

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

DSS TECHNOLOGY MANAGEMENT, INC.
Patent Owner

Case IPR2015-00373
Patent 6,128,290

**PETITIONER'S REQUEST FOR REHEARING
OF INSTITUTION DECISION UNDER 37 C.F.R. § 42.71(d)**

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

TABLE OF CONTENTS

TABLE OF AUTHORITIES ii

I. Introduction..... 1

II. Relief Requested 2

III. Standard of Review..... 2

IV. Statement of Facts..... 3

V. Rationale for Rehearing..... 5

 A. The Board overlooked Patent Owner’s concession of Barber’s public accessibility and misapprehended the weight of the evidence in the record.5

 B. The Board misapprehended the purpose of 37 C.F.R. § 42.64(b) and acted contrary to an established pattern of conduct by the Board.....6

 C. The Board imposed an arbitrary requirement on Apple to preemptively provide additional evidence that Barber qualifies as prior art.....10

VI. Conclusion 13

TABLE OF AUTHORITIES

Cases

Alternative Legal Solutions v. Employment Law Compliance, Inc.,
IPR2014-00562 (Paper 9, Oct. 7, 2014).....8

In re Lister,
583 F.3d 1307 (Fed. Cir. 2009)12

Informatica Corporation v. Protegrity Corporation,
CBM2015-00021 (Paper 14, Jun. 1, 2015)6

Palo Alto Networks, Inc. v. Juniper Networks, Inc.,
IPR2013-00369 (Paper 16, Dec. 19, 2013)7

PPG Indus. Inc. v. Celanese Polymer Specialties Co. Inc.,
840 F.2d 1565 (Fed. Cir. 1988)3

SipNet EU S.R.O. v. Straight Path IP Group, Inc.,
IPR2013-00246 (Paper 62, Oct. 9, 2014).....6

Suffolk Techs., LLC v. AOL Inc.,
752 F.3d 1358 (Fed. Cir. 2014)12

Toyota Motor Corporation v. American Vehicular Sciences LLC.,
IPR2013-00417 (Paper 14, Jan. 13, 2014)7

Statutes

35 U.S.C. § 102(b)3

35 U.S.C. § 103(a)1

35 U.S.C. § 312(a)10

35 U.S.C. § 314(a)10

Regulations

37 C.F.R. § 42.64(b) passim

37 C.F.R. § 42.64(b)(1).....11

37 C.F.R. § 42.64(b)(2)..... 7, 11
37 C.F.R. § 42.64(c).....12
37 C.F.R. § 42.71(d) 1, 3, 5
37 C.F.R. § 42.71(c).....1, 2

I. Introduction

Petitioner Apple Inc. (“Apple”) respectfully requests rehearing under 37 C.F.R. §§ 42.71(c) and (d) and that the Board reconsider and reverse its decision not to institute *inter partes* review based on Barber.

On June 25, 2015, the Board instituted *inter partes* review of claims 6, 7, 9, and 10 of U.S. Patent No. 6,128,290 (“the ’290 patent”) under 35 U.S.C. § 103(a) over the combination of Natarajan and Neve, and claims 6 and 7 of the ’290 patent under 35 U.S.C. § 103(a) over Mahany. The Board declined to institute *inter partes* review of claims 9 and 10 under 35 U.S.C. § 103(a) based on Barber.

As a matter of law, the Board misapprehended the statutes and the regulations governing these proceedings by creating an irrebuttable presumption that the date stamped on a printed publication is not what it purports to be. The Board overlooked that the asserted prior art—Barber—*facially indicates* that it was publicly accessible on the date asserted by Apple. Moreover, the Board overlooked that Patent Owner has not provided any evidence or arguments to the contrary. Instead, the Board acted contrary to the procedural framework of *inter partes* review and the highly factual nature of the printed publication inquiry.

In brief, the Board has imposed an arbitrary requirement on Apple to preemptively corroborate its prior art. This is not supported by the relevant statutes or regulations, and is capricious in view of an established pattern of conduct by the

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.