

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORP.,
Petitioner,

v.

VIRNETX INC.,
Patent Owner.

Case IPR2014-00614
Patent 7,418,504 B2¹

Before MICHAEL P. TIERNEY, KARL D. EASTHOM, and
STEPHEN C. SIU, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION
Request for Rehearing
37 C.F.R. § 42.71(c)

¹ Case IPR2014-00613 has been consolidated with the instant proceeding.

I. INTRODUCTION

Petitioner’s Rehearing Request seeks a modification of the Board’s determination “with regard to the anticipation of claims 32 and 56 by Provino, because the Board . . . misapprehended or overlooked Petitioner’s inclusion of these claims in the proposed grounds of unpatentability.” Paper 11, 2 (“Req. Reh’g”). As relief, Petitioner “requests that the Board amend the [I]nstitution [D]ecision to include review of claims 32 and 56 based on anticipation by Provino.” Req. Reh’g 2.

“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c).

II. DISCUSSION

The Rehearing Request demonstrates an abuse of discretion, because we overlooked Petitioner’s showing of anticipation of claims 32 and 56 by Provino. On this record, Petitioner showed a reasonable likelihood of prevailing on the ground that Provino anticipates claims 32 and 56. *See* IPR2014-00613, Paper 2, 47 (“’613 IPR, Pet.”); Req. Reh’g 2–5. As Petitioner shows in its Rehearing Request, the failure to list claims 32 and 56 as part of the review based on anticipation by Provino amounts to “an inadvertent transcription error, rather than a deliberate omission.” *See* Req. Reh’g 3. The Institution Decision states that “[a]s an alternative to anticipation, Petitioner asserts that claims 29–32 and 53–56 are unpatentable under 35 U.S.C. § 103(a) over Provino and Kosiur. ’613 IPR, Pet. 50–53.” Paper 9, 25–26 (emphasis added).²

² Based on this alternative obviousness showing, we instituted trial on the ground that the combination of Provino and Kosiur renders claims 32 and 56 obvious.

III. CONCLUSION

Based on the foregoing discussion, we grant Petitioner's requested relief and modify the Institution Decision to reflect trial institution on the additional ground that Provino anticipates claims 32 and 56.

IV. ORDER

For the reasons given, it is

ORDERED that the Petitioner's Rehearing Request is *granted*; and
FURTHER ORDERED that the Institution Decision is modified accordingly to reflect that trial hereby is instituted retroactively as of the date of the Institution Decision, in accordance with the existing Scheduling Order, on the alternative ground that Provino anticipates claims 32 and 56.

IPR2014-00612, IPR2014-00613, and IPR2014-00614
Patent 7,418,504 B2

For PETITIONER:

W. Karl Renner
Kevin E. Greene
FISH & RICHARDSON P.C.
axf@fr.com
IPR38868-0007IP1@fr.com

For PATENT OWNER:

Joseph E. Palys
Naveen Modi
PAUL HASTINGS LLP
josephpalys@paulhastings.com
naveenmodi@paulhastings.com

Jason E. Stach
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
jason.stach@finnegan.com