

PTAB Uses Recent Precedent In Backing Elm Over Samsung

By **Matthew Bultman**

Law360, New York (October 19, 2017, 10:18 PM EDT) -- The Patent Trial and Appeal Board rejected Samsung's challenge to a semiconductor patent it has been accused of infringing, capping a series of victories for the owner, Elm 3DS Innovations, with a ruling that builds upon a holding that put limits on multiple petitions.

The PTAB on Tuesday denied Samsung Electronics Co. Ltd.'s request for inter partes review of various claims in Elm 3DS Innovations LLC's patent. Micron Technology Inc. and SK Hynix Inc. previously challenged this same patent but lost after the board said they hadn't shown the disputed claims were likely invalid.

Reaching its decision, the board relied on **several factors** outlined last month by an expanded panel to be used as a baseline for determining whether to institute review when multiple petitions challenge the same patent. On a whole, the PTAB said those factors weighed against review.

"We do not take lightly denying a petition on grounds unrelated to its substantive patentability challenges," the board wrote. But "after weighing the respective factors here, and in the particular circumstances of this proceeding, we exercise our discretion ... and decline to institute inter partes review."

The ruling is noteworthy because the expanded panel in *General Plastic v. Canon Kabushiki* dealt with multiple petitions filed by the same party. Some had raised questions about how the PTAB would deal with a situation where a different party was responsible for the subsequent petition.

"The rhetoric has been that PTAB tends to favor petitioners, but I think to the contrary: In this decision you can see that they are indeed considering the equities from the patent owner's perspective, at least in these situations where there's multiple petitions filed against the same patent," said Michael Newman of Mintz Levin Cohn Ferris Glovsky and Popeo PC, an attorney for Elm.

Elm's patent relates to memory circuit technology used in devices such as cellphones. It is one of 13 owned by the patent licensing entity that was challenged at the PTAB after it sued Samsung, Micron and SK Hynix for infringement.

In a series of decisions this summer, the PTAB handed Elm a **sweeping victory** and upheld the validity of claims in 11 of those patents; those decisions have been appealed to the Federal Circuit. The two challenged claims in one other patent were found invalid.

Tuesday's decision addressed the last open challenge to Elm's patent portfolio. Samsung filed the petition in April, several months after the PTAB denied review in challenges that Micron and SK Hynix brought against the patent.

Based on some of the arguments made, the PTAB said Samsung appears to have benefited from the earlier decisions, even though it wasn't involved in their proceedings. The board also said Samsung in its petition used some testimony offered by Elm's experts in those earlier cases.

"Furthermore, if we were to institute a review here, petitioner would be able to use the final written

decisions from fourteen inter partes reviews, which address many of the same issues, to improve its position,” the board wrote, saying this weighed strongly in favor of denying the challenge.

Representatives for Samsung declined to comment.

The patent at issue is U.S. Patent Number 8,791,581.

Samsung is represented by Naveen Modi, Allan Soobert, Phillip Citroen and Joseph Rumpler of Paul Hastings LLP.

Elm is represented by William Meunier, Michael Renaud and Michael Newman of Mintz Levin Cohn Ferris Glovsky and Popeo PC.

The case is Samsung Electronics Co. Ltd. v. Elm 3DS Innovations LLC, case number IPR2017-01305, before the Patent Trial and Appeal Board.

--Editing by Adam LoBelia.

Correction: An earlier version of this story misattributed a quote made by an attorney for Elm. The error has been corrected.