

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KINGSTON TECHNOLOGY COMPANY, INC.,
Petitioner,

v.

POLARIS INNOVATIONS LTD.,
Patent Owner.

Case IPR2016-01622
Patent 6,850,414 B2

Before SALLY C. MEDLEY, JEAN R. HOMERE,
and KEN B. BARRETT, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

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

I. INTRODUCTION

On March 7, 2018, Polaris Innovations Ltd. (“Patent Owner”) filed a Request for Rehearing (Paper 36, “Request” or “Req. Reh’g”) of our Final Written Decision (Paper 35, “Final Dec.”), particularly our denial of Patent Owner’s Motion to Amend (Paper 18, “Mot. to Amend”) U.S. Patent No. 6,850,414 B2 (“the ’414 patent,” Ex. 1001). Concurrent with its Request for Rehearing, Patent Owner filed Exhibit 2015. For the reasons provided below, Patent Owner’s Request for Rehearing is *denied*. We also expunge Exhibit 2015.

II. SUGGESTION FOR PANEL EXPANSION

In its Request, Patent Owner “suggests that the panel ‘suggest to the Chief Judge the need for the designation of an expanded panel’” before consideration of the Request. Req. Reh’g 3 (citing PTAB Standard Operating Procedure (SOP) 1).

Standard Operating Procedure 1 identifies some of the reasons for which the Chief Judge may expand a panel. PTAB SOP 1, 3 (§ III.A). For example, an expanded panel may be appropriate when “[t]he proceeding or AIA Review involves an issue of exceptional importance” or when “[c]onsideration by an expanded panel is necessary to secure and maintain uniformity of the Board’s decisions.” *Id.* (§ III.A.1, 2).

In this case, the Chief Judge has considered Patent Owner’s suggestion for an expanded panel, but has determined that an expanded panel is not warranted.

III. ANALYSIS

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). “The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.* When rehearing a decision on a petition, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c).

Patent Owner’s Motion to Amend proposed to substitute a newly-presented claim 9 for dependent claim 8 and sought to cancel all the instituted challenged claims. Patent Owner requests reconsideration regarding both aspects of the Motion to Amend. Req. Reh’g 1.

A. Arguments Regarding Proposed Substitute Claim 9

As an initial matter, we note that Patent Owner’s current arguments regarding the proposed substitute claim focus almost exclusively on policy and procedural matters rather than our substantive determination that proposed substitute claim 9 is unpatentable. *See, e.g.*, Req. Reh’g 7–8. Patent Owner, in effect, argues that it was erroneous for us to consider any arguments or evidence not in the Petition in evaluating the patentability of the proposed substitute claim. *See, e.g., id.* at 10 (quoting Final Dec. 21) (Patent Owner asserting that “[t]he FWD’s [Final Written Decision’s] suggestion that it must always determine whether the substitute claim is patentable ‘based on the entirety of the record, including any opposition made by the petitioner’” is incorrect in this case.) (citations omitted). In so arguing, Patent Owner does not direct our attention to any matter we misapprehended or overlooked.

Patent Owner argues: “As for the FWD’s denial of [the Motion to Amend as to] proposed substitute Claim 9, it misapprehended the Board’s sole prior decision on point, *Amerigen Pharmaceuticals v. Shire*, IPR2015-02009, Paper 38 (PTAB Mar. 31, 2017), and the law that it applied.” Req. Reh’g 1; *see also id.* at 9 (arguing that we overlooked or misapprehended that decision “and the law it applied”). As to that “law,” Patent Owner contends that the Final Decision “cannot be squared with *Amerigen*’s central holding that IPR has no requirement to *re*-prove the patentability of subject matter of non-instituted claims.” *Id.* at 10; *see also id.* at 2 (characterizing the holding of *Amerigen* as pertaining to there being no requirement for a patent owner to prove original, non-amended claims are patentable). Patent Owner, however, does not point to any portion of the Final Decision that could be construed as placing a requirement on Patent Owner to prove patentability. *Cf.* Final Dec. 7, 15, 21 (indicating the applied legal framework where the burden is *not* on the patent owner to prove patentability). We addressed, in the Final Decision, Patent Owner’s arguments regarding *Amerigen*, Final Dec. 19–20, and determined that “*Amerigen* does not, as Patent Owner implies, establish a procedural rule that precludes a petitioner from opposing a motion to amend,” *id.* at 20. Contrary to Patent Owner’s arguments, we did not misapprehend or overlook its arguments; rather, we disagreed with Patent Owner’s position. We note that merely disagreeing with our analysis or conclusions does not serve as a proper basis for a rehearing. It is not an abuse of discretion to provide analysis or conclusions with which a party disagrees.

Patent Owner argues, with emphasis added: “The FWD further overlooks or misapprehends contrary Board practice and law in post-grant

inter partes reexamination, which, as Patent Owner and the Federal Circuit’s judges have explained, should guide the Board in interpreting the requirements for amending patents in IPR.” Req. Reh’g (citing Paper 33, 27). Similarly, Patent Owner argues that the “conclusion” reached in the Final Decision “is just the opposite of what happens in *inter partes* reexamination.” *Id.* at 12 (emphasis added) (citing Paper 33, 27-28; Paper 34, 98:19-99:10). The cited sources of this argument, Papers 33 and 34, are, respectively, Patent Owner’s demonstrative exhibits for the hearing and the hearing transcript. The Request does not identify where in the record this matter—concerning *inter partes* reexamination practice as opposed to that of *inter partes* review—was raised in a brief or other substantive paper. Thus, this appears to be improper argument raised for the first time at the hearing¹ or appearing for the first time in a demonstrative exhibit slide that was not even discussed at the hearing.² We could not have, in the Final Decision, overlooked or misapprehended briefing made for the first time in the present Request and after the issuance of the Final Decision.

Patent Owner argues that “[t]he FWD’s holding not only misapprehends past reexamination practice, Board decisions, and Federal Circuit guidance: it misapprehends IPR’s statutory structure” and that “the

¹ The cited portion of the hearing transcript indicates that the few sentences contained little argument and were more of an invitation for the panel to explore the matter on its own. *See* Hearing Tr. (Paper 34), 98:19–21 (“So I’m almost out of time, but just quickly, they say, well, you should actually look to *inter partes* reexamination proceedings as the backdrop.”).

² We note that Patent Owner was given the opportunity to provide the last word during briefing, and did file a paper titled “Patent Owner’s Brief Addressing Impact of *Aqua Products v. Matal*” (Paper 30).

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