

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

Case IPR2013-00083 (JYC)
U.S. Patent No. 6,415,280

Before KEVIN F. TURNER, JONI Y. CHANG, and
MICHAEL R. ZECHER, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*

DECISION
EMC Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

EMC Corporation and VMware, Inc. (“EMC”) filed a request for rehearing (Paper 27, “Req.”) of the decision on institution (Paper 19, “Dec.”), which instituted *inter partes* review of claims 36 and 38 of U.S. Patent 6,415,280 (“the ’280 patent”). In its request, EMC essentially contends that the Board should authorize certain grounds of unpatentability that were denied as redundant, but hold those grounds in abeyance “until and unless the course of the Trial causes one of them to become non-redundant.” Req. 3-4. The request for rehearing is *denied*.

II. ANALYSIS

When rehearing a decision on institution, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment 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); and *In re Gartside*, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000).

In determining whether to institute an *inter partes* review of a patent, the Board may “deny some or all grounds for unpatentability for some or all of the challenged claims.” 37 C.F.R. § 42.108(b). Rules for *inter partes* review proceedings were promulgated to take into account the “regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings.” 35 U.S.C. § 316(b). In

addition, as mandated by 35 U.S.C. § 316(a)(11), 37 C.F.R. § 42.100(c) was promulgated to require that the final written determination in an *inter partes* review to be issued one year after the date of institution, except that the review may be extended by not more than six months for good cause shown.

In the decision on institution for the instant proceeding, the Board granted EMC's petition to institute an *inter partes* review of all of the challenged claims of the '280 patent—namely (1) claims 36 and 38 as anticipated under 35 U.S.C. § 102(e) by Woodhill; and (2) claims 36 and 38 as unpatentable under 35 U.S.C. § 103(a) over Woodhill. In rendering the decision on institution, the Board exercised its discretion in denying all other asserted ground as being redundant in light of the two grounds for which review was instituted. Dec. 18-19.

EMC seeks reconsideration of the decision on institution denying those grounds. In particular, EMC argues that the references are not redundant in all respects and for all purposes. Req. 1. According to EMC, each of the references has different technical teachings, and PersonalWeb may present declarations, propose claim amendments, or propose new claims “that would make these references non-redundant.” Req. 2. EMC also urges the Board to balance the concerns for a focused, efficient proceeding with the concerns of prejudice to EMC by authorizing certain denied grounds, but hold those grounds in abeyance “until and unless the course of the Trial causes one of them to become non-redundant.” Req. 3-4.

EMC's arguments are not persuasive. The proper focus of a redundancy designation is not whether the applied prior art disclosures have differences, for it is rarely the case that the disclosures of different prior art references will be

literally identical. Rather, the focus is on whether the petitioner articulated a meaningful distinction in terms of relative strengths and weaknesses with respect to application of the prior art disclosures to one or more claim limitations. *See Liberty Mutual Ins. Co. v. Progressive Casualty Inc. Co.*, CBM2012-00003 (Paper No. 7), at *2 (PTAB, Oct. 25, 2012). Furthermore, the possibility that PersonalWeb may amend a challenged claim or add a new claim to recite something other than what EMC has cited initially does not generally present a genuine need for granting redundant grounds. EMC may oppose a motion to amend and respond to new issues arising from the amendment including evidence supporting their opposition. *See 37 C.F.R. § 42.23 and Section H of the Office patent Trial Practice Guide*, 77 *Fed. Reg.* 48756, 48767 (Aug. 14, 2012).

EMC fails to appreciate fully that the Board is charged with securing the just, speedy, and inexpensive resolution of every proceeding. 37 C.F.R. § 42.1(b). In its petition, EMC does not explain that any of the denied grounds are any more relevant than the grounds on which the review was instituted. In fact, EMC agrees “that the references are redundant insofar as each ground of unpatentability is sufficient to invalidate the claims.” Req. 1. Thus, we are not persuaded that the decision on institution should be altered in any way so that EMC may be in a better position to prevail.

With respect to EMC’s proposal of holding certain denied grounds in abeyance, such a serial procedure would introduce unnecessary, significant delays and inefficiencies. Notably, under such a procedure, if EMC loses the instituted grounds on appeal, the case would return to the Board to determine the denied grounds, which would require a second deposition of the same witnesses, a second

patent owner's response, and a second reply. In that situation, the final written determination most likely would not be issued within one year after the date of institution. Accordingly, we decline to adopt such a serial procedure that would cause unnecessary delays and inefficiencies.

For the forgoing reasons, EMC has not shown that the Board abused its discretion in denying the redundant grounds.

III. CONCLUSION

EMC's request for rehearing is *denied*.

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