nagasawa's case body 1. Also, Nagasawa's fifth embodiment already includes a video conferencing camera facing the user, mounted in the hinge connecting case bodies 1 and 2. In light of that teaching, there is little reason to add a camera to the inward facing side of Nagasawa's case body 1.

For the foregoing reasons, Petitioner has not shown a reasonable likelihood that it would prevail in establishing that claim 18 would have been obvious over Nagasawa and Härmä.

4. Dependent Claims 19–21

Claims 19–21 each depend, directly or indirectly, from claim 18. Ex. 1001, 22:53–62. The same deficiencies discussed above for claim 18 equally apply to claims 19–21. Petitioner has not shown a reasonable likelihood that it would prevail in establishing that any of claims 19–21 would have been obvious over Nagasawa and Härmä.

E. Alleged Obviousness of Claims 18–20 over Härmä

For purposes of this Decision, we need not reach a conclusion about whether Petitioner has shown a reasonable likelihood that any one of claims 18–20 would have been obvious over Härmä. We discretionarily deny the Petition even assuming that there is a reasonable likelihood that Petitioner would prevail in showing obviousness of at least one of claims 18–20 over Härmä.

However, we note that a merits analysis would involve the meaning of “receive and transmit information,” i.e., whether the term means “real-time or near real-time audio and visual information” as proposed by Patent Owner (Prelim. Resp. 15–16). Petitioner states that “the prior art invalidates the claims under any plausible construction.” Pet. 12. Given that the '168

patent is directed “to a system, method, and apparatus for providing real-time or near real-time interpreting services for utilization on a network,” Ex. 1001, 1:16–18, 3:21–40, Patent Owner’s proposed construction is at least plausible. We do not find an explanation in the Petition that what Petitioner relied on as the information received and transmitted in Härmä is either real-time or near real-time. And the opinion of Dr. Chatterjee regarding the use of Härmä in a video conference implying that it could involve live video exchange (Ex. 1004 ¶ 146) is vehemently opposed by Dr. Theogarajan (Ex. 2001 ¶¶ 56–60, 63, 126–131). Balancing the evidence regarding this issue, therefore, leaves us with doubts as to the strength of the Härmä ground.

F. Discretionary Denial Under 35 U.S.C. § 314(a)

The Director has discretion to institute *inter partes* review. 35 U.S.C. § 314(a); *SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 373 (2018). That discretion, for this proceeding, has been delegated to the Board. *See* 37 C.F.R. § 42.4(a). Under appropriate circumstances, the Board may exercise that discretion to deny a petition “even when the petition includes at least one claim subject to a challenge that otherwise meets the criteria for institution.” Consolidated Trial Practice Guide⁷ at 64. The Consolidated Trial Practice Guide states:

If a panel determines that a petition meets the standards for institution in relation to fewer than all the challenges presented, or where deficiencies in the petition (such as a failure to provide a construction under 35 U.S.C. § 112(f)) affect only a portion of the challenge presented, the panel will evaluate all the challenges and determine whether, in the interest of efficient administration

⁷ Available at <http://www.uspto.gov/TrialPracticeGuideConsolidated>.

of the office and integrity of the patent system, the entire petition should be denied. *See* 37 C.F.R. §§ 316(b), 326(b).

Id.

For the reasons that follow, we exercise discretion to deny the Petition under 35 U.S.C. § 314(a).

The Petition includes four alleged grounds of unpatentability, three of which each challenge four claims and one of which challenges three claims. Pet. 6. Petitioner has not shown a reasonable likelihood of prevailing in any of the three grounds each of which challenges claims 18–21. Even assuming Petitioner has shown a reasonable likelihood of prevailing on the sole remaining ground challenging claims 18–20 and based on Härmä alone, that would still represent at most 25% of the overall challenge based on grounds and claims. And considering that the evidence on the disputed issue on claim construction in the Härmä ground appears to be in equipoise at this juncture, the threshold for institution, even if reached, would be a close question.

Under *SAS*, 584 U.S. at 366, it is the petition itself which guides the life of the petition. If we institute review, the trial would include all challenged claims on all alleged grounds of unpatentability asserted in the Petition, including those three grounds for which we have determined that Petitioner has not shown a reasonable likelihood of prevailing on any claim. *See BioDelivery Sciences International, Inc. v. Aquesitive Therapeutics, Inc.*, 898 F.3d 1205, 1209 (Fed. Cir. 2018) (“We agree that *SAS* requires institution on all challenged claims and all challenged grounds.”).

In the circumstance here, we find that it would not be an efficient use of the Board’s time and resources to institute review. *See Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 10–11 (PTAB

Nov. 7, 2018) (informative); *see also Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 at 41–43 (PTAB Jan. 24, 2019) (informative). Petitioner has not shown a reasonable likelihood of success for three of four alleged grounds of unpatentability directed to all challenged claims. Even as to the one remaining ground based on Härmä alone, for which we reserve judgment, even if assuming Petitioner has made a sufficient showing for institution, the ground is directed to less than all challenged claims.

For the foregoing reasons, we exercise discretion under 35 U.S.C. § 314(a) to decline to institute *inter partes* review.

IV. CONCLUSION

We exercise discretion under 35 U.S.C. § 314(a) to decline institution.

V. ORDER

In consideration of the foregoing, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), the Petition is *denied*.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. AND SAMSUNG
ELECTRONICS AMERICA, INC.,

Petitioners,

v.

KP INNOVATIONS 2, LLC,

Patent Owner.

IPR2025-00101

Patent 10,499,168 B2

Before JAMESON LEE, MIRIAM L. QUINN, and LISA A. MURRAY,
Administrative Patent Judges.

MURRAY, *Administrative Patent Judge, dissenting.*

I respectfully disagree that we should deny institution based on the analysis articulated in *Chevron Oronite Co. LLC v. Infineum USA L.P.*, IPR2018-00923, Paper 9 (PTAB Nov. 7, 2018) (informative) and in *Deeper, UAB v. Vexilar, Inc.*, IPR2018-01310, Paper 7 (PTAB Jan. 24, 2019) (informative). I dissent because I would not deny institution under 35 U.S.C. § 314(a).

I. SUBSTANTIVE MERITS OF THE PETITION

An *inter partes* review may be instituted only if “the information presented in the petition . . . and any [preliminary] response . . . shows that

there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). On the record before us, I would conclude that Petitioner has met its burden of establishing a reasonable likelihood that it would prevail in showing the unpatentability of at least claim 18 of the ’168 patent under 35 U.S.C. § 103 in view of Härmä. *See* Ex. 1008 (WO 01/21893 A1 (filed Oct. 25, 2000, published May 3, 2001)) (“Härmä”).

Härmä describes a mobile phone with two cameras pointed in different directions. “[T]he object of the invention is a mobile phone that enables capturing still pictures and video clips, for instance in a video conference, in a versatile and easily applicable fashion.” Ex. 1008, 1:21–23. Petitioner asserts that Härmä qualifies as prior art under at least §§ 102(a) and 102(e) “at least because it was published in English, identified the U.S. as a designated state, and further because the ’168 Patent is not entitled to its provisional application’s priority date.” Pet. 6.

Petitioner asserts that the invention in challenged claims 18–21 is not disclosed in the provisional application. Pet. 5. The provisional discusses only the invention as depicted in Figures 1–2 of the ’168 patent, i.e., a desktop device with a single camera. *See* Ex. 1002, 18, 46–47. Claims 18–21, however, correspond to the invention as shown in Figures 3–5 of the Specification, a mobile network communications device with multiple cameras. *See* Ex. 1001, Figs. 3–5, 19:30–37. On the current record, I would agree with Petitioner that the challenged claims are not entitled to the provisional filing date and should be afforded a priority date no earlier than October 25, 2001. *See* Pet. 5. Consequently, I would conclude that Härmä qualifies as prior art, as Petitioner alleges.

On the current record, I would also conclude that Härmä discloses each limitation of the challenged independent claim 18. As in the preamble to claim 18, Härmä discloses a communication service device operable with a communication network, specifically, “a mobile phone comprising a camera” that is operable with a radio network. Ex. 1008, 1:3, 5:29–35. Härmä further discloses a user using the mobile phone to receive and transmit information over the network, for example in a videoconference. *Id.* at 1:21–23, 2:16–24, Fig. 3a; *compare* Ex. 1001, 22:34–36 (identified by Petitioner as element 18[a] of claim 18). As shown in Härmä Figures 5a and 5b, Härmä discloses a mobile phone comprising a housing with a first side and an opposite second side, the first side comprising a display 3 and a first camera 4, and the second side comprising a second camera 7. Ex. 1008, 6:4–16, Figs. 5a, 5b; *compare* Ex. 1001, 22:37–46 (elements 18[b]–18[d]).

The final limitation of claim 18 reads:

wherein the first and second input devices and first display devices are carried by the housing in an orientation to allow the at least one user to access the at least one first input device and first display device from the first side of the housing at the same time as the at least one second input device from the second side of the housing.

Ex. 1001, 22:47–62 (element 18[e]). Petitioner asserts that there are two possible interpretations of this language: (1) Petitioner’s preferred interpretation, that “at least one user” encompasses preferred embodiments involving two users, one on each side of the device; or (2) Patent Owner’s apparent interpretation, that “at least one user” encompasses a single user that uses the first and second input device and the first display at the same time, for example by showing the inputs from the two cameras in a split-screen view on the first display. Pet. 24–25.

In this *inter partes* review, claims would be construed using the same standard used to construe the claims in a civil action under 35 U.S.C. § 282(b). *See* 37 C.F.R. § 42.100(b). This standard includes construing claims in accordance with the ordinary and customary meaning of such claims, as would have been understood by one of ordinary skill in the art at the time of the invention. *See id.*; *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (en banc). “The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). I would conclude that for the purposes of institution it is not necessary to resolve the dispute regarding the interpretation of element 18[e] because the Härmä device could be used according to either party’s interpretation. For example, Härmä Figures 3a and 3b depict a user viewing a split-screen display of the inputs from both cameras at the same time. Ex. 1008, 5:7–23, Figs. 3a–3b.

Patent Owner’s only argument with regard to Härmä, other than asserting that the challenged claims are entitled to the provisional filing date, Prelim. Resp. 11, is that “the information received and transmitted in Härmä is limited to still photographs and video clips, even during video conferencing. *Id.* at 47 (citing Ex. 2001 ¶¶ 59–62). According to Patent Owner, “[t]he ’168 Patent requires real-time or near real-time information to be received and transmitted over the network.” *Id.* Specifically, Patent Owner would construe the term “receive and transmit information” in claim 18 to mean “real-time or near real time audio and visual information.” *Id.* at 15–16 (citing Ex. 1001, 5:60–61); *see also* Ex. 1001, 1:16–18 (“The

present invention relates generally to a system, method, and apparatus for providing real-time or near real time interpreting services for utilization on a network.”).

Here also, I would conclude that for institution purposes it is unnecessary to resolve whether Patent Owner’s proposed claim construction is correct because Petitioner would be equally likely to prevail under Patent Owner’s construction. In Härmä, “the object of the invention is a mobile phone that enables capturing still pictures and video clips, for instance in a video conference, in a versatile and easily applicable fashion.” Ex. 1008, 1:21–23. On the current record, there is no sharp distinction between “near real time visual information,” which Patent Owner and Dr. Theogarajan acknowledge would include some buffering, Prelim. Resp. 46; Ex. 2001 ¶ 127, and video clips sent over the course of a videoconference, *see* Ex. 1008, 1:4–5 (“[m]ore and more often mobile phones include a camera that enables capturing still pictures and video clips, as well as their use in video conferences.”); *see also* Ex. 1004 ¶¶ 60–67 (describing the state of the art of videoconferencing during the late 1990s). I disagree with the Majority’s conclusion that the two expert declarations are “in equipoise” on this point. Neither expert explains whether there is a significant difference between, for example, near-real time video with a five-second delay due to buffering and a video “clip” that is stored for five seconds before transmission. The relevant question is whether the video disclosed in Härmä is transmitted during a videoconference, and here the experts are in agreement. Dr. Chatterjee testifies that the Härmä mobile phone “can be used for ‘video conferencing[,]’” Ex. 1004 ¶ 146, while even Dr. Theogarajan acknowledges that in Härmä, “video clips are captured and

sent in a video conference[,]” Ex. 2001 ¶ 63. Thus, even if Patent Owner’s claim construction is correct, Petitioner would still be reasonably likely to establish that Härmä, in combination with the knowledge of one of ordinary skill in the art during the relevant time period, discloses each limitation of challenged claim 18, rendering the claim unpatentable as obvious.

II. DISCRETIONARY DENIAL

Because Petitioner has established that there is a reasonable likelihood that it would prevail with respect to at least one of the claims challenged in the petition, institution of an *inter partes* review is proper unless some grounds for discretionary denial exist. 35 U.S.C. § 314(a). Institution of a review remains discretionary “even when a petitioner demonstrates a reasonable likelihood of prevailing with respect to one or more claims.” *Deeper*, Paper 7, 42 (citing *SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 366 (2018)); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”). Exercise of that discretion, however, is bounded by the requirement to construe our rules to “secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b).

A. *Common Bases for Discretionary Denial*

There are a number of grounds for denying institution of *inter partes* review based on a potentially meritorious petition, none of which apply in this instance. For example, the Board may deny institution if there are multiple proceedings before the Office involving the patent at issue. Under section 325(d) of Title 35, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C.

§ 325(d); *see Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential); *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential) (§ III.C.5, first para. only). Here, Petitioner correctly argues that the asserted prior art was not of record before the Examiner and is materially different from the prior art considered during examination. Pet. 8; *see generally* Ex. 1003.

Similarly, the Board may deny institution if multiple petitions for *inter partes* review of the same patent are filed. *See General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (informative). Here, “[t]his is the first and only petition challenging the ’168 Patent.” Pet. 6.

Perhaps the most common reason for a discretionary denial is the presence of parallel litigation in a Federal district court or before the U.S. International Trade Commission. In this circumstance, the Board is guided by six interrelated factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”), with the goal of balancing efficiency, fairness, and patent quality. When considering related litigation, the Board evaluates the following factors (“*Fintiv* factors”):

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;

4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Fintiv, Paper 11, 5–6. In evaluating these factors, the Board will “take[] a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.”⁸ *Id.* at 6.

⁸ On June 21, 2022, the Director issued an Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation, which the Acting Director rescinded on February 28, 2025 (“Rescinded Interim *Fintiv* Guidance”). This document is available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

Subsequently, on March 24, 2025, the Chief Judge of the Board issued Guidance on USPTO's rescission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (the “March 2025 *Fintiv* Guidance”). The March 2025 *Fintiv* Guidance is available at https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_rescission_20250324.pdf. Consequently, we now apply *Fintiv* and the March 2025 *Fintiv* Guidance, and do not apply the Rescinded Interim *Fintiv* Guidance.

Additionally, on March 26, 2025, the Acting Director issued a Memorandum setting forth new Interim Processes for PTAB Workload Management for evaluating discretionary denial of institution (the “Interim Processes for PTAB Workload Management”). These Interim Processes apply to IPR and PGR proceedings where the patent owner's preliminary response is due after March 26, 2025.

Here, because the Preliminary Response was due on February 21, 2025, the new Interim Processes do not apply. *See* FAQs for Interim Processes for

For the purposes of this Decision, I would analyze the *Fintiv* factors as follows. Factor 1 weighs in favor of institution because in the parallel district court litigation the court issued a stay on November 21, 2024 pending the final resolution of this IPR proceeding. Ex. 1026. Factor 2 also weighs in favor of institution because the district court has set a trial date of September 2026, four months after an *inter partes* review would conclude. Factor 3, investment in the parallel proceeding by the court and the parties, also favors institution. Petitioner represents that the district court litigation is “just beginning” and that under the scheduling order issued in September 2024, before the stay was granted, fact discovery would not have opened until May 2025. Pet. 7; Ex. 1013, 4. Factor 4 is neutral. While the same claims of the ’168 patent are asserted in both the Petition and in the

PTAB Workload Management, available at <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>:

*What is the process if a patent owner filed a POPR, or the deadline for filing a POPR passed, on or before the Process Memorandum issued on March 26, 2025? In this situation, the bifurcated process is not available, and a Board panel will proceed as it would have before the Process Memorandum issued. Thus, during the preliminary phase of an AIA proceeding, a Board panel will address any discretionary considerations and merits and other non-discretionary considerations the parties raise (e.g., in a petition or a POPR), as enumerated in previously existing Board precedent (including *Fintiv*, *General Plastic*, and *Advanced Bionics*) and the Consolidated Trial Practice Guide (Nov. 2019). The panel will not address any new factors outlined in the Process Memorandum, nor consider a request for rehearing based on those new factors.*

district court Complaint, *see* Ex. 1012, there is a *Sotera*-type⁹ stipulation in effect stating that if the Board institutes *inter partes* review on the grounds presented in the Petition, the Petitioner will not pursue an invalidity defense in the parallel district court litigation that “the patent claims subject to the instituted IPR are invalid based on grounds that were raised or reasonably could have been raised in the IPR.” Ex. 1027. Factor 5 weighs in favor of denial, as the Petitioner is the same as the defendant in the parallel litigation. *See* Ex. 1012. Finally, Factor 6 is slightly neutral. While Petitioner has shown a reasonable likelihood that its arguments have merit, as discussed above, Patent Owner has identified one circumstance, discussed below, that could affect the Board’s exercise of discretion.

Patent Owner identifies a total of five circumstances that, in Patent Owner’s view, would justify denying institution in this proceeding. First, Patent Owner suggests that it is unlikely that Petitioner will prevail. Prelim. Resp. 62. For the reasons discussed above, I am not persuaded by this argument. Second, only four of the twenty-one claims in the ’168 patent are asserted in the Petition. *Id.* Patent Owner does not explain the relevance of this point. Third, the patent has expired, and Patent Owner “will be irreparably harmed if one or more claims survive this *inter partes* review and after an 18-month IPR delay, the ‘stayed’ litigation is restarted and takes another 18 months.” *Id.* This argument is also unpersuasive. Since the patent has expired, only past infringement will be at issue in district court, for which Patent Owner can be made whole through a damages award. Fourth,

⁹ *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 18–19 (PTAB Dec. 1, 2020) (precedential). While such stipulations are not dispositive, they are one of many factors to be weighed in a *Fintiv* analysis.

the case has been assigned to Judge Albright of the Western District of Texas, who, according to Patent Owner, prefers to bring cases to trial within eighteen months. *Id.* at 62–63. This argument is also not relevant to the *Fintiv* analysis. The district court litigation was already stayed when Judge Albright was assigned to the case, Ex. 1026, and discovery has not begun, Ex. 1013. The Board does not speculate on whether a district court judge will change the trial date in an issued scheduling order, but takes that order at face value. The current trial date set for the parallel district court litigation is in September 2026, after any *inter partes* review would conclude.

Ex. 1013. Finally, Patent Owner argues that “the USPTO’s Patent and Trademark Appeal Board’s (PTAB) Administrative Judges staffing may have issues over the next 18 months. This case is not a good use of judicial resources[.]” Prelim. Resp. 63. I discuss this issue further in the following section. For the purposes of assessing *Fintiv* Factor 6, I conclude that Patent Owner’s concern for the potential burden on the Board, at best, renders Factor 6 neutral.

In sum, *Fintiv* Factors 1–3 favor institution of an *inter partes* review, Factors 4 and 6 are neutral, and only Factor 5, the identity of the parties, weighs against institution. Weighing all of the factors while taking a holistic view that balances the concern for efficiency with the concern for the integrity of the system, *see Fintiv*, Paper 11, 6, I would conclude that the facts of this case do not warrant discretionary denial based on the existence of parallel district court litigation.

B. The Majority’s Discretionary Denial Analysis

Although Petitioner has met the statutory threshold for institution under 35 U.S.C. § 314(a), the Majority declines to institute on the grounds

that it would not be an efficient use of the Board's time and resources to institute review. Relying on the reasoning in *Chevron*, Paper 9, 10–11, and *Deeper*, Paper 7, 42–43, the Majority finds that institution would not serve the just, speedy, and inexpensive resolution of the parties' dispute. See 37 C.F.R. § 42.1(b).

In *Chevron*, the petitioner demonstrated a reasonable likelihood of prevailing on two dependent claims out of a total of twenty challenged claims. *Chevron*, Paper 9, 11. In other words, only ten percent of the challenges raised had a reasonable likelihood of success. The Board concluded that “instituting a trial with respect to all twenty claims based on evidence and arguments directed to dependent claims 3 and 4 is not an efficient use of the Board's time and resources.” *Id.*

In *Deeper*, the petitioner's arguments had merit for just two claims and one ground out of twenty-three challenged claims and four asserted grounds. *Deeper*, Paper 7, 42–43. In other words, only nine percent of the twenty-three claim challenges were reasonably likely to succeed at trial. As in *Chevron*, the Board concluded that “based on the particular facts of this proceeding,” institution would not be “an efficient use of the Board's time and resources.” *Id.* at 43.

Here, Petitioner has challenged four claims on four grounds. Even if Petitioner only prevailed on asserted Ground 3 for the reasons discussed above, the result would be that three out of four challenged claims, including the independent claim, would be unpatentable in light of Härmä. In other words, Petitioner has shown a reasonable likelihood that it will prevail on *seventy-five* percent of the challenged claims. I would conclude that this is

reason enough to conclude that the “particular facts of this proceeding” are not similar to those in *Chevron* and *Deeper*.

There are, moreover, other reasons why the current Petition does not present the kind of complexity that led the *Chevron* and *Deeper* panels to deny institution. First, this is not a case where we would need to address a large volume of claims and grounds when only one or two dependent claims are really at issue. Petitioner has challenged only one independent claim and three dependent claims. Pet. 1. Second, the technology at issue is simple, as are the prior art references, which reduces the burden on the Board. Third, there are only three references to consider, and three of the four grounds asserted rely on single prior art references. *See id.* at 6. Fourth, two of the grounds asserted not only rely on the same single reference but overlap so completely that the Petition discusses them together, as does the Majority. *See id.* at 13–37 (combining anticipation Ground 1 and obviousness Ground 2). In my view, addressing the allegations raised in this Petition would not present an undue burden on the Board.

Patent Owner is correct that “Congress specifically contemplated that regulations implementing IPRs might include ‘a safety valve that allows the Office to decline to institute further proceedings if a high volume of pending proceedings threatens the Office’s ability to timely complete all proceedings.’” Prelim. Resp. 63–64 (quoting 157 Cong. Rec. S1377 (daily ed. Mar. 8, 2011)). While Patent Owner suggests that the Board may face staffing issues “over the next 18 months[,]” *id.* at 63, the Board has already taken steps to address these potential issues through a bifurcated discretionary denial review process that applies to proceedings with a patent owner preliminary response due after March 26, 2025. *See* FAQs for Interim

Processes for PTAB Workload Management, available at <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>. In other words, a safety valve is already in place should it be needed in the future. In my view, it would be better to rely on that safety valve in future cases, should the need arise, rather than to pre-emptively deny institution in an otherwise meritorious case that is not subject to the new review process and would not place a significant burden on the Board. Consequently, on this record I would find that Petitioner has shown it is reasonably likely to prevail with regard to at least one challenged claim and that there is no need to exercise our discretion to deny institution of an *inter partes* review.

III. CONCLUSION

After considering the substantive merits of the Petition, a holistic analysis of the *Fintiv* factors on the facts involved, and the potential burden on the Board of conducting an *inter partes* review in this proceeding, I would conclude that based on the record before us, the facts of this case do not warrant discretionary denial.

Accordingly, I would institute *inter partes* review of all claims on all grounds raised in the Petition, and, respectfully, I dissent.

IPR2025-00101
Patent 10,499,168 B2

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