Trials@uspto.gov
Tel: 571.272.7822

Paper 64
Entered: February 12, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC., LINKEDIN CORP., and TWITTER, INC.,
Petitioner,

v.

SOFTWARE RIGHTS ARCHIVE, LLC,
Patent Owner.

Cases IPR2013-00480 (Patent 5,832,494)
IPR2013-00481 (Patent 6,233,571)[1]

Before SALLY C. MEDLEY, CHRISTOPHER L. CRUMBLEY, and BARBARA A. PARVIS, *Administrative Patent Judges.*

PARVIS, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

[1] This order addresses issues that are the same in both identified cases. We exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

In these related proceedings, the Final Written Decisions were entered on January 29, 2015 and January 30, 2015.[2] On appeal, the Federal Circuit issued a decision *affirming-in-part* and *reversing-in-part* the Board's Final Written Decisions. *Software Rights Archive, LLC v. Facebook, Inc.*, 659 F. App'x 627, 643 (Fed. Cir. 2016) (nonprecedential). The Federal Circuit's Mandate was entered September 9, 2016.[3] On November 20, 2017, Patent Owner filed papers titled Requests for Rehearing ("Requests") in the instant proceedings. IPR2013-000480, Paper 62 ("'480 Req. Reh'g."); IPR2013-00481, Paper 63 ("'481 Req. Reh'g."). Patent Owner requests "to institute further *inter partes* review after return of the mandate from the Federal Circuit." *See, e.g.*, '480 Req. Reh'g., 1.[4]

As an initial matter, no decision has been issued from which rehearing can be requested. *See* 37 C.R.F. § 42.71(d). Patent Owner refers to a "Dismissal Decision," dated October 19, 2017. *See, e.g.*, '480 Req. Reh'g., 1 (citing Ex. 2127). The cited exhibit, however, is only an e-mail responding to a status inquiry. IPR2013-00480, Ex. 2127. We previously have cautioned against using e-mail for substantive communications to the Board. IPR2013-00481, Paper 41, 2 n.1. Accordingly, Patent Owner should have sought authorization to file its Requests in these proceedings. *See* 37 C.F.R. § 42.20. Patent Owner did not request or receive such authorization.

Rather than expunge Patent Owner's unauthorized Requests (37 C.F.R § 42.7(a)), we treat them as requests for authorization to file

[2] *See* IPR2013-00480, Paper 55; IPR2013-00481, Paper 54.
[3] *See* IPR2013-00480, Paper 60; IPR2013-00481, Paper 61.
[4] For purposes of expediency, for remaining citations, we refer to the papers filed in IPR2013-00480. Similar papers were filed in Case IPR2013-00481.

additional briefing. '480 Req. Reh'g. For the reasons given, we deny Patent Owner's requests.

Patent Owner's Requests are improper and inconsistent with the Federal Circuit's mandate. Patent Owner draws our attention to Standard Operating Procedure No. ("SOP") 9 and, more specifically, to the statement "[i]n ex parte appeals and reexamination appeals, reversals at the Federal Circuit are considered to be remanded cases to the PTO for further action." '480 Req. Reh'g., 5. Additionally, Patent Owner contends that based on Federal Circuit precedent and "[b]ased on the suggestion in PTAB SOP 9 that the Board 'consider the scope of the remand,' it necessarily follows that the Board has jurisdiction to resolve any remaining issues that have not yet been decided." *Id.* (citing Ex. 2129, 6).

We need not make a determination of whether we have jurisdiction because, based on the circumstances and facts in the instant proceedings, Patent Owner's Requests are improper and inconsistent with the Federal Circuit's mandate. Indeed, in Requests for Rehearing submitted to the Federal Circuit, Patent Owner took the position that the Federal Circuit's Decision is a reversal, not a remand. IPR2013-00480, Ex. 2128, 1 ("Respectfully, the Court's opinion errs because it reverses the PTAB's decision of patentability for lack of substantial evidence without any factual determination by the PTAB as to whether the remaining limitations unaddressed by the Court are present in the prior art."); *see also id.* at 3 ("Rather, this court must first determine whether the PTAB's finding was supported by substantial evidence . . . and, if unsupported, it must remand for the PTAB to decide in the first instance.").

Furthermore, Patent Owner's Requests raise improper arguments. For

example, Patent Owner provides contentions for "eliminating candidate cluster links, wherein the number of candidate cluster links are limited and the closest candidate cluster links are chosen over the remaining links," recited in claim 5. '480 Req. Reh'g. 9-11. This recitation, however, is discussed in the Federal Circuit's Decision. *Software Rights Archive*, 659 F. App'x at 641–42. As an additional example, Patent Owner contends that the asserted prior art "*never selects a single node for analysis*" ('480 Req. Reh'g., 12) and contends the deficiency applies to claims 15 and 16. (*id.* at 14). However, the "selecting" step is recited in independent claim 14, from which claims 15 and 16 depend, directly or indirectly. Ex. 1001, 52:51–53:3. In the Final Written Decision, we determined that Petitioner has shown by a preponderance of the evidence that claim 14 of the '494 Patent is unpatentable. IPR2013-00480, Paper 55, 2, 24. That determination has not been reversed. *Software Rights Archive* , 659 F. App'x at 643.

Accordingly, Patent Owner's Requests are denied.

ORDER

It is

ORDERED that Patent Owner's Requests, i.e., IPR2013-000480, Paper 62 and IPR2013-00481, Paper 63 are *denied*.

IPR2013-00480 (Patent 5,832,494)
IPR2013-00481 (Patent 6,233,571)

PETITIONER:

Heidi L. Keefe
Mark R. Weinstein
COOLEY LLP
hkeefe@cooley.com
mweinstein@cooley.com

David Silbert
Asim M. Bhansali
Sharif E. Jacobs
KEKER & VAN NEST LLP
djs@kvn.com
abhansali@kvn.com
sjacob@kvn.com

PATENT OWNER:

Martin M. Zoltick
Nancy J. Linck
Soumya P. Panda
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
mzoltick@rfem.com
nlinck@rfem.com
sanda@rfem.com

Minghui Yang
Victor Hardy
HARDY PARRISH YANG LLP
myang@hpylegal.com
vhardy@hpylegal.com