

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

DSS TECHNOLOGY MANAGEMENT, INC.,
Patent Owner.

Case IPR2015-00369
Patent 6,128,290

Before JAMESON LEE, MATTHEW R. CLEMENTS, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner Apple Inc. (“Apple”) filed a request for rehearing (Paper 11, “Req. Reh’g”), requesting rehearing, reconsideration, and reversal of our determination not to institute *inter partes* review of claims 1–4 of U.S. Patent No. 6,128,290 (“the ’290 patent”) under 35 U.S.C. § 103 over Barber.¹ For the reasons that follow, Apple’s request for rehearing is *denied*.

II. BACKGROUND

In its Petition, Apple challenged the patentability of claims 1–4 of the ’290 patent on the following two grounds:

Reference(s)	Basis	Claims Challenged
Barber	§ 103(a)	1–4
Natarajan ² and Neve ³	§ 103(a)	1–4

Pet. 11–12, 15–59. In an institution decision entered on June 25, 2015, we concluded that Apple established a reasonable likelihood that it would prevail in challenging the patentability of claims 1–4 of the ’290 patent under 35 U.S.C. § 103(a) over the combination of Natarajan and Neve, and we instituted *inter partes* review on that ground. Paper 9, 13–20 (“Dec.”). Because Apple did not, however, make a sufficient preliminary showing that Barber is a “printed publication” within the meaning of 35 U.S.C. § 102, i.e., that Barber was publicly accessible before the critical date, we declined to

¹ Thomas J. Barber Jr., BODYLAN™: A LOW-POWER COMMUNICATIONS SYSTEM (M.S. thesis, Massachusetts Institute of Technology) (Ex. 1002, “Barber”)

² U.S. Patent No. 5,241,542 (Ex. 1003)

³ U.S. Patent No. 4,887,266 (Ex. 1004)

institute *inter partes* review based on Apple’s proposed challenge over Barber. *Id.* at 10–13. Apple now argues, *inter alia*, that we misapprehended the law, overlooked evidence, and “acted contrary to the procedural framework of *inter partes* review and the highly factual nature of the printed publication inquiry” in our determination not to institute review over Barber. Req. Reh’g 1.

III. STANDARD OF REVIEW

When rehearing a decision on petition, the Board reviews the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion occurs when a “decision [i]s 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.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988). “The burden of showing that a decision should be modified lies with the party challenging the decision.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). In its request for rehearing, the dissatisfied party must (1) “specifically identify all matters the party believes the Board misapprehended or overlooked” and (2) identify the place “where each matter was previously addressed.” 37 C.F.R. § 42.71(d); Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768. With these principles in mind, we address the arguments presented by Apple in turn.

IV. ANALYSIS

A. Patent Owner was not obligated to raise an argument in its Preliminary Response concerning the public accessibility of Barber, and we do not understand Patent Owner to have conceded that issue

Apple contends in its request for rehearing that the Board “overlooked Patent Owner’s concession of Barber’s public accessibility.” Req. Reh’g 5 (boldface omitted). According to Apple, “Patent Owner did not argue that Barber fails to qualify as prior art for lack of public accessibility or that the stamped date on Barber’s cover does not establish a publication date.” *Id.* at 4. “To the contrary,” Apple asserts, “Patent Owner conceded the public accessibility of Barber, stating that ‘Barber did not become publicly available at least until April 11, 1996.’” *Id.* at 5 (boldface and italics omitted) (quoting Prelim. Resp. 21). “For this reason alone,” Apple contends, “the Board should have addressed the merits of the proposed ground of invalidity based on Barber.” *Id.*

Contrary to Apple’s contentions, the Board did not overlook the fact that Patent Owner DSS Technology Management, Inc. (“DSS”) did not raise an argument in its Preliminary Response concerning the public accessibility of Barber. Although the Board takes into account a patent owner’s preliminary response, if such a response is filed, 37 C.F.R. § 42.108(c), the filing of a preliminary response is optional, and we do not construe a patent owner’s failure to raise any particular argument in a preliminary response as a concession or waiver. Whether or not a preliminary response is filed, we are constrained, as explained in our institution decision, to decide whether to institute a trial based on “the information presented in the petition.” Dec. 12 (citing 35 U.S.C. § 314(a)). In this case, for the reasons stated in the institution decision and in section IV.B below, the information presented in

Apple's Petition was insufficient to demonstrate that Barber is a printed publication within the meaning of 35 U.S.C. §§ 102 and 311(b) such that it would be available as prior art in an *inter partes* review proceeding.

Moreover, DSS's statement that "Barber did not become publicly available at least until April 11, 1996" is not reasonably read as a concession of Barber's public availability on April 11, 1996, or any other date. Req. Reh'g 5. In the context of DSS's argument that claims 1–4 are entitled to the benefit of the March 6, 1996 filing date of the '695 application from which the '290 patent claims priority, DSS's statement is more naturally read merely as an assertion that Barber was not publicly available on March 6, 1996. *See* Prelim. Resp. 5. In any event, to the extent that DSS's statement constitutes an admission, that, by itself, is insufficient to establish that the public interested in the art could access Barber prior to the critical date of the '290 patent. *See In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989); *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981) (noting the key inquiry is whether the reference was made "sufficiently accessible to the public interested in the art" before the critical date.). Admission by DSS does not mean the Board would refrain from making an assessment in that regard.

B. The record evidence is insufficient to qualify Barber as a "printed publication" within the meaning of §§ 102 and 311(b)

Pursuant to 35 U.S.C. § 314(a), Apple had the burden to establish in its Petition a reasonable likelihood of success, including, among other things, making a threshold showing that Barber is a "printed publication" within the meaning of 35 U.S.C. §§ 102 and 311(b). As we explained in the institution decision, Apple did not satisfy its burden. Dec. 11–12. Apple submitted no evidence, for example, to establish that the thesis was indexed,

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