

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

LG ELECTRONICS, INC.,

Petitioner

v.

ATI TECHNOLOGIES ULC,

Patent Owner.

---

Case IPR2015-01620

Patent 7,095,945 B1

---

BRIAN J. McNAMARA, RAMA G. ELLURU, and  
JAMES B. ARPIN, *Administrative Patent Judges*

McNAMARA, *Administrative Patent Judge.*

DECISION

Denying Motion For Joinder And  
Denying Institution Of *Inter Partes* Review  
*37C.F.R. § 42.122(b), § 42.108*

## INTRODUCTION

LG Electronics, Inc. (“Petitioner”) filed a Petition, Paper 2 (“Pet.”), requesting that we institute an *inter partes* review of claim 21 (the “challenged claim”) of U.S. Patent No. 7,095,945 B1 (Ex. 1001, “the ’945 Patent”). 35 U.S.C. § 311. Petitioner identifies LG Electronics U.S.A., Inc. and LG Electronics MobileComm U.S.A. as real parties-in-interest with Petitioner. Pet. 1. Petitioner also filed a Motion for Joinder with IPR2015-00321. Paper 3 (“Mot.”). In IPR2015-00321, we instituted a trial on challenges to claim 18, but declined to institute a trial of Petitioner’s challenge to claim 21. *LG Electronics, Inc. v. ATI Techs. Inc.*, Case IPR2015-00321, slip op. at 13–17 (PTAB Jun 26, 2015) (Paper 20) (“Decision to Institute”). ATI Technologies ULS (“Patent Owner”) filed an Opposition to the Motion (Paper 7, “Opp. to Mot.”) and Petitioner filed a Reply to Patent Owner’s Opposition (Paper 8, “Reply”). On November 11, 2015, Patent Owner also filed a Preliminary Response (Paper 9, “Prelim. Resp.”) to the Petition.

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the petition “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.”

For the reasons set forth below, we exercise our discretion under 35 U.S.C. § 315(c) and deny Petitioner’s Motion for Joinder with IPR2015-00321. In the absence of joinder, the Petition is barred under 35 U.S.C. § 315(b). Therefore, we do not institute a trial of challenged claim 21.

## PENDING LITIGATION

The ’945 Patent is the subject of a patent infringement lawsuit brought by Advanced Micro Devices, Inc. in the Northern District of California: *Advanced*

*Micro Devices, Inc., et al., v. LG Electronics, Inc., et al.*, Case No. 3:14-cv-01012. Pet. 1; Paper 6, 2. It is undisputed that Petitioner was served with a complaint in this patent infringement suit more than one year before the filing date of the Petition. Thus, absent joinder, where the one year time bar imposed by statute does not apply, the Petition is barred as untimely. 35 U.S.C. § 315(b), (c).

#### THE '945 PATENT (EXHIBIT 1001)

The '945 Patent explains that a transport stream (TS) consists of fixed length packets based on a four byte header and 184 bytes of data payload obtained from larger data blocks. Ex. 1001, col. 1, ll. 61–64. Elementary Streams are packetized into fixed or variable length “packetized elementary stream (PES) packets and PES packets are merged to create a program with its own system time clock (STC). *Id.* at col. 1, l. 65–col. 2, l. 9. Elementary streams (ES) within one program have periodic time stamps corresponding to the STC counter to indicate proper timing for each ES. *Id.* at col. 2, ll. 10–12. Figures 1–4 illustrate conventional signal structures. *Id.* at col. 2, ll. 49–50.

The '945 Patent discloses a system and method for displaying multimedia programs in real time and/or storing them for subsequent display, including as a time shifted display in which the stored portion of the program is played back while new portions of the program are being stored. Ex. 1001, Abstract. The '945 Patent discloses three modes of operation: (1) a receive only mode, i.e., the Transparent Mode, in which a digital transport stream receiver (DTSR) receives a live broadcast, which is accessed immediately and not saved, *id.* at col. 3, ll. 45–53; (2) a Continuous Time Shifting Mode, in which a received program is stored in the form of full transport stream packets or packetized elementary stream (PES) packets; and (3) a Part-Time Shifting Mode, in which a time shifted program is

played at a user defined speed, e.g., fast forward, while the host central processing unit (CPU) receives and stores a real time event. *Id.* at col. 4, ll. 1–8.

The '945 Patent discloses several programmed embodiments of the Part-Time Shifting mode using this system. *Id.* at col. 6, l. 13–col. 7, l. 48.

### CHALLENGED CLAIM

Claim 21, which is drawn to a system, is the only claim at issue in this proceeding and is reproduced below:

21. A system comprising:
- a first input node to receive a multiplexed packetized data stream that carries real-time multimedia programs;
  - a first transport stream demultiplexer having an input coupled to the first input node to select packets of data having a predefined packet identifier and an output to provide the select packets of data;
  - a storage device having a data port coupled to the output of the first transport stream demultiplexer to receive the select packets, wherein the storage device is to store the select packets;
  - a first clock recovery module having an input coupled to the first input node, and an output, wherein the first clock recovery module is to generate a clock at the output based upon received timing information transmitted in packets of the multiplexed packetized data stream before the select packets are stored in the storage device; and
  - a decoder having a first input coupled to the output of the first clock recovery module to receive the clock, a second input coupled the data port of the storage device to receive the select packets, and an output to provide decoded real-time data.

#### ART CITED IN PETITION

Designation	Reference	Date	Exhibit No.
Hatanaka	US 6,397,000 B1	May 28, 2002	(Ex. 1006)
Anderson	US 6,275,507 B1	Aug. 14, 2001	(Ex. 1010)
Hoogenboom	US 5,517,250	May 14, 1996	(Ex. 1009)

#### BASIS OF PETITION

Claim	Basis	References
21	§ 103(a)	Hatanaka and Hoogenboom
21	§ 103(a)	Hatanaka and Anderson

#### MOTION FOR JOINDER

We begin our analysis by addressing Petitioner’s Motion for Joinder. Petitioner moves to join this proceeding with IPR2015-00321. Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b). As indicated in the legislative history, the Board determines whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case. *See* 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (when determining whether and when to allow joinder, the Office may consider factors including the breadth or unusualness of the claim scope, claim construction issues, and consent of the patent owner). When exercising that discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. 37 C.F.R. § 42.1(b).

On June 26, 2015, in IPR2015-00321, we entered a Decision to Institute an *inter partes* review of claim 18 of the ’945 Patent as obvious over U.S. Patent No. 6,397,000 B1 (“Hatanaka”) alone and the combination of Hatanaka and U.S. Patent No. 6,951,058 B1 (“O’Connor”). *LG Electronics, Inc. v. ATI Techs. Inc.*, Case

IPR2015-00321, slip op. at 17–19 (PTAB June 26, 2015) (“IPR2015-00321 Dec.to Inst.”). In that Decision to Institute, we declined to institute a trial on Petitioner’s challenge to claim 21 under 35 U.S.C. § 102 (e) as anticipated by Hatanaka. *Id.* at 13–17.

On July 24, 2015, Petitioner filed the Petition in this IPR2015-01620, asserting that claim 21 is obvious under 35 U.S.C. § 103(a) over Hatanaka in view of U.S. Patent No. 5,517,250 (“Hoogenboom”) and obvious under 35 U.S.C. § 103(a) over Hatanaka in view of U.S. Patent No. 6,275,507 (“Anderson”). Neither Hoogenboom nor Anderson were cited in IPR2015-00321. Petitioner also filed its Motion For Joinder of this proceeding with IPR2015-00321. On August 24, 2015, Patent Owner filed its Opposition to Petitioner’s Motion For Joinder. On September 24, 2015, Petitioner filed its Reply.

Petitioner argues that Joinder is permissible under our rules and that, at the time Petitioner filed its motion, Joinder would minimally impact the current trial schedule. Mot. 6–9. Petitioner further argues that Joinder would be efficient and not prejudice Patent Owner because this proceeding involves the same parties and same subject matter as that in IPR2015-00321. *Id.* at 4–6. Specifically, Petitioner asserts that its arguments in the Petition regarding Hatanaka overlap the arguments it made in its petition in IPR2015-00321 (“First Petition”). *Id.* at 4–5. Petitioner further notes that the technical expert supporting its contentions in this proceeding is the same as the expert Petitioner employed in IPR2015–00321.

Patent Owner opposes Joinder on the grounds that Petitioner has failed to meet its burden to demonstrate that Joinder is appropriate. Opp. to Mot. 3. Patent Owner contends (1) that Petitioner is not entitled to use our Decision to Institute in IPR2015-00321 as a roadmap to obtain a “second bite at the apple”; (2) that

Petitioner has failed to provide good cause or reason to warrant a “second bite at the apple”; and, (3) that the facts of the case merit denial of Joinder. *Id.* at 4.

Petitioner’s Reply does not address Patent Owner’s “second bite at the apple” argument directly, but contends that Patent Owner would not be prejudiced by the addition of two new references because of the overlapping subject matter and because the primary reference, Hatanaka, is already a reference in the instituted *inter partes* review. Reply 4–5. According to Petitioner, it would not be a substantial burden for Patent Owner to respond to two additional references directed at one claim, where the subject matter overlaps an already instituted *inter partes* review. *Id.* Petitioner cites Patent Owner’s response to its petition in related case IPR2015-00325, where Patent Owner has presented four new declarations and over 100 exhibits, as further evidence that Patent Owner would not incur additional cost or effort. *Id.* at 5.

Although the parties dispute the propriety of same party Joinder, we need not address this issue because we are not persuaded that the circumstances in this proceeding warrant Joinder regardless of whether same party joinder is permissible. Petitioner cites our Decision in *Samsung v. Virginia*, Case IPR2014-00557, slip op. at 18 (PTAB June 13, 2014) (Paper 10) for the proposition that, given the undisputed facts of this case, we should grant Petitioner’s motion for joinder because it will result in a “minimal amount of additional work” for Patent Owner, and the Petition and the First Petition involve “the same patent and parties... substantially the same exhibits... [and] substantial overlap in the asserted references.” Reply 2. While in some cases, we have permitted joinder as an expedient way to obtain a just resolution of all issues, e.g., *Samsung v. Virginia*, Case IPR2014-00557, slip op. at 18 (PTAB June 13, 2014) (Paper 10), in others, particularly where our Decision to Institute has been used as a roadmap to remedy

deficiencies in an earlier petition, we exercised our discretion under 35 U.S.C. § 315(c) and declined to grant joinder. *Samsung Electronics Co. Ltd. et al. v. Affinity Labs of Texas, LLC*, Case IPR2015-00820, slip op. at 4 (PTAB May 15, 2015)(Paper 12); *Atoptech, Inc. v. Synopsys, Inc.*, Case IPR2015-00760, slip. op. at 8–9 (PTAB July 21, 2015) (Paper 14).

“A decision to institute review on some claims should not act as an entry ticket, and a how-to guide . . . to challenge those claims which [the petitioner] unsuccessfully challenged in the first petition.” *ZTE Corp. et al. v. ContentGaurd Holdings, Inc.*, Case IPR2013-00454, slip op. at. 5–6 (PTAB Sept. 25, 2013) (Paper 12). The Board is concerned about encouraging, unnecessarily, the filing of petitions that are partially inadequate. *Id.* By “[p]ermitting second chances” the Board needs to “be mindful not only of this proceeding, but of ‘every proceeding’” when exercising its discretion, for such cases will inevitably “tie[] up the Board’s limited resources.” *See Samsung Elecs., et al. v. Rembrandt Wireless Tech., LP*, Case IPR2015-00555, slip op. at 8 (PTAB June 19, 2015) (Paper 20) (exercising discretion under 35 U.S.C. § 325(d) to deny institution and finding motion for joinder moot).

We are not persuaded by Petitioner’s contention that its arguments concerning anticipation by Hatanaka and its challenge to claim 21 based on the combination of Hatanaka and other references in the Petition overlap the arguments Petitioner made in the First Petition in IPR2015-00321.<sup>1</sup> Our Decision

---

<sup>1</sup> In its Preliminary Response, Patent Owner argues that the Petition is redundant to the First Petition, that Hatanaka is structurally different from claim 21 and that Hatanaka suffers from several deficiencies not cured by Hoogenboom or Anderson. Prelim. Resp. 2–3. In particular, Patent Owner contends that Hatanaka does not teach the claimed storage device or the claimed first clock recovery module. *Id.*



to Institute in IPR2015-00321 noted deficiencies in the First Petition. IPR2015-00321 Dec. to Inst. 13–17. Aside from its claim charts, the First Petition provides only 14 lines of text explaining its analysis of how Hatanaka demonstrates anticipation of claim 21. IPR2015-00321, Pet. 38–39. We specifically noted Petitioner’s contention concerning the recitation in claim 21 “wherein the first clock recovery module is to generate a clock at the output based upon received timing information transmitted in packets of the multiplexed packetized data stream before the select packets are stored in the storage device.” *Id.* at 22. Petitioner argued that clock recovery unit 13 of Hatanaka is the claimed clock recovery module, but did not explain how in Hatanaka the production of a time stamp prior to storing the packets teaches generation of a clock, as claimed. IPR2015-00321 Dec. to Inst. 16. We also noted that the First Petition did not address how in Hatanaka the generation of a stable clock by the clock recovery module from clock 46 discloses the limitations recited in claim 21 of the ’945 Patent. *Id.*

The Petition abandons the First Petition’s challenge to claim 21 as anticipated under 35 U.S.C. § 102(e) by Hatanaka and asserts new challenges, with a different statutory basis, i.e., obviousness under 35 U.S.C. § 103(a) based on the combination of Hatanaka and Hoogenboom and Hatanaka and Anderson. In the Petition, guided by our Decision to Institute in IPR2015-00321, Petitioner cites two new references and provides explanation missing from the First Petition concerning its theory of how Hatanaka discloses a clock recovery module based on received timing information transmitted in packets of the multiplexed data stream. Pet. 15–17. Petitioner also cites Hoogenboom as explicitly disclosing generating a clock at the output based upon received timing information transmitted in packets of the multiplexed packetized data stream before the select packets are stored in the

storage device. *Id.* at 17, 21–26. According to Petitioner, it would have been obvious to one of ordinary skill to combine this disclosure with Hatanaka’s system. *Id.* Petitioner also cites to Anderson as disclosing a clock recovery module. Pet. 30–34.

In consideration of the above, we agree with the Patent Owner that joinder is not appropriate in this case because the Petition uses our Decision to Institute in IPR2015-00321 as a guide to remedy deficiencies in the First Petition. Although there may be efficiencies to gain from addressing the same claims in *inter partes* review that are at issue in pending district court litigation, permitting second chances without constraint undermines judicial efficiency by expending our resources on issues that were not adequately presented the first time. *Atoptech, Inc.*, Case IPR2015-00760, slip. op. at 8–9.

Petitioner has not demonstrated a reasoned justification for its failure to assert in the First Petition the obviousness challenges it asserts in this Petition. Petitioner presents no argument or evidence that Anderson or Hoogenboom was not known or available at the time Petitioner filed the First Petition. As discussed above, the arguments in the Petition concerning Hatanaka and claim 21 were cursory and inadequate. The Petition now presents arguments that Petitioner could have made in the First Petition, had it chosen to do so. The Petition is aimed at matters identified in the Decision to Institute in IPR2015-00321 as not adequately addressed to justify *inter partes* review. *See Travelocity.com L.P. v. Cronos Technologies, LLC*, Case CBM2015-00047, slip op. at 13 (PTAB June 12, 2015) (Paper 7) (“[A] decision on a petition for covered business method review is not simply part of a feedback loop by which a petitioner may perfect its challenges through a subsequent filing.”).

In consideration of the above facts and circumstances, we exercise our discretion under 35 U.S.C. § 315(c) and deny Petitioner's Motion for Joinder.

#### DECISION ON PETITION

Institution of *inter partes* review is barred when the petition is filed more than one year after the petitioner is served with a complaint alleging infringement of the patent. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b).

The record indicates that Petitioner was served with a complaint more than one year before filing the Petition. Accordingly, in view of our decision to deny Petitioner's Motion for Joinder, we deny the Petition because it was not filed within the time limit imposed by 35 U.S.C. § 315(b)

#### ORDER

In consideration of the above, we do not institute *inter partes* review.

PETITIONER:

Robert G. Pluta

Amanda K. Streff

MAYER BROWN LLP

[rpluta@mayerbrown.com](mailto:rpluta@mayerbrown.com)

[astreff@mayerbrown.com](mailto:astreff@mayerbrown.com)

[AMDIPR@mayerbrown.com](mailto:AMDIPR@mayerbrown.com)

PATENT OWNER:

Michael B. Ray

Lestin L. Kenton, Jr.

Michael D. Specht

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

[mray-PTAB@skgf.com](mailto:mray-PTAB@skgf.com)

[lkenton-PTAB@skgf.com](mailto:lkenton-PTAB@skgf.com)

[mspecht-PTAB@skgf.com](mailto:mspecht-PTAB@skgf.com)