

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SEOUL SEMICONDUCTOR CO., LTD., and  
SEOUL SEMICONDUCTOR, INC.,  
Petitioner,

v.

DOCUMENT SECURITY SYSTEMS, INC.,  
Patent Owner.

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Case IPR2018-00265  
Patent 6,949,771 B2

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Before SALLY C. MEDLEY, SCOTT C. MOORE, and  
BRENT M. DOUGAL, *Administrative Patent Judges*.

DOUGAL, *Administrative Patent Judge*.

DECISION  
Denying Patent Owner's Request for Rehearing  
*37 C.F.R. § 42.71*

## INTRODUCTION

Patent Owner filed a Request for Panel Rehearing (Paper 13, “Reh’g Req.”) of our Decision instituting an *inter partes* review (Paper 8, “Institution Decision”) of claims 1–9 of U.S. Patent No. 6,949,771 B2. We deny Patent Owner’s Request for Panel Rehearing for the reasons set forth below.

## STANDARD OF REVIEW

When considering a request for rehearing a decision instituting trial, the Board reviews its decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if the decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if an unreasonable judgment is made in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). We further note that 37 C.F.R. § 42.71(d) states:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

We now turn to Patent Owner’s asserted errors in the Institution Decision.

## ANALYSIS

We instituted review of all challenged claims on all four asserted grounds. Dec. 12. Patent Owner asserts, however, that we only evaluated a single claim and two grounds in violation of 37 C.F.R. § 42.108, which, according to Patent Owner, requires us to include in every decision to institute an evaluation and analysis of every claim and every ground.” Reh’g Req. Patent Owner’s arguments are not

persuasive.

First and foremost, *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018), requires the Board, when instituting, to institute review of all claims in a petition after determining there is a reasonable likelihood that at least one of the claims challenged is unpatentable. *Id.* at 1356. In *SAS*, the Supreme Court, interpreting 35 U.S.C. § 314, held that a petitioner “is entitled to a final written decision addressing all of the claims it has challenged . . . .” *Id.* at 1359–60. Title 35, section 314(a), directs, in relevant part, that “[t]he Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition . . . and any response . . . 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.” The Supreme Court determined that “Section 314(a) does not require the Director to evaluate every claim individually. Instead, it simply requires a decision whether the petitioner is likely to succeed on ‘at least 1’ claim.” 138 S. Ct. at 1356. The Court explained: “[o]nce that single claim threshold is satisfied, it doesn’t matter whether the petitioner is likely to prevail on any *additional* claims; the Director need not even consider any other claim before instituting review.” *Id.* (emphasis original). Further, the Court emphasized: “Rather than contemplate claim-by-claim institution . . . the language [of section 314(a)] anticipates a regime where a reasonable prospect of success on a single claim justifies review of all.” *Id.*

Accordingly, the Supreme Court’s interpretation of the law in *SAS* controls the institution decision. Patent Owner does not address the Supreme Court’s instructions in *SAS* concerning institution decisions. *See generally* Reh’g Req. In particular, Patent Owner has not provided any persuasive justification for why we should interpret our Rules to require an evaluation and analysis of every claim and

every ground notwithstanding the Supreme Court’s instructions to the contrary. In any event, we disagree with Patent Owner that we did not provide a sufficient analysis regarding all challenged claims and grounds for the following reasons.

The Petition challenges claims 1–9 of the ’771 patent. Claims 1–8 are independent and similar to each other. Patent Owner recognizes that independent claims 1–8 “include many elements in common.” Prelim. Resp. 12, 22. In fact, all of Patent Owner’s arguments in the Preliminary Response are addressed to these common elements. *Id.* Even Patent Owner’s arguments concerning the two grounds surrounding dependent claim 9, which depends from independent claim 8, rely on the common elements from the independent claims. *Id.* at 30 (arguing that “Ground 3 fails for the same reasons as Ground 1” and “Ground 4 fails for the same reasons as Ground 2”).

In particular, Patent Owner’s Preliminary Response focuses on common limitations present in independent claims 1–8, namely a “light source” including:

- a substrate having opposing first and second surfaces, the substrate defining an aperture extending from the first surface to the second surface, said aperture having a first opening in the first surface and second opening in said second surface;
- a platform covering said first opening,
- a light emitting diode mounted on the platform within the aperture, and
- a transparent encapsulant material encapsulating the light emitting diode in the aperture.

Prelim. Resp. 12; *see also, id.* at 22. Patent Owner then states that claims 1–5, 7 and 8 also “require that the platform is ‘located outside of said aperture.’” *Id.* at 13; *see also, id.* at 22. Claim 9 depends from claim 8 and thereby also requires these common elements. With the exception of noting that some of these limitations are not present in claim 6, Patent Owner’s Preliminary Response makes

no distinction between any of the challenged claims.

Though not acknowledged by Patent Owner, the Institution Decision substantively addresses each and every argument raised by Patent Owner in its Preliminary Response. One familiar with the record would understand that though the Institution Decision analyzes Patent Owner's arguments with respect to representative claim 1, the analysis is equally applicable to each of the other challenged claims because Patent Owner argued the claims as a group.

Patent Owner makes the broad assertion that it "set forth reasons why each of these four grounds is deficient," but Patent Owner does not identify any specific argument presented by Patent Owner that is not addressed in the Institution Decision. Thus, Patent Owner's request fails to identify any overlooked matter previously addressed by Patent Owner. *See* 37 C.F.R. § 42.71(d).

#### CONCLUSION

For the foregoing reasons, we conclude that Patent Owner has not shown that the Panel abused its discretion in the Institution Decision.

#### ORDER

For the reasons given, it is

ORDERED that Patent Owner's Request for Panel Rehearing is *denied*.

IPR2018-00265  
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PETITIONER:

Michael Eisenberg  
HOLLAND & KNOGHT LLP  
Michael.eisenberg@hklaw.com

Charles H. Sanders  
Jonathan M. Strang  
LATHAM & WATKINS LLP  
Charles.sanders@lw.com  
Jonathan.strang@lw.com

PATENT OWNER:

Wayne M. Helge  
James T. Wilson  
Aldo Noto  
DAVIDSON BERQUIST JACKSON & GOWDEY L.L.P.  
whelge@dbjg.com  
jwilson@dbjg.com  
anoto@bdjg.com