

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners,

v.

SOFTWARE RIGHTS ARCHIVE, LLC,

Patent Owner.

Case 2013-00480

Patent 5,832,494

PATENT OWNER'S REQUEST FOR REHEARING

UNDER 37 C.F.R. § 42.71(d)

Table of Contents

Table of Contents i

Table of Authorities ii

I. Summary of Issues for Rehearing 1

II. Argument 1

 A. The Federal Circuit’s Failure to Explicitly Order a Remand Does Not Preclude Further Consideration of SRA’s Unaddressed Arguments. 1

 B. The Board Must Consider SRA’s Unaddressed Arguments in a Final Decision before Invalidating Any Pending Claims. 5

 C. Unresolved Factual Issues Remain Concerning Claim 5..... 9

 D. Unresolved Factual Issues Remain Concerning the Selection of a Node and Claimed Alignment of Steps with Respect to a Selected Node found in Claims 1, 5, 15, and 16..... 11

 E. Nothing can be Inferred from the Federal Circuit’s Denial of SRA’s Combined Petition for Panel Rehearing and Rehearing En Banc. 14

III. Conclusion 15

Table of Authorities

Cases

<i>Ariosa Diagnostics v. Verinata Health, Inc.</i> , 805 F.3d 1359 (Fed. Cir. 2015).....	8
<i>Conway v. Chemical Leaman Tank Lines, Inc.</i> , 644 F.2d 1059 (5th Cir. 1981)	5
<i>Exxon Chem. Patents, Inc. v. Lubrizol Corp.</i> , 64 F.3d 1553 (Fed. Cir. 1995).....	2
<i>In re Lee</i> , 277 F.3d 1338 (Fed. Cir. 2002).....	7, 8
<i>In re Nuvasive, Inc.</i> , 841 F.3d 966 (Fed. Cir. 2016).....	6
<i>Laitram Corp. v. NEC Corp.</i> , 115 F.3d 9471 (Fed. Cir. 1997).....	4, 6, 8
<i>Laitram Corp. v. NEC Corp.</i> , 62 F.3d 1388 (Fed. Cir. 1995).....	4
<i>Shinn Fu Co. of Am. v. The Tire Hanger Corp.</i> , No. 2016-2250, 2017 U.S. App. LEXIS 11787 (Fed. Cir. Jul. 3, 2017)	6
<i>United States v. Cote</i> , 51 F.3d 178 (9th Cir. 1995)	15
Regulations	
37 C.F.R. § 42.2	1
37 C.F.R. § 42.71(d)	1

I. Summary of Issues for Rehearing

Pursuant to 37 C.F.R. § 42.71(d), Software Rights Archive, LLC (“SRA” or “Patent Owner”) requests rehearing of the Board’s refusal to institute further *inter partes* review after return of the mandate from the Federal Circuit, as reflected in electronic correspondence dated October 19, 2017. Ex. 2127 at 1. (“Dismissal Decision”). The Dismissal Decision held that, “In light of the Federal Circuit’s decision to affirm-in-part and reverse-in-part, the panel did not take further action, as the further actions proposed by Patent Owner are not consistent with the Federal Circuit’s mandate.” *Id.* As the Dismissal Decision indicates that the Board will take no further action with respect to this *inter partes* review, it constitutes a final decision within the meaning of 37 C.F.R. § 42.71(d) as well as a denial to “institute a trial” under that section. 37 C.F.R. § 42.2 (“A decision is final only if it disposes of all necessary issues with regard to the party seeking judicial review, and does not indicate that further action is required.”). As detailed below, the Board has failed to properly interpret the scope of the mandate in this action. Patent Owner respectfully requests that the Board withdraw the Dismissal Decision, and resolve the remaining factual issues as discussed below.

II. Argument

A. The Federal Circuit’s Failure to Explicitly Order a Remand Does Not Preclude Further Consideration of SRA’s Unaddressed Arguments.

On October 19, 2017, the Board declined to address pending issues that were

not addressed in the Federal Circuit's opinion ("Appeal Decision", Paper 60) regarding the appeal of the Board's Final Written Decision ("Final Decision", Paper 55). *See* Appellant's Combined Petition for Panel Rehearing and Rehearing En Banc, Docket No. 2015-1649 (Fed. Cir. Oct. 11, 2016) ("480 Rehearing Petition") (explaining in greater detail the arguments of Patent Owner that were not considered)(attached as Exhibit 2128). The Board did not articulate the reasoning for its Dismissal Decision, but Patent Owner's understanding is the Board adopted Petitioners' position that the Appeal Decision's failure to explicitly "remand" this proceeding deprives the Board jurisdiction for further proceedings on the merits.

With the upmost respect, Patent Owner submits that it was clear legal error for the Board to terminate this proceeding without addressing the arguments of Patent Owner that have yet to be considered. The Federal Circuit has squarely addressed the issue of a lower tribunal's jurisdiction in the absence of an explicit remand instruction after a reversal. In *Exxon Chem. Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553 (Fed. Cir. 1995) ("*Exxon I*"), the Federal Circuit reversed a District Court's finding of literal infringement without explicitly including a "remand" for further proceedings on unaddressed issues. *Exxon I*, 64 F.3d at 1561 (stating that the decision was a "reversal without remand..."). Exxon petitioned the Federal Circuit for rehearing to "clarify its opinion regarding Exxon's right to move for a new trial on doctrine-of-equivalents infringement." *Exxon Chem.*

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