

DOCKET NO: 0100157-00244

By: Peter Dichiara, Reg. No. 38,005 (Lead Counsel)
David L. Cavanaugh, Reg. No. 36,476 (Back-up Counsel)
Wilmer Cutler Pickering Hale and Dorr LLP
1875 Pennsylvania Avenue NW
Washington, DC 20006
Tel: (202) 663-6025
Email: David.Cavanaugh@wilmerhale.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EMC Corporation and VMware, Inc.

Petitioner

v.

PersonalWeb Technologies LLC.

Patent Owner

U.S. Patent No. 6,415,280.

IPR Case No. IPR2013-00083

**REQUEST FOR REHEARING UNDER 37 C.F.R. § 42.71(C)–(D)
OF DECISION TO INSTITUTE INTER PARTES REVIEW**

**THE PETITIONER’S REQUEST FOR REHEARING UNDER 37 C.F.R.
§ 42.71(C)–(D) OF DECISION TO INSTITUTE *INTER PARTES* REVIEW**

On May 17, 2013, the Board issued a Decision under 35 U.S.C. § 311 (the “Decision”) *inter alia* authorizing *inter partes* review of claims 36 and 38 of U.S. Patent No. 6,415,280 (the ‘280 patent) on two of the grounds presented in the Petition filed December 15, 2013 (the “Petition”), specifically:

- A. Claims 36 and 38 as anticipated under 35 U.S.C. § 102(e) by Woodhill.
- B. Claims 36 and 38 as unpatentable under 35 U.S.C. § 103(a) over Woodhill.

Decision at 19.

The remaining grounds of unpatentability proposed in the Petition were determined to be redundant to the above grounds and therefore denied. The Petitioner agrees that the references are redundant insofar as each ground of unpatentability is sufficient to invalidate the claims.

However, the references and denied grounds are not redundant in all respects and for all purposes. For example, Woodhill is prior art under § 102(e), whereas some of the other cited grounds involve § 102(b) references which cannot be

antedated.¹ As outlined in the Petition, each of the references also has different technical teachings. The Patent Owner may present declarations or propose claim amendment(s) or new claims that would make these references non-redundant. The Patent Owner may attempt to distinguish the challenged claims from the references used in the granted grounds of unpatentability in ways that would be wholly insufficient when compared to the presently-denied references. Indeed, the Patent Owner has already confirmed that the references have different technical substance and attempted to distinguish the references in different ways in its Preliminary Statements in other, related *inter partes* reviews. See, e.g., IPR2013-00082. A key purpose of this Request is thus to address the potential for prejudice to the Petitioner which could result from removing grounds and references that the Board has already confirmed are highly relevant and in fact provide a reasonable basis for unpatentability.

The Petitioner recognizes that there are strong principles of administrative efficiency and economy that counsel in favor of a focused proceeding. Consequently, the Petitioner requests that the Board address this Request in one of

¹ As identified in the Petition, Langer (published August 1991), Satyanarayanan (published May 1990) and Kantor (published August 1993) were each published more than a year before the filing date of the '280 patent. Petition at 3-5.

two ways to balance the concerns for a focused, efficient proceeding with the concerns of prejudice to the Petitioner:

1. Grant certain grounds of unpatentability, previously denied in error as redundant,² but hold in abeyance any further application of these

² Petitioner has sought to limit the number of grounds to grant on rehearing in view of statements already made in the Decision. In particular, Petitioner seeks grant of Ground 1 because it was error to deny it as redundant in that Browne contains different technical substance than Woodhill, *compare* Petition at 28-39 *with* Petition at 39-48, a fact confirmed, for example, in Patent Owner's Preliminary Statement in IPR 2013-00082 ("Prelim. Statement IPR '82") in which it sought to distinguish Woodhill in ways wholly inapplicable to Browne and which were not argued for Browne. *Compare* Prelim. Statement IPR '82 at 18-25 *with* 35-47. Petitioner also seeks grant of Ground 6 because it was error to deny it as redundant in that Satyanarayanan and Langer are references under § 102(b) and cannot be antedated whereas Woodhill is a § 102(e) reference, and in that Satyanarayanan and Langer contain different technical substance than Woodhill, *see* Petition at 51-56, a fact confirmed, for example, in Prelim. Statement IPR '82 in which the Patent Owner sought to distinguish Woodhill in ways wholly inapplicable to Langer and that were not argued for Langer. *Compare* Prelim. Statement IPR '82 at 26-34 *with* 35-47.

Grounds until and unless the course of the Trial causes one of them to become non-redundant; or

2. Consider the present Request as timely-filed but hold the Request in abeyance until and unless the course of the Trial causes one of grounds to become non-redundant. In this case, certain grounds of unpatentability, previously denied in error as redundant, are the same as those identified above, and the Petitioner would alert the Board of events which would require the Board to make a Decision on this Request.

In this manner, the Board, the Patent Owner, and the Petitioner may all focus their efforts on the grounds granted in the Decision to Institute Trial and proceed in an efficient and timely manner, yet balance the concern for prejudice of removing certain references and grounds that are already acknowledged as providing a reasonable basis for unpatentability and which may become non-redundant as a result of actions outside of the control of the Petitioner.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.