Trials@uspto.gov
571-272-7822

Paper 14
Entered: October 20, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISH NETWORK L.L.C.,
Petitioner,

v.

DRAGON INTELLECTUAL PROPERTY, LLC,
Patent Owner.

Case IPR2015-00499
Patent 5,930,444

Before NEIL T. POWELL, STACEY G. WHITE, J. JOHN LEE,
Administrative Patent Judges.

WHITE, *Administrative Patent Judge.*

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

I. INTRODUCTION

Dish Network L.L.C ("Petitioner") requests rehearing (Paper 9, "Req. Reh'g") of our Decision Instituting *Inter Partes* Review (Paper 7, "Decision" or "Dec.") of U.S. Patent No. 5,930,444 ("the '444 patent"). Petitioner seeks rehearing, reconsideration, and reversal of our determination not to institute *inter partes* review of the '444 patent under 35 U.S.C. §§ 102 and 103 over several grounds based upon Truog.[1] In our Decision, "we determine[d] that Petitioner ha[d] not provided sufficient evidence to establish that Truog qualifies as a printed publication." Dec. at 11. Petitioner asserts that the Board erred because (1) we overlooked or misapprehended arguments and evidence as to Truog's status as prior art to the '444 patent, and (2) we misapplied the "reasonable likelihood" standard. Req. Reh'g 1. Petitioner also argues that review should have been instituted on claim 10 over an additional ground because "no injustice would result" from granting review on the ground that we declined to institute. *Id.* at 11–12. For the reasons that follow, Petitioner's request for rehearing is *denied*.

II. BACKGROUND

In the Petition, the claims of the '444 patent were challenged on the following grounds:

Reference(s)	Basis	Claim(s) Challenged
Truog	§ 102	1, 5, 6, 8, and 14
Truog	§ 103	1, 5, 6, 8–10, and 14

[1] Michael R. Truog, THE TELEVISION PAUSE FUNCTION (May 1989) (Bachelor of Science in Electrical Engineering Thesis, Massachusetts Institute of Technology) (on file with Massachusetts Institute of Technology Library) ("Truog") (Ex. 1002).

Reference(s)	Basis	Claim(s) Challenged
Truog and Yifrach[2]	§ 103	1, 5–10, and 14
Truog and Vogel[3]	§ 103	2–4 and 13
Truog, Yifrach, and Vogel	§ 103	2–4 and 13
Truog and Ulmer[4]	§ 103	10
Truog, Yifrach, and Ulmer	§ 103	10
Goldwasser[5] and Yifrach	§ 103	1, 7–10, and 14
Goldwasser, Yifrach, and Vogel	§ 103	2–4 and 13
Goldwasser, Yifrach, and Ulmer	§ 103	10

Pet. 18–59. In our Decision, we concluded that Petitioner established a reasonable likelihood that it would prevail in challenging the patentability of claims 1, 7–10, and 14 over Goldwasser and Yifrach and claims 2–4 and 13 over Goldwasser, Yifrach, and Vogel. Dec. 20. Petitioner did not, however, make a sufficient showing that Truog is a "printed publication" within the meaning of 35 U.S.C. § 102, i.e., that Truog was publicly accessible before the critical date and, thus, we denied Petitioner's request to institute *inter partes* review based on the proposed challenges over Truog. *Id.* at 10–12.

III. STANDARD OF REVIEW

When rehearing a decision, 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.*

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[2] US 5,126,982, filed Sept. 10, 1990, issued June 30, 1992 ("Yifrach") (Ex. 1003).

[3] PCT Pub. WO 90/15507, published Dec. 13, 1990 ("Vogel") (Ex. 1004).

[4] PCT Pub. WO 89/12896, published Dec. 28, 1989 ("Ulmer") (Ex. 1006).

[5] US 5,241,428, filed Mar. 12, 1991, issued Aug. 31, 1993 ("Goldwasser") (Ex. 1005).

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. We address Petitioner's arguments with these principles in mind.

IV. ANALYSIS

A. Evidence of Public Accessibility

Petitioner maintains that it submitted sufficient evidence to support its arguments concerning the public accessibility of an undergraduate thesis authored by Michael R. Truog titled "The Television Pause Function." Req. Reh'g 3–11. Specifically, Petitioner argues that the Declaration of Walter Bender, Mr. Truog's thesis advisor, was sufficient to show public accessibility. *Id.* at 3. We, however, fully reviewed Mr. Bender's Declaration, and Petitioner has not persuaded us that any evidence or argument was overlooked or misapprehended.

As noted in the Decision, Mr. Bender testified that he "was familiar with the process for publication of theses by MIT at the time of the Truog Thesis." Dec. 10 (citing Ex. 1009 ¶ 4). As to the procedure for publication of theses, he stated that "[o]nce accepted the thesis would be transmitted to the MIT Library, where it would be indexed in the Library's catalog, and made available for public viewing and copying. The theses would generally be indexed and publically available within a month or two of submission."

Id. As to the specific Truog thesis he testified that "[t]o the best of my understanding the stamped date of June 16, 1989 on the front of Exhibit 1002 indicates the date the Truog Thesis was cataloged and publically available in the MIT Library." *Id.* ¶ 5.

In the Decision, we determined that "Mr. Bender's testimony lacks personal knowledge as to when and how the Truog thesis was made available to the public, and his testimony also is insufficient evidence of the library's specific practices as to indexing and cataloging papers in the relevant time period between Truog's purported publication in 1989 and the '444 patent's 1992 priority date." Dec. 11. For reasons discussed below, we are not persuaded of error in this determination. Mr. Bender's testimony does not provide sufficient evidence of either general library practice or the specific facts surrounding the purported publication of Mr. Truog's thesis.

Petitioner relies heavily on *In re Hall*, 781 F.2d 897 (Fed. Cir. 1986). In that case, the Federal Circuit affirmed a Board decision sustaining the rejection of certain claims of a reissue application. 781 F.2d at 897. As noted in *Hall*, "the proponent of the publication bar must show that prior to the critical date the reference was sufficiently accessible, at least to the public interested in the art, so that such a one by examining the reference could make the claimed invention without further research or experimentation." *Id.* at 899. *Hall* relied upon "the librarian's affidavit of express facts regarding the *specific* dissertation of interest and his description of the routine treatment of dissertations in general, in the ordinary course of business in his library." *Id.* at 898 (emphasis in original). In a later case, *In re Lister*, 583 F.3d 1307 (Fed. Cir. 2009), the Federal Circuit discussed several public accessibility cases, including *Hall*, and

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