

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARRIS GROUP, INC.,
Petitioner,

v.

TQ DELTA LLC,
Patent Owner.

Case IPR2016-00430
Patent 8,238,412 B2

Before SALLY C. MEDLEY, KALYAN K. DESHPANDE, and TREVOR M. JEFFERSON, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

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

I. INTRODUCTION

Arris Group, Inc. (“Petitioner”) filed a request for rehearing (Paper 10, “Req. Reh’g”) of the Board’s decision (Paper 9, “Dec.”) dated July 1 2016, which denied institution of *inter partes* review of claims 1–21 of U.S. Patent No. 8,238,412 B2 (Ex. 1001, “the ’412 patent”). Petitioner contends that the Board “overlooked or misapprehended important points presented in the Petition regarding why a person of ordinary skill in the art at the time of the alleged invention would have been motivated to combine the teachings of Hughes-Hartogs with those of Baran and Frenkel.” Req. Reh’g 2 (italics omitted). For the reasons stated 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.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988). The request must identify, specifically, all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

III. DISCUSSION

We determined in our Decision Denying Institution that Petitioner generally states the subject matter of the claims was described by Hughes-Hartogs, Baran, and Frenkel “in a manner that would have led a person of ordinary skill in the art to the claimed subject matter through the exercise of only routine skill.” Pet. 15. Petitioner further states that “the modification of ‘227 Patent [Hughes-Hartogs] to include the teachings of ‘511 Patent [Baran] and ‘268 Patent [Frenkel] is demonstrative of the application of a known

technique to a known device to yield predictable results under 35 U.S.C. §103.” *Id.* at 15–16. However, Petitioner does not point to evidence or make any other argument explaining why a person with ordinary skill in the art would have combined Hughes-Hartogs, Baran, and Frenkel, why such a combination would have required only “routine skill,” or even why the results of such a combination would have been predictable. *See* Prelim. Resp. 33–34. Accordingly, Petitioner has not provided any *reason* that would have prompted a person with ordinary skill in the art to combine Hughes-Hartogs, Baran, and Frenkel in the manner proposed by Petitioner.

Dec. 12.

Petitioner argues that we overlooked pages 10–12 of the Petition, which explains that Hughes-Hartogs expressly references Baran, and Frenkel expressly references Hughes-Hartogs.¹ Req. Reh’g 5–6 (citing Ex. 1004, 1:46–51; Ex. 1006, 1:50–54, 2:8–10). Petitioner further argues that we overlooked that Hughes-Hartogs discloses that it is a continuation in the efforts previously initiated by Baran and incorporates Baran by reference. *Id.* at 5 (citing Ex. 1004, 1:65–66, 7:40–42). Petitioner then contends that “the only question, then, is whether a person of ordinary skill in the art at the time of the invention would have had ‘an apparent reason to combine the known elements in the fashion claimed by the patent at issue.’” *Id.* at 7 (quoting *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)).

We disagree with Petitioner that we overlooked these points in the Petition. Petitioner mischaracterizes our Decision. We did not determine that there was not a reason to combine Hughes-Hartogs, Baran, and Frenkel, but rather we determined that Petitioner failed to set forth sufficient evidence and rationale

¹ Petitioner explains that Frenkel discloses an express reference to U.S. Patent No. 4,833,706, which is a grandchild of Hughes-Hartogs.

explaining why a person with ordinary skill in the art would have combined Hughes-Hartogs, Baran, and Frenkel. *See* Dec. 12–14. At best, the Petition only sets forth that Hughes-Hartogs references Baran, and Frenkel indirectly references Hughes-Hartogs. *See* Pet. 10–12. The Petition does not set forth any rationale to combine Hughes-Hartogs, Baran, and Frenkel, but rather only states the prior art references each other. *See id.* Petitioner now argues that a “person of ordinary skill in the art, having ordinary curiosity and creativity, could then connect the dots,” and now provides an explanation as to why a person of ordinary skill in the art would have combined Hughes-Hartogs, Baran, and Frenkel. *See* Req. Reh’g 7–9. However, we did not overlook or misapprehend these now asserted reasons to combine the prior art because this rationale was not presented in the Petition. Similarly, Petitioner’s argument that we overlooked or misapprehended that Hughes-Hartogs discloses that it is a continuation in the efforts previously initiated by Baran and incorporates Baran by reference is not persuasive because Petitioner did not present this argument in the Petition.

Petitioner further mischaracterizes our Decision in their argument that “the Board stated that Petitioner’s argument was based on the testimony of its expert.” *Id.* at 4. We determined

At best, Petitioner directs us to pages 42–44 of the Declaration of Mr. Lance McNally. *Id.* at 18–19, 22–23. Although we decline to incorporate Mr. McNally’s Declaration into the Petition, we note that pages 42–44 of Mr. McNally’s Declaration consist of several paragraphs discussing the application of the cited prior art to independent claim 1 of the ’412 patent. Ex. 1002 ¶¶ 52–60. Only paragraph 58 discusses the combination of Hughes-Hartogs and Baran. *Id.* ¶ 58. Paragraph 58 states “[a] POSA would combine the ‘227 [Hughes-Hartogs] and ‘511 [Baran] patents to show a test mode with messages comprising one or more data variables that represent the test information.” *Id.* However, the statement is conclusory,

unsupported by a sufficient rationale or reason to combine Hughes-Hartogs and Baran. This statement additionally does not provide a sufficient reason for a person of ordinary skill in the art to combine Frenkel with Hughes-Hartogs and Baran. As such, even if we were to incorporate this passage from Mr. McNally's Declaration into the Petition, which we do not, this single statement is insufficient to support the legal conclusion of obviousness.

Dec. 13. As such, we declined to incorporate Mr. McNally's declaration into the Petition, and determined that the Petition could not incorporate portions of the Declaration without a discussion of these portions in the Petition. We further determined that Mr. McNally's Declaration is insufficient to establish a rationale to combine Hughes-Hartogs, Baran, and Frenkel because the Declaration "is conclusory, unsupported by sufficient rationale or reason to combine Hughes-Hartogs and Baran . . . [and] Frenkel with Hughes-Hartogs and Baran." *Id.* Therefore, we did not determine that there is a "corollary requirement that the 'rational underpinning' be further supported by an expert," as argued by Petitioner. Req. Reh'g 4-5.

Accordingly, we are not persuaded by Petitioner that we misapprehended or overlooked points in the Petition that provided a rationale to combine Hughes-Hartogs, Baran, and Frenkel. We are also not persuaded by Petitioner's argument that we required a rationale to combine to be supported by an expert. Therefore, Petitioner's request for rehearing is denied.

IV. CONCLUSION

The Board denies the relief requested in the request for rehearing.

V. ORDER

Accordingly, it is hereby

ORDERED that Petitioner's request for rehearing is *denied*.

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