

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SAINT LAWRENCE COMMUNICATIONS LLC,
Patent Owner.

Case IPR2017-01244
Patent 6,807,524 B1

**PETITIONER'S REQUEST FOR REHEARING
OF INSTITUTION DECISION UNDER 37 CFR § 42.71(d)**

TABLE OF CONTENTS

I. INTRODUCTION.....1

II. LEGAL STANDARD2

III. RATIONALE FOR REHEARING.....2

 A. The Board overlooked the requirement of 37 C.F.R. § 42.108(c) and failed to view testimonial evidence in the light most favorable to Petitioner..... 2

 1. The Petition and supporting expert declaration establish that Salami teaches the claimed filter arrangement.....3

 2. Patent Owner’s testimonial evidence created a genuine issue of material fact as to the teachings of Salami5

 3. The Board erred when it credited Patent Owner’s testimonial evidence over Petitioner’s corresponding testimonial evidence6

 B. The Board erred to the extent it substituted its own understanding of Salami for the understanding of one of ordinary skill in the art 9

IV. CONCLUSION.....12

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Brand v. Miller</i> , 487 F.3d 862 (Fed. Cir. 2007)	2, 10, 11
<i>Kingston Tech. Co. v. Polaris Innovations Ltd.</i> , IPR2016-01623, Paper 7 (P.T.A.B Feb. 15, 2017).....	8, 9
<i>Mylan Pharmaceuticals Inc. v. UCB Pharma GmbH</i> , IPR2016-00510, Paper 12 (P.T.A.B. July 20, 2016).....	8
<i>PPG Indus., Inc. v. Celanese Polymer Specialties Co.</i> , 840 F.2d 1565 (Fed. Cir. 1988)	2
<i>Perfect Web Techs., Inc. v. InfoUSA, Inc.</i> , 587 F.3d 1324 (Fed. Cir. 2009)	10
<i>Realtime Data LLC, v. Oracle Int’l Corp.</i> , IPR2016-00695, Paper 8 (P.T.A.B. Sept. 13, 2016).....	9
<i>Synopsys, Inc. v. Mentor Graphics Corp.</i> , 814 F.3d 1309 (Fed. Cir. 2016)	10, 11
Other Authorities	
37 C.F.R. § 42.6(e).....	13
37 C.F.R. § 42.71(c).....	2
37 C.F.R. § 42.71(d)	1, 2
37 C.F.R. § 42.108(c).....	1, 2, 3, 5, 6, 7, 8, 9, 11, 12
<i>Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board</i> , 81 Fed. Reg. 18750, 18755 (Apr. 1, 2016)	9

I. INTRODUCTION

Petitioner Apple Inc. (“Apple”) respectfully requests rehearing under 37 C.F.R. § 42.71(d) of the Board’s October 25, 2017 Decision denying institution of *inter partes* review of U.S. Patent No. 6,807,524 (“the ’524 Patent”). Specifically, Petitioner requests that the Board reconsider its determination that the Petition failed to establish that the prior art, Salami (Ex-1008), discloses the particular filter arrangement recited in the independent claims. Rehearing is warranted because the Board overlooked 37 C.F.R. § 42.108(c), which requires evidence to be viewed in the light most favorable to Petitioner when there is a genuine issue of material fact. Here, Patent Owner filed expert testimony with its Preliminary Response that directly conflicted with the testimony of Petitioner’s expert that Salami teaches the claimed filter arrangement. The Board erred when it credited Patent Owner’s expert evidence (“we agree with Patent Owner that Salami does not disclose [the claimed filter arrangement],” Inst. Dec. 17) instead of resolving the factual dispute in favor of Petitioner.

To the extent the Board relied upon its own understanding of Salami instead of the understanding of a person of ordinary skill in the art, Petitioner respectfully submits that doing so constitutes error in the context of this proceeding. Federal Circuit case law establishes that “in the context of a contested case, it is

impermissible for the Board to base its factual findings on its expertise, rather than on evidence in the record.” *Brand v. Miller*, 487 F.3d 862, 869 (Fed. Cir. 2007).

When the conflicting testimonial evidence in this proceeding is viewed in the light most favorable to Petitioner, as required by § 42.108(c), the record establishes that Salami discloses the claimed filter arrangement. Petitioner respectfully requests that the Board institute trial in order to resolve this factual dispute with the benefit of a fully developed record.

II. LEGAL STANDARD

The Board's decision on institution is reviewed for an abuse of discretion. 37 C.F.R. § 42.71(c). 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). Further, a request for rehearing “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.” 37 C.F.R. § 42.71(d).

III. RATIONALE FOR REHEARING

A. The Board overlooked the requirement of 37 C.F.R. § 42.108(c) and failed to view testimonial evidence in the light most favorable to Petitioner

When a patent owner introduces testimonial evidence with its preliminary

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.