

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT, LLC,
Patent Owner.

Case IPR2018-01079
Patent 8,213,970 B2

Before TREVOR M. JEFFERSON, CHRISTA P. ZADO, and
KEVIN C. TROCK, *Administrative Patent Judges*.

ZADO, *Administrative Patent Judge*.

DECISION
Denying Request for Rehearing
37 C.F.R. § 42.71

INTRODUCTION

AGIS Software Development, LLC (“Patent Owner”) seeks rehearing (Paper 12, “Request” or “Req. Reh’g.”) of the Institution Decision (Paper 9, “Decision” or “Inst. Dec.”) in this proceeding, in particular, the determination that Google, LLC (“Petitioner”) demonstrated a reasonable likelihood it would prevail in showing unpatentability of claim 1 of the challenged patent based on the combination of Kubala and Hammond. Patent Owner asserts that the Board’s determination is incorrect because: (1) the Board “overlooked and/or misapprehended” argument that “Petitioner made no attempt to combine the teachings of Kubala and the ‘other prior art solutions [disclosed in Kubala],’ such as ‘read receipts,’ because there is no reason or motivation to do so”; and (2) the Decision “overlooks the fact that Kubala distinguishes between prior art approaches based on flags (as in flag 216) and those based on return receipts.” *Id.* at 2, 4.

For the reasons discussed below, we deny the Request.

DISCUSSION

The applicable standard for granting a request for rehearing of a petition decision is abuse of discretion. 37 C.F.R. § 42.71(c). The party seeking rehearing has the burden of showing the decision should be modified:

(d) Rehearing. . . . The burden of showing a decision should be modified lies with the party challenging the decision. 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, and opposition, or a reply.

37. C.F.R. § 42.71(d).

With regard to the ground at issue (i.e., Kubala combined with Hammond), Petitioner relies on Kubala, a printed patent application, as the primary reference. For limitation 1.5, which recites “requiring the forced message alert software on said recipient PDA/cell phone *to transmit an automatic acknowledgment* to the sender PDA/cell phone as soon as said forced message alert is received by the recipient,” Petitioner relies on Kubala’s disclosure of automatically sending, when an e-mail arrives at its intended destination, a return receipt to the sender, thereby providing acknowledgement that the e-mail has been received by the intended recipient. Paper 2, 30 (“Petition” or “Pet.”) (citing Ex. 1005 ¶ 6). Because Kubala describes sending a return receipt as a prior art solution, Patent Owner argued in the Preliminary Response that Petitioner must show a motivation to combine this feature with “Kubala’s device,” e.g., the device described in Kubala as the alleged invention. Paper 6, 36–37 (“Prelim. Resp.”). According to Patent Owner, Petitioner failed to articulate sufficient reasoning. *Id.* In particular, Patent Owner argued there is no motivation to combine return receipts with Kubala’s device, which uses flags to indicate to e-mail recipients that a mandatory response is required. *Id.* Patent Owner argued, furthermore, that an ordinarily skilled artisan would have understood Kubala to teach away from using return receipts in Kubala’s device. *Id.* In the Request, Patent Owner asserts that we overlooked and/or misapprehended its arguments. Req. Reh’g 2–5. We disagree.

We considered, and addressed, Patent Owner’s arguments, and found them to be unavailing. Inst. Dec. 30–32. As noted in the Decision, Petitioner’s declarant, Mr. Williams, articulated a rationale to combine, namely that due to uncertainty as to whether an e-mail message was

received, return receipts provided a well-known benefit. *Id.* at 31–32 (citing Ex. 1003 ¶ 103). Also discussed in the Decision, based on the record at the time, we disagreed that Kubala teaches away from the use of return receipts, and provided the reasons for disagreement, explaining that contrary to Patent Owner’s arguments, there was no evidence of incompatibility between sending return receipts and flagging e-mail messages to indicate requirement of a mandatory response. *Id.* at 30–32. Thus, we considered Patent Owner’s arguments in rendering the Decision.

CONCLUSION

For the foregoing reasons, Patent Owner has not shown that the Board misapprehended or overlooked a matter. We, therefore, are not persuaded to modify the Decision.

ORDER

Accordingly, it is:

ORDERED that the Request for Rehearing is *denied*.

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