

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD., SAMSUNG ELECTRONICS
AMERICA, INC., SAMSUNG TELECOMMUNICATIONS AMERICA LLC,
SAMSUNG SEMICONDUCTOR INC., SAMSUNG AUSTIN
SEMICONDUCTOR LLC,
Petitioner,

v.

HOME SEMICONDUCTOR CORPORATION,
Patent Owner

Case IRP2015-00460
Patent 6,146,997

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
CORRECT PRPS SYSTEM INDICATION OF FILING DATE
ASSOCIATED WITH DECEMBER 17, 2014 PETITION FOR *INTER*
PARTES REVIEW OF U.S. PATENT NO. 6,146,997**

For three days, from December 16, 2014 through December 18, 2014, the Board's PRPS filing system was off-line with technical difficulties. During this outage, on December 17, 2014, Petitioner Samsung submitted an email indicating an intent to file a petition seeking *inter partes* review of U.S. Patent No. 6,146,997, and subsequently, on December 19, 2014, filed such a petition. Samsung now seeks to have the December 19, 2014 Petition accorded a filing date of December 17, 2014.

Samsung's motion should be denied. Section 312(a) sets forth the required content of a petition for *inter partes* review. Samsung's e-mail conspicuously lacks nearly all of this required material, such as an identification of the challenged claims, an identification of the prior art and evidence, an explanation of the grounds for invalidity for each challenged claim, and the required fee. Because the email lacks the statutorily required material, it is not a petition.

That Samsung ostensibly followed the temporary instructions on the Board's website does not justify granting the motion. The Board cannot waive statutory requirements. Thus, to the extent that the Board's temporary procedure did not require submission of the mandatory materials set forth in 35 U.S.C. § 312, it is outside the Board's authority to act. For these reasons, Samsung should not be granted a filing date of December 17, 2014.

1. STATEMENT OF MATERIAL FACTS.

1. From December 16, 2014 through December 18, 2014, the PTAB's PRPS system was suffering technical difficulties and was unavailable to the public. Paper 3, Appendix 1.

2. During this time period, the PTO posted the following notice on its website regarding procedures to be followed during the outage:

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 email to TRIALS@USPTO.GOV indicating the need to file one of these items. DO NOT send attachments.

Paper No. 3, Appendix 1. (emphasis original).

3. This procedure differs from the ordinary procedures that the PTAB has described on its website to be used in the event of a technical failure. These procedures provide that "if PRPS is unavailable during normal business hours, petitions (and other documents) may be submitted to the Board via email: Trials@uspto.gov." www.uspto.gov/ip/boards/bpai/prps.jsp (accessed 1/19/2015).

Paper filing is authorized if PRPS and the mailbox trials@uspto.gov are unavailable. *Id.*

4. On December 17, 2014, Samsung submitted an email to the electronic mailbox trials@uspto.gov. Paper No. 3, Appendix 2.

5. The December 17, 2014 email identifies the patent at issue and identifies the real parties in interest – various Samsung entities. *Id.*

6. The December 17, 2014 email does not identify, in writing and with particularity, each claim challenged, the ground on which the challenge to each claim is based, or the evidence that supports the grounds for challenging each claim. Paper No. 3, Appendix 2. Nor does the email identify or include copies of the patents and printed publications relied upon by Samsung. *Id.* The email does not authorize charging of a deposit account or otherwise arrange for the payment of the fee established by the Director. *Id.*

7. On December 19, 2014, Samsung filed a petition seeking review of the '997 patent. Paper No. 1.

8. On January 14, 2015, the PTO assigned a filing date of December 19, 2014 to the petition. Paper No. 4.

2. ARGUMENT.

2.1 Samsung's E-Mail Submission Does Not Meet The Statutory Requirements For A Proper Petition.

35 U.S.C. §312 sets forth the requirements of a petition requesting *inter partes* review of an issued United States Patent. In particular, Section 312(a)

provides:

A petition filed under section 311 may be considered *only if* –

(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 the 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.

35 U.S.C. 312(a) (emphasis added). Consistent with the statutory mandate, the PTO has established rules providing that an incomplete petition will not be accorded a filing date, and requiring a complete petition to include the required statutory materials. 37 C.F.R. 42.104 and 42.106.

Samsung's December 17th email does not satisfy the requirements of Section 312(a), which means that it is not a "petition." In particular, Samsung's email does not include the following:

- (1) The required fee. Samsung's email does not include the required fee, nor does it include authorization to charge a deposit account or any other recognized method of fee transmission;
- (2) An identification of the challenged claims.
- (3) An identification of the grounds on which each challenge is based, "in writing and with particularity";
- (4) Identification and copies of the prior art; and
- (5) Affidavits or declarations.

In sum, Samsung's email falls well short of the statutory requirements for a petition, and thus should not be treated as one.

Nor does relevant Board authority excuse this failure. The Board has considered filing errors in at least two cases, but in each case, there were critical factual distinctions between the facts at issue and those in the present case.

In *ConMed Corp. v. Bonutti Skeletal Innovations LLC*, IPR2013-00624, the Board considered whether a petition should be given a filing date of September 25, 2013, when it was uploaded into PRPS and served on the patent owner, or October 2, 2013, when the petitioner actually clicked "submit" on PRPS. Paper 18. The

Board concluded that the failure of a paralegal to click the “submit” button was a clerical error correctable under 37 C.F.R. 42.104(c). Paper 18 at 7. In particular, the Board found that the petition was uploaded into PRPS on September 25, and that the upload included all of the required statutory materials – including each claim challenged, the grounds of the challenge, and the evidence supporting the challenge. *Id.* at 6-7. In addition, the evidence showed that the fee was paid on September 25. *Id.* In this circumstance, the Board held that a paralegal’s failure to hit “submit” was a correctible clerical error.

Likewise in *ABB Inc. v. Roy-G-Biv Corp.*, IPR2013-00063, 2013 WL 6907728 (Patent Tr. & App. Bd. 2013), the Board considered whether a paralegal error in uploading copies of the petition and exhibits was correctible error under Rule 42.104(c). The Board concluded that Rule 104(c) was broad enough to encompass clerical errors in uploading the documents. *Id.* At *5. The Board further found that information entered into PRPS correctly on the original filing date provided notice of the parties, patent number, challenged claims, statutory grounds and exhibits relied upon. *Id.* at *6.

These cases do not excuse Samsung’s inadequate submission. While the PTO may have a policy of liberally interpreting Rule 42.104(c) to permit correction of filing errors, in both of these prior cases the information required by the statute had been entered into PRPS as of the filing date sought. No such facts

are present here – the email submitted to trials@uspto.gov lacks the required statutory information, and thus is not a petition. The later filed petition should not be entitled to the earlier email date.

2.2 That Samsung Followed The Board’s Website Notice Does Not Excuse The Inadequate Submission Because the Board Lacks Authority to Waive Statutory Requirements.

There is no dispute that Samsung followed the special procedure set forth on the Board’s website during the December PRPS outage. There is also no doubt that the Board has wide discretion in setting the manner of filing documents before it, and in determining when and whether to waive the requirements of its rules. *See, e.g.*, 37 C.F.R. 42.5. However, it is also beyond doubt, and a basic principle of administrative law, that the Board cannot establish procedures or rules that are inconsistent with the enabling statute. *See, e.g., In re Portola Packaging, Inc.*, 110 F.3d 786, 789 (Fed. Cir. 1997) (rejecting MPEP guidelines that were contrary to the reexamination statute); *Hoechst Aktiengesellschaft v. Quigg*, 917 F.2d 522, 526 (Fed. Cir. 1990) (“Since this court must reject administrative constructions of the statute that are inconsistent with the statutory mandate, we give no deference to the agency’s interpretations and conclusions.”) Where a statute clearly requires something, an agency like the PTO may not disregard statutory language. *Id.*

Section 315(b) precludes *inter partes* review, if “the *petition* requesting the proceeding is filed more than 1 year after the date on which the petitioner, real

party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b) (emphasis added). Section 312(a) defines the minimum attributes necessary to constitute a petition for *inter partes* review. The Board may not disregard these statutory mandates when it establishes substitute filing procedures, and cannot accept an email that lacks the required content as a “petition” requesting an *inter partes* review.¹

The Board decided to adopt procedures during the December 16-18 outage that do not comply with the statute authorizing *inter partes* review. Any email submitted using these procedures that does not include the mandatory information from Section 312(a), including that filed by Samsung in this case, is not a petition, and cannot establish a filing date for one. While denial of Samsung’s motion might seem like a harsh result – blame for this result rests squarely on Samsung who could have sought to file the petition before the very last day of the statutory period provided in Section 315(b) or who could have provided the required statutory material in the email, but did not. Moreover, Samsung will still have the ability to challenge the asserted patents during the district court action.

¹ In contrast, the Board’s normal procedures for dealing with technical difficulties with PRPS, when complied with, would pass statutory muster. Submission of the documents to be filed via email to trials@uspto.gov, or submission of the documents to be filed by Priority Mail Express, would have been acceptable because all information required by Section 312 would be submitted to the PTO.

3. CONCLUSION.

For the reasons set forth above, Samsung is not entitled to a filing date of December 17, 2014, and their motion (Paper No. 3) should be denied.

Dated: January 20, 2015

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on January 20, 2015, a true and correct copy of the foregoing **PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO CORRECT PRPS SYSTEM INDICATION OF FILING DATE ASSOCIATED WITH DECEMBER 17, 2014 PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 6,146,997** was served via email to the Petitioners by serving the correspondence email addresses of record as follows:

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