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Paper 10
Entered: January 30, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD,
SAMSUNG ELECTRONICS AMERICA, INC.,
SAMSUNG SEMICONDUCTOR, INC., and
SAMSUNG AUSTIN SEMICONDUCTOR LLC,
Petitioners,

v.

HOME SEMICONDUCTOR CORPORATION,
Patent Owner.

Cases IPR2015-00459 (Patent 6,150,244)
IPR2015-00460 (Patent 6,146,997)
IPR2015-00466 (Patent 6,030,893)
IPR2015-00467 (Patent 6,030,893)[1]

Before JONI Y. CHANG, JON B. TORNQUIST, and BETH Z. SHAW, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

DECISION
Granting Motion to Correct Filing Date Recorded in PRPS
37 C.F.R. § 42.6

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[1] This Decision addresses the same issues in the above-identified cases. Therefore, we exercise our discretion to issue one Decision to be entered in each of the identified cases. The parties, however, are not authorized to use this style heading in any subsequent papers.

Petitioners, Samsung Electronics Co. Ltd, Samsung Electronics America, Inc., Samsung Semiconductor, Inc., and Samsung Austin Semiconductor LLC (collectively, "Samsung"), filed a Motion to Correct the filing date of its Petition recorded in the Patent Review Processing System ("PRPS") for each of the above-identified *inter partes* reviews. Paper 3, "Mot."[2] Patent Owner, Home Semiconductor Corporation ("HSC"), filed an Opposition to Samsung's Motion in each proceeding at issue. Paper 8, "Opp." For the reasons set forth below, Samsung's Motions are *granted*.

INTRODUCTION

The Board's electronic filing system, PRPS, was down with technical difficulties, and unavailable for parties to submit petitions or other documents electronically, for three days—from December 16, 2014 to December 18, 2014.

For administrative efficiency, the Board adopted the following special procedure to be followed during this emergency outage, and published it on the Board's Web site (at http://www.uspto.gov/ip/boards/bpai/prps.jsp):

> **PRPS is currently down as of December 16, 2014 3:00 pm EST.**
>
> PTAB will be extending deadlines for the parties for all matters that do not have statutory deadlines until the site becomes available. As for petition filings, patent owner responses, motions, and requests for rehearing (on institution decisions or final decisions) and any other matters that have an imposed deadline or statutory due date, the parties should send an e-mail to TRIALS@USPTO.GOV indicating

[2] For the purpose of clarity and expediency, we treat IPR2015-00459 as representative, and all citations are to IPR2015-00459 unless otherwise noted.

> the need to file one of these items. DO NOT send attachments. PTAB will authorize filing of late attachments and PTAB will change the filing dates in PRPS to reflect the appropriate filing date. ALL MATTERS SHOULD BE SERVED ON OPPOSING COUNSEL ON THE APPROPRIATE DUE DATE.

See Mot., Appendix 1 (which contains a screenshot of the notice).

The Board also indicated to parties who contacted the Board during the emergency outage that the Board will consider a petition or document that is submitted in accordance with the aforementioned special procedure to be filed timely. Subsequently, the Board published a second notice regarding the PRPS emergency outage, which, in part, provides the following:

> Accordingly, for a matter with an imposed deadline or statutory due date, the Board deems filed, in accordance with 37 C.F.R. § 42.6(b)(1), any paper enumerated in the notice above that was submitted in accordance with the instructions set forth above, as of the date an e-mail was sent to Trials@uspto.gov indicating the need to file the paper, as long as the paper was served on opposing counsel on the appropriate due date, and the paper, accompanied by the appropriate fee, was subsequently submitted in PRPS when it became available.

See http://www.uspto.gov/ip/boards/bpai/prps.jsp, Ex. 3001.

On December 17, 2014, Samsung, following the Board's special procedure, sent an e-mail to the Board, for each of the above-identified proceedings, notifying the Board of its Petition filings. Mot., Appendix 2. In each e-mail, Samsung also indicated that it concurrently served HSC with the Petition and corresponding Exhibits. *Id*. at Appendix 2, 3. Therefore, the record before us indicates that Samsung could have submitted, on December 17, 2014, its Petitions to the Board electronically in accordance with the Board's normal procedure under 37 C.F.R. § 42.6(b)(1), but for the unavailability of PRPS.

Once PRPS was up and available on December 19, 2014, Samsung exercised reasonable diligence and submitted electronically, via PRPS, the Petitions, the appropriate fee payments, and corresponding Exhibits. Paper 1; Exs. 1001–1013. Samsung also concurrently submitted the instant Motions, requesting that the Board change the dates recorded in PRPS to reflect the correct filing date, December 17, 2014, in accordance with the Board's special procedure, for each proceeding at issue. Mot. 3.

In its Opposition, HSC does not dispute that Samsung complied with the Board's special procedure for filing its Petitions. Opp. 8. Instead, HSC argues that Samsung's Motions should be denied because each e-mail sent by Samsung on December 17, 2014, did not include the contents of a petition as required by 35 U.S.C. § 312(a). *Id*. at 2, 4–6. For instance, HSC alleges that the e-mail did not identify the challenged claims and asserted grounds of unpatentability or include the fee payment. *Id*. at 4. HSC further contends that the Board cannot excuse Samsung's inadequate submission as a clerical error in uploading the documents, and the Board lacks authority to waive statutory requirements. *Id*. at 6–9.

We are not persuaded by HSC's arguments, as they focus narrowly on the e-mails and do not consider the totality of the factual evidence in the record. Based on our review of the entire record before us, we determine that Samsung followed the proper procedure for filing its Petitions during the PRPS December 16–18 emergency outage, and, therefore, each of the Petitions at issue should be accorded a filing date of December 17, 2014.

DISCUSSION

Certain content requirements of a petition for *inter partes* review are set forth in 35 U.S.C. § 312(a), which provides:

> REQUIREMENTS OF PETITION.—A petition filed under section 311 may be considered only if—
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> (1) the petition is accompanied by payment of the fee established by the Director under section 311;
>
> (2) the petition identifies all real parties in interest;
>
> (3) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim, including—
>
> (A) copies of patents and printed publications that the petitioner relies upon in support of the petition; and
>
> (B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on expert opinions;
>
> (4) the petition provides such other information as the Director may require by regulation; and
>
> (5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner.

This statute, however, does not specify the manner of filing a petition for *inter partes* review. Rather, the procedure for filing petitions is set forth in regulations promulgated by the Director, pursuant to 35 U.S.C. § 316. *See* 35 U.S.C. § 316(a)(4) ("The Director shall prescribe regulations establishing and governing *inter partes* review under this chapter . . . ."). The regulations were promulgated taking into consideration "the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter." 35 U.S.C. § 316(b). Moreover, the rules governing the

conduct of *inter partes* review are construed to secure "the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b).

The manner of filing a petition is governed, in part, by 37 C.F.R. § 42.6(b)(1), which provides:

> *Electronic filing.* Unless otherwise authorized, submissions are to be made to the Board electronically via the Internet according to the parameters established by the Board and published on the Web site of the Office.[3]

HSC does not dispute that the Board has the authority to promulgate this rule. *See generally* Opp. Nor does HSC allege that the Board's normal procedure published on the Board's Web site exceeds the Board's statutory authority. *Id.* at 9, n.1. Instead, HSC argues that 35 U.S.C. § 312(a) defines the minimum attributes necessary to constitute a petition for *inter partes* review, and the Board may not disregard these requirements when it established the special procedure for filing petitions and other documents during the PRPS December 16–18 emergency outage. *Id*. at 9.

The Board, however, did not disregard the requirements of 35 U.S.C. § 312(a), as alleged by HSC. In fact, the Board's special procedure required Samsung, for each proceeding, to notify the Board of its filing by sending an e-mail to the Board and to serve on HSC a complete Petition with corresponding Exhibits, on December 17, 2014, before the statutory deadline under 35 U.S.C. § 315(b). This provided HSC adequate notice of the basis of relief by identifying the challenged claims, asserted grounds of unpatentability, and supporting

[3] *See* http://www.uspto.gov/ip/boards/bpai/prps.jsp.

evidence. HSC does not allege that it was not served properly with the Petitions, or that the Petitions do not comply with the content requirements of 35 U.S.C. § 312(a). *See generally* Opp.

The Board's special procedure also required Samsung to exercise due diligence and submit its Petitions electronically via PRPS, once PRPS was available. The instant record shows that Samsung indeed submitted each Petition accompanied by the appropriate fee payment, in compliance with 35 U.S.C. § 312(a)(1), when PRPS became available after the December 16–18 emergency outage. HSC does not allege that those electronic submissions via PRPS are incomplete. Nor does HSC contend that there are discrepancies between the served Petitions and the Petitions submitted via PRPS. *See generally* Opp.

For administrative efficiency, the Board's special procedure instructed parties not to send attachments in the e-mail, and did not require parties to submit the petition or document via Priority Mail Express. In establishing the special procedure, the Board considered many factors. Notably, the Board observed an unexpected high number of filings in December of 2014 (nearly two hundred petitions), and most of the petition filings have numerous exhibits and large files. The Board's e-mail system would not have been able to handle these additional demands. Moreover, paper filings via Priority Mail Express would create significant administrative burdens and delays.

In light of the extraordinary circumstances, the Board's special procedure provided parties a just, speedy, and inexpensive mechanism for filing petitions and documents during the PRPS December 16–18 emergency outage, in consistence with 35 U.S.C. §§ 312(a) and 316.

As discussed above, HSC does not dispute that Samsung complied with the Board's special procedure for filing its Petitions. Opp. 8. Indeed, the record shows that Samsung exercised reasonable diligence in filing its Petitions, in accordance with the Board's special procedure. Based on our review of the entire record, we determine that Samsung's Petitions comply with all of the requirements of 35 U.S.C. § 312(a).

For the foregoing reasons, we accord each of the Petitions at issue a filing date of December 17, 2014.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Samsung's Motions to Correct the filing date recorded in PRPS are *granted*; and

FURTHER ORDERED that the filing date recorded in PRPS for each Petition and the corresponding Exhibits filed in the above-identified proceedings will be changed to December 17, 2014, upon entry of this Decision.

IPR2015-00459 (Patent 6,150,244)
IPR2015-00460 (Patent 6,146,997)
IPR2015-00466 (Patent 6,030,893)
IPR2015-00467 (Patent 6,030,893)

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