

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN ZHIYI TECHNOLOGY CO. LTD., D/B/A ILIFE,
Petitioner,

v.

IROBOT CORP.,
Patent Owner.

Case IPR2017-02061
Patent 6,809,490 B2

Before WILLIAM V. SAINDON, TERRENCE W. MCMILLIN, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

DECISION

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

Shenzhen Zhiyi Technology Co. Ltd., d/b/a iLife, (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–3, 7, 12, and 42 of U.S. Patent No. 6,809,490 B2 (Ex. 1001, “the ’490 patent”). Paper 1 (“Pet.”). In our Decision on Institution (Paper 8, “Dec. on Inst.”), we instituted an *inter partes* review as to the claim involved in the obviousness ground (claim 42), but we did not institute an *inter partes* review as to the claims involved in the anticipation ground (claims 1–3, 7, and 12). Dec. on Inst. 15. Petitioner filed a Request for Rehearing (Paper 10, “Req. Reh’g”) alleging that we should not have denied institution as to the anticipation ground because we misapprehended petitioner’s argument.

We do not take a position as to the merits of Petitioner’s Request, but note that intervening case law has since clarified that we should not have denied institution of the claims in the anticipation ground while granting institution of the claims in the obviousness ground. The U.S. Supreme Court’s recent decision in *SAS Institute* holds that a final written decision under 35 U.S.C. § 318(a) “*must address every claim the petition has challenged.*” *SAS Inst. Inc. v. Iancu*, 584 U.S. ___, ___ (2018) (slip op., at 5).¹ Because we instituted an *inter partes* review as to claim 42, absent further developments in the proceeding, we must issue a final written decision regarding claims 1–3, 7, 12, and 42 of the ’490 patent. Accordingly, we bring the anticipation ground into the *inter partes* review to allow a full and fair consideration of the evidence before making any final written decision regarding challenged claims 1–3, 7, 12, and 42.

¹ 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018)

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In view of the foregoing, it is hereby:

ORDERED that Petitioner's Request for Rehearing is granted; and
FURTHER ORDERED that the scope of the *inter partes* review of the
'490 patent instituted on March 12, 2018 is modified to include determining
whether claims 1–3, 7, and 12 of the '490 patent are anticipated by Ueno-
642.

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