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Paper 15
Date Entered: September 2, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.,
Petitioner
v.

ATI TECHNOLOGIES, ULC,
Patent Owner.

Case IPR2015-00327
Patent 6,897,871 B1

Before JONI Y. CHANG, BRIAN J. McNAMARA, and JAMES B. ARPIN, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

DECISION
Denying Request for Rehearing
37C.F.R. § 42.71(d)

DISCUSSION

On August 10, 2015, LG Electronics ("Petitioner") filed a Request for Rehearing (Paper 14, "Req. Reh'g.") of our Decision on Institution (Paper 13, "Dec. on Inst.") entered on July 10, 2015. The burden of showing a decision should be modified lies with the party challenging the decision. 37 C.F.R. § 42.71(d). 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, an opposition, or reply. *Id.* For the reasons discussed below, the Request for Rehearing is *denied*.

The Petition challenges claims 1–3, 5, 6, 8–11, 13, 15, 17, 18, and 20 based on Stuttard and Owens alone and in combination with other references that Petitioner applied in challenges to the same claims in IPR2015-00326 ("the Companion Case"). Dec. on Inst. 6. Our Decision on Institution notes that, after considering the similarities between Stuttard and Owens, as asserted in the Petition, and Rich and Lindholm, as asserted in the Companion Case, Petitioner's arguments in this proceeding were substantially the same as those Petitioner advanced in the Companion Case. *Id.* at 11–12. Notwithstanding Petitioner's application of different primary references, in view of the overlapping arguments and our institution of *inter partes* review of the same claims in the Companion Case, we exercised our discretion under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108 (a) and declined to institute against the same claims in this proceeding. *Id.* at 11.

Petitioner contends that our Decision on Institution is contrary to the language of 35 U.S.C. § 325(d), which states that, in determining whether to institute a proceeding, the Director may take into account whether, and reject the petition or request because, the same or substantially the same arguments

previously were presented to the Office. Req. Reh'g. 2. According to Petitioner, the arguments presented in IPR2015-00327 ("the Present Proceeding") are not arguments previously presented to the Board because they were filed on the same day as the Companion Case. *Id.* at 4.

Petitioner's argument fails for at least several reasons. First, our Decision on Institution does not rely exclusively on 35 U.S.C. § 325(d). As our Decision notes, we exercised our discretion more broadly under 35 U.S.C. § 314(a) and 37 C.F.R. § 108(a), and we articulated our rationale for doing so. Dec. on Inst. 11–12.

Second, Petitioner fails to recognize the discretionary nature of 35 U.S.C. § 325(d), which states that the Director "*may* take into account" arguments presented previously. 35 U.S.C. § 325(d) does not impose a requirement to institute or not institute a proceeding under Chapter 30, 31 or 32.

Third, Petitioner proposes an unworkable statutory interpretation under which our discretion and the statute's intent would be circumvented by a Petitioner who files an unlimited number of Petitions on the same day, regardless of how closely related the issues are in those Petitions. Petitioner, thus, would thwart the just, efficient and speedy resolution of matters by filing on the same day multiple petitions citing different references that disclose substantially the same subject matter. *See*, 37 C.F.R. § 42.1(b) ("This part [42] shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.")

Fourth, Petitioner's position is contrary to the legislative history cited in the Request for Rehearing. Req. Reh'g. 3–4 (citing 157 Cong. Rec. S1360-S1394 at S1376 (March 8, 2011) (remarks of Senator Jon Kyl)). The

quoted history states that the second sentence of § 325(d) "will prevent parties from mounting attacks on patents that raise issues that are substantially the same as issues that were already before the Office with respect to the patent" and will address the problem caused by the requirement for the Patent Office to accept many requests for reexamination "that raise challenges that are *cumulative to or substantially overlap* with issues previously considered by the Office with respect to the patent." *Id.* (emphasis added). In the Present Proceeding, for the reasons articulated in the Decision on Institution, we determined that the challenges presented in the Petition were substantially the same and cumulative to the challenges presented and previously considered in the Companion Case.

Petitioner's decision to file both petitions on the same day does not change the fact that we considered the challenges in the Companion Case and that they are substantially the same as those in the Present Proceeding. Petitioner contends that the arguments in the Present Proceeding are completely different from those found in the Companion Case because of the *different primary prior art references*. *Id.* at 4–6. Petitioner notes that Stuttard and Owens are assigned to different entities and published on different dates from Rich and Lindholm. *Id.* at 5. However, Petitioner does argue any error in our determination that Stuttard and Owens disclose substantially the same subject matter as Lindholm and Rich or that the arguments presented in the Present Proceeding are not substantially different from those presented in the Companion Case.

Finally, citing several other cases, Petitioner contends that we have never applied § 325(d) to concurrently-filed Petitions direct to the same patent. *Id.* at 6–8. However, as discussed above, § 325(d) does not mandate

that we institute or not institute any review. The scope of our discretion is not so limited as Petitioner contends. *See, ASUSTEK Computer Inc. v. EXOTABLET, Ltd.*, Case IPR2015-00043, slip op. at 9–10 (PTAB Apr. 23, 2015) (Paper 6) (denying institution under 37 C.F.R. § 42.108(a) in view of institution of petition challenging the same claims of same patent on a different reference filed the same day in IPR2015-00046).

In consideration of the above, Petitioner has not demonstrated that we overlooked or misapprehended any matters in our Decision on Institution.

ORDER

Accordingly, it is:

ORDERED that the Request for Rehearing is *denied*.

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