From: Carmichael, Jim (External)
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To: Precedential_Opinion_Panel_Request
Cc: dblock-ptab@sternekessler.com; spappas-ptab@sternekessler.com; mspecht-ptab@sternekessler.com; MPH-IPRs
Subject: Precedential Opinion Panel request for IPR2019-00819
Attachments: IPR2019-00819 - rehearing request (FINAL).pdf

Dear Honorable Board:

I write on behalf of Patent Owner MPH Technologies Oy regarding the PTAB decision to institute review of U.S. Patent No. 7,620,810 in case number IPR2019-00819. The decision by Judges Hamann, Jivani, and Margolies grants the petition of Apple Inc. for *inter partes* review and declines to exercise the Director's discretion under § 325(d) to reject Apple's petition, despite the fact that both primary references raised in Apple's petition were extensively discussed and applied in rejections of claims during original prosecution.

The decision was based on the panel's erroneous beliefs (1) that the original examiner's separate rejections over references relied upon in the Petition weighed *against* exercising discretion under 35 U.S.C. § 325(d) because the separately applied references were not applied simultaneously in the same exact combination as in the Petition and (2) that the panel's implicit difference of opinion with the examiner concerning what a particular applied reference would have suggested to POSITA counts as a sufficient "error" weighing against exercising § 325(d) discretion under factor (e) of *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, (PTAB Dec. 15, 2017) (precedential).

SATISFACTION OF REQUIREMENTS OF STANDARD OPERATING PROCEDURE 2

Based on my professional judgment, I believe the Board's panel decision is contrary to the following precedent of the Board: *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, (PTAB Dec. 15, 2017) (precedential as to § 325(d) factors).

Based on my professional judgment, I believe this case requires an answer to one or more precedent-setting questions of exceptional importance: (1) whether an examiner's separate rejections over references relied upon in the Petition weighs against exercising discretion under 35 U.S.C. § 325(d) merely because the separately applied references were not applied together in the same exact combination as in the Petition and (2) whether a PTAB panel's implicit difference of opinion with the examiner concerning what a particular applied reference would have suggested to POSITA sufficiently counts as an explicit examiner "error" under factor (e) of *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, (PTAB Dec. 15, 2017) (precedential).

REASONS FOR RECOMMENDING PRECEDENTIAL OPINION PANEL REVIEW

As stated in the attached request for rehearing: The Board panel's decision to decline to exercise discretion under § 325(d) on the Director's behalf misapprehended or overlooked that the examiner's separate rejections based on references relied on in the Petition does not weigh ***against*** exercising discretion under 35 U.S.C. § 325(d) merely because the separately applied references were not applied together in the exact combination in the Petition. *Becton, Dickinson* itself expressly addressed a situation in which two references raised in combinations in the petition were applied only separately in previous prosecution, and held that the prior separate discussion and application of the references during prosecution nevertheless weighed in favor of denying institution under § 325(d), not against. *Becton, Dickinson*, at 22-23. The informative Board decision of *Kayak Software* further supports this line of authority, and suggests that to conclude otherwise "would exalt form over substance" in the § 325(d) inquiry. *Kayak Software Corp. v. International Business Machines Corp.*, CBM2016-00075, Paper 16, 8-9 (PTAB Dec. 15, 2016) (informative).

The Board panel's decision to decline to exercise discretion under § 325(d) also misapprehended or overlooked that a difference of opinion with the examiner's purportedly implied views, concerning what a particular applied reference would have suggested to POSITA, is insufficient to supply the type of error contemplated by *Becton, Dickinson* factor (e) ("whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art"). As the Board has previously held when applying this *Becton, Dickinson* factor: "Requiring a showing of ***explicit*** and intrinsic error in a petition for an AIA post-grant proceeding properly places the burden on the party who seeks to challenge the patentability of the issued claims over the same or substantially the same prior art or arguments presented previously to the Office during examination. Requiring a showing of error also ensures protection for Patent Owner, where only upon such a showing can the Board readily ascertain whether there are serious doubts about how the patent issued over the same or substantially the same prior art that the Office considered previously during examination." *Juniper Networks, Inc. v. Mobile Telecomm'ns Techs.*, LLC, IPR2017-00642, Paper 31, 21 (PTAB Mar. 14, 2018) (emphasis added).

This conflict presents questions of wide applicability and undermines the certainty and consistency of the Board's application of the Director's statutory discretion under § 325(d). Accordingly, these issues warrant the attention of the Precedential Opinion Panel.

Respectfully submitted,

James T. Carmichael

Lead Counsel for Patent Owner MPH Technologies Oy

CARMICHAEL IP PLLC
James T. Carmichael
8000 Towers Crescent Drive, 13th Floor
Tysons, VA 22182
(703)646-9255
jim@carmichaelip.com