

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

APPLE INC.  
Petitioner

v.

PERSONALWEB TECHNOLOGIES, LLC and  
LEVEL 3 COMMUNICATIONS, LLC  
Patent Owners

---

Case IPR2013-00596  
Patent 7,802,310

---

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

**PETITIONER APPLE INC.'S REQUEST FOR REHEARING  
UNDER 37 C.F.R. § 42.71(c) AND (d)**

***Mail Stop "PATENT BOARD"***  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TABLE OF CONTENTS**

I. Standard of Review ..... 1

II. The Board abused its discretion by not instituting *inter partes* review on the basis of Woodhill under 35 U.S.C. §§ 102(e)/(b) and 103(a)..... 2

III. The Board abused its discretion by not instituting *inter partes* review on the basis of Farber under 35 U.S.C. § 102(b). ..... 5

IV. Conclusion ..... 10

On March 26, 2014, the Board instituted *inter partes* review of claims 24, 32, 70, 81, 82, and 86 under 35 U.S.C. § 103(a) over the combination of Woodhill and Stefik (Ground 6). The Board declined to institute *inter partes* review on any of the eight additional grounds.

Petitioner Apple Inc. respectfully requests rehearing under 37 C.F.R. § 42.71(c) and (d) of the Board's decision not to institute *inter partes* review of claims 24, 32, 70, 81, 82, and 86 of the '310 patent on several grounds. Prior authorization is not required for filing this request. 37 C.F.R. § 42.71(d). The grounds that are the subject of this request for rehearing are as follows:

Ground	Basis	Reference(s)
4	35 U.S.C. § 102(e)/(b)	Woodhill
5	35 U.S.C. § 103(a)	Woodhill
9	35 U.S.C. § 102(b)	Farber

This request seeks reconsideration of the foregoing grounds of unpatentability as discussed in detail below.

#### **I. Standard of Review**

Apple's review of the Board's decision of March 26, 2014 is authorized under 37 C.F.R. § 42.71(c) and (d). Under 37 C.F.R. § 42.71(c), "[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion."

An abuse of discretion occurs when a "decision was based on an erroneous

conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co. Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988). *See also* 37 C.F.R. § 42.71(d) (“The request must specifically identify all matters the party believes the Board misapprehended or overlooked”).

**II. The Board abused its discretion by not instituting *inter partes* review on the basis of Woodhill under 35 U.S.C. §§ 102(e)/(b) and 103(a).**

The Board provides no rationale indicating that any consideration has been given to the proposed grounds of invalidity on the basis of Woodhill alone under pre-AIA 35 U.S.C. §§ 102(e)/(b)<sup>1</sup> and 103(a). The merits of these separate grounds of invalidity have been overlooked by the Board. The Board’s failure to institute on these grounds amounts to an abuse of discretion.

Institution of *inter partes* review on the basis of these further grounds of invalidity is consistent with the “just, speedy, and inexpensive resolution” of the proceeding as required under 37 C.F.R. § 42.1(b). Apple has fully briefed these arguments and presented rationale for their separate consideration. Failing to

---

<sup>1</sup> As discussed in detail with regard to Farber, below, the Board erred in its conclusion regarding the priority date of the ’310 patent. Under the correct priority date, both Woodhill and Stefik are 102(b) references, rather than 102(e).

institute on these grounds would unjustly prejudice Apple. Moreover, instituting on these grounds would still result in a speedy and inexpensive resolution of trial, as most of the issues are the same as those that would be briefed on the basis of the instituted ground.

The Board has agreed to institute *inter partes* review of the challenged claims on the basis of pre-AIA 35 U.S.C. § 103(a) over Woodhill in view of Stefik. Demonstrating invalidity under pre-AIA 35 U.S.C. §§ 102 (Woodhill) or 103 (Woodhill alone) would inherently show invalidity under 35 U.S.C. § 103 based on the combination of Woodhill in view of Stefik. However, even though Woodhill is part of the adopted ground of invalidity, Apple does not want to assume that the Board would allow an argument that Woodhill teaches every element of the petitioned claims at Trial. Apple should not have to address issues relating to the appropriateness of combining Woodhill or issues of secondary considerations if it can adequately demonstrate at Trial that Woodhill teaches each feature of the claims, and thus requests that the Board specifically institute trial on the additional basis of Woodhill alone under pre-AIA 35 U.S.C. §§ 102 or 103.

The instituted ground of invalidity is not redundant with the additional grounds on the basis of Woodhill alone. As discussed at p. 59 of the Petition, Stefik provides the strength of additional teachings regarding the claimed “selective access”. However, Stefik has a later priority date than Woodhill –



# 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.