

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION
Petitioner

v.

YISSUM RESEARCH DEVELOPMENT COMPANY OF THE HEBREW
UNIVERSITY OF JERUSALEM
Patent Owner

Case IPR2013-00219¹
Patent 7,477,284 B2

Before SALLY C. MEDLEY, KARL D. EASTHOM, and
JAMES B. ARPIN, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

DECISION
Petitioner's Request for Rehearing
37 C.F.R. § 42.71

¹ The IPR2013-00327 proceeding has been joined with this proceeding.

I. INTRODUCTION

Petitioner, Sony Corporation, filed a request for rehearing (Paper 22; “Req.”) of the Board’s September 23, 2013, decision (Paper 16; “Dec.”), which instituted *inter partes* review of claims 1-3, 10, 20, 27-29, 36, and 37 of Patent No. US 7,477,284 B2 (Ex. 1001; “the ’284 Patent”). Petitioner argues that (1) the grounds based on Ishiguro (Ex. 1005) for challenging the patentability of claims 1-4, 7, 10, 27-29, 36, and 38² are not redundant; (2) the Board should institute *inter partes* review of challenged claims 20 and 37 based on Kawakita (Ex. 1004); (3) the Board should institute *inter partes* review of challenged claims 20 and 37 based on Ishiguro; and (4) the Board should institute *inter partes* review of challenged claim 38 based on Asahi. Req. 2-3; *see* Dec. 8 (listing full citations to the references).

On October 16, 2013, Patent Owner filed a response (Paper 23) opposing Petitioner’s request for rehearing; and, on October 18, 2013, Petitioner filed a reply (Paper 24) responding to Patent Owner’s opposition to the request for rehearing. Rule 42.71(d), however, does not provide for a party to file an opposition to a request for rehearing without *first* obtaining authorization from the Board. *See SAP America, Inc. v. Versata Software, Inc.*, CBM2012-00001, Paper 73 (PTAB July 15, 2013) (Order Authorizing Additional Briefing). Patent Owner did not seek the Board’s authorization to file its response, and, therefore, Patent Owner’s response has not been considered. Moreover, because we have not considered Patent Owner’s unauthorized response to Petitioner’s request for rehearing, we also have not considered Petitioner’s reply to the unauthorized response.

² In its decision in IPR2013-00327, Paper 14, dated September 24, 2013, the Board instituted *inter partes* review of claims 4, 7, and 38 of the ’284 Patent. In view of the contemporaneous decision joining IPR2013-00327 with IPR2013-00219, Petitioner refers to the claims identified in each petition in its request for rehearing.

For the reasons set forth below, Petitioner's request is *denied*.

II. STANDARD OF REVIEW

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) (citations omitted). The request must identify, with specificity, all matters that the moving party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

III. DISCUSSION

Petitioner argues that the grounds for challenging claims 1-4, 7, 10, 27-29, 36, and 38 of the '284 Patent based on Ishiguro are not redundant in view of the institution of *inter partes* review with respect to those claims based on Kawakita because Ishiguro is “better in some respect” than Kawakita. Req. 4-5 (quoting *Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, CBM2012-00003, Paper 7, at 3 (PTAB Oct. 25, 2012)). In particular, Petitioner argues that, unlike Kawakita, Patent Owner does not challenge Ishiguro's status as a printed publication. *Id.* at 4.

The Board is charged with securing the just, speedy, and inexpensive resolution of every proceeding and has the discretion to deny some grounds to ensure that objective is met. 37 C.F.R. §§ 42.1(b), 42.108(b). In our decisions in the now-joined proceedings, we instituted *inter partes* review based on grounds covering all of the challenged claims, going forward on the grounds that the Board determined to be the most sufficient substantively. In that regard, the Board determined that, based on the record evidence, Kawakita is a publicly accessible

reference. Pet. 52-55 (citing, e.g., Ex. 1015, Ex. 1024, and Ex. 1031). For purposes of the decision to institute, Petitioner established that Kawakita was publicly accessible, and the Board was not persuaded by Patent Owner's arguments to the contrary. Dec. 19-20; *see* Prelim. Resp. 18-19.

Therefore, as indicated, the issue of the public accessibility of Kawakita was not raised for the first time in Patent Owner's preliminary response. Rather, Petitioner addressed the issue directly and persuasively in its petition. Pet. 52-55. Petitioner directed the Board to evidence, including three separate and consistent declarations (*see* Ex. 1015, Ex. 1024, and Ex. 1031), to establish facts sufficient to show that Kawakita is available as a reference at this point in the proceeding, and Patent Owner failed to persuade us otherwise. Based on the Board's determination that Kawakita was a publicly accessible reference as of the putative, priority date of the '284 Patent, the Board determined to institute review on grounds of unpatentability with respect to challenged claims 1-3, 10, 20, 27-29, 36, and 37, based on Kawakita and to deny institution on grounds of unpatentability based on Ishiguro. Dec. 35.

Lastly, for purposes of our decision, the Board was not persuaded that Ishiguro necessarily describes "a display that receives a plurality of the mosaics and displays them so as to provide a sense of depth of the scene," as recited in independent claims 1 and 27. Dec. 16-17 (construing a "display"); *see also* Prelim. Resp. 20-21. Consequently, Petitioner does not argue in its petition, and we do not determine from Petitioner's petition and Patent Owner's preliminary response, that Ishiguro is "better in some respect" than Kawakita, as Petitioner asserts (*see* Req. 3-4); and we, therefore, decline to modify the decision to institute. For these reasons, we are not persuaded that the Board abused its discretion in not instituting *inter partes* review on grounds based on Ishiguro.

Petitioner argues that the Board should institute *inter partes* review of claims 1-4, 7, 10, 27-29, 36, and 38 on grounds based on Ishiguro because the Board instituted *inter partes* review on grounds based on Ishiguro in related IPR 2013-00218, involving Patent No. US 6,665,003 B1 (“the ’003 Patent”). Req. 5-6. Further, Petitioner argues that the Board should institute *inter partes* review of claims 20 and 37 on grounds based on Kawakita alone or Kawakita and Chen (Ex. 1008; *see* Dec. 9) because the Board instituted *inter partes* review of allegedly, “substantively similar” claim 22 of the ’003 Patent on those grounds. Req. 7-9. Petitioner argues that, because these claims are “substantively similar,” “the Board *invites* contradictory outcomes” by failing to institute on the same grounds in each *inter partes* review. *Id.* at 6 (emphasis added); *see also* Req. 8.

Initially, we note that the challenged claims of the ’003 Patent differ from the challenged claims of the ’284 Patent. Significantly, challenged apparatus claim 1 of the ’284 Patent recites that the imaging apparatus comprises “a display that receives a plurality of the mosaics and displays them so as to provide a sense of depth of the scene.” *See* Ex. 1001, Claim 1; *see also* Ex. 1001, Claim 38 (reciting a “displaying” step). No such limitation appears in independent claim 1 or 34³ of the ’003 Patent.

Petitioner also argues that claims 20 and 37 of the ’284 Patent are “substantively similar” to claim 22 of the ’003 Patent. Req. 7-8. Petitioner argues that, “[f]or the sake of consistency and to avoid conflicting rulings,” the Board also should institute *inter partes* review of claims 20 and 37 on grounds based on Kawakita, or Kawakita and Chen. *Id.* at 8-9. Nevertheless, claims 20 and 37 of the ’284 Patent and claim 22 of the ’003 Patent are dependent claims; and, for the

³ Petitioner challenged independent claim 34 in IPR2013-00326 that is joined with IPR2013-00218.

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