

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MPH TECHNOLOGIES OY,
Patent Owner.

IPR2019-00819 (Patent 7,620,810 B2)
IPR2019-00820 (Patent 7,937,581 B2)¹

Before KAMRAN JIVANI, JOHN D. HAMANN, and
STACY B. MARGOLIES, *Administrative Patent Judges*.

JIVANI, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

¹ This Order addresses the same issue for the above-identified cases. Therefore, we exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in any subsequent papers.

IPR2019-00819 (Patent 7,620,810 B2)

IPR2019-00820 (Patent 7,937,581 B2)

I. INTRODUCTION

Apple Inc. (“Petitioner”) requested an *inter partes* review of claims 1–7 (the “challenged claims”) of U.S. Patent No. 7,620,810 B2 (Ex. 1001, the “’810 patent”). Paper 2 (“Petition” or “Pet.”).² MPH Technologies OY (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). We instituted an *inter partes* review of all of the challenged claims. Paper 10 (“Dec. on Inst.”).

Patent Owner requests rehearing of our decision to institute review. Paper 13 (“Reh’g Req.”). Having considered the Request for Rehearing, we determine that Patent Owner has not shown that we abused our discretion in declining to deny institution under 35 U.S.C. § 325(d). Accordingly, we deny Patent Owner’s request for the following reasons.

II. STANDARD OF REVIEW

37 C.F.R. § 42.71(d) provides that:

A party dissatisfied with a decision may file a request for 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 where each matter was previously addressed in a motion, opposition, or a reply.

See Office Trial Practice Guide (84 Fed. Reg. 64,280 (Nov. 21, 2019)). Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was based on an erroneous conclusion of

² All citations are to IPR2019-00819 unless otherwise noted. Petitioner made a similar request for review of claims 1–9 of U.S. Patent No. 7,937,581 B2 in IPR2019-00820.

IPR2019-00819 (Patent 7,620,810 B2)

IPR2019-00820 (Patent 7,937,581 B2)

law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus., Inc. v. Celanese Polymer Specialties Co., Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted).

III. ANALYSIS

In its Request for Rehearing, Patent Owner argues that we erred for two reasons. First, Patent Owner contends that we misapprehended or overlooked that § 325(d)³ and prior Board decisions interpreting § 325(d) establish that the Examiner’s entry of separate rejections based on references relied on in the Petition “does not weigh *against* exercising discretion merely because they were not applied together in the exact combination in the Petition.” Reh’g Req. 2. Second, Patent Owner contends that we misapprehended or overlooked where a difference of opinion with the examiner about how a particular reference should be applied “is insufficient to supply the type of error contemplated by factor (e) of the *Becton, Dickinson* test⁴ (‘whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art’).” *Id.* at 6. We address each of these arguments below.

³ In determining whether to institute an *inter partes* review, we “may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d); 37 C.F.R. § 42.4(a) (stating that the “Board institutes the trial on behalf of the Director”).

⁴ *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, slip op. at 17–18 (PTAB Dec. 15, 2017) (Paper 8) (precedential as to § III.C.5, first para.), which provides six non-exclusive factors to consider when deciding whether to exercise discretion to deny review under 35 U.S.C. § 325(d).

IPR2019-00819 (Patent 7,620,810 B2)

IPR2019-00820 (Patent 7,937,581 B2)

A. *Patent Owner's arguments regarding whether the Examiner's consideration of references in separate rejections weighs against exercising discretion*

According to Patent Owner, our determination that the Examiner's use of Ishiyama and Murakawa in separate rejections, and not in the exact combination presented by the Petition, "weighs against denying institution" under § 325(d) "is diametrically contrary to *Becton, Dickinson*, which addressed materially the same facts and came to exactly the opposite conclusion." Reh'g Req. 4 (citing Dec. on Inst. 13–14). Patent Owner argues that our determination also conflicts with the Board's informative decision in *Kayak Software Corp. v. International Business Machines Corp.*, CBM2016-00075, Paper 16, 8–9 (PTAB Dec. 15, 2016) (informative), in which, according to Patent Owner, the Board concluded that to require an examiner to have applied the exact combination of references raised in the petition in order for denial under § 325(d) to be appropriate "would exalt form over substance." *Id.* at 5 (citing *Kayak* at Paper 16, 8–9).

We disagree with Patent Owner. Patent Owner's arguments here relate to *Becton, Dickinson* factor (c), "the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection." *Becton, Dickinson*, Paper 8, 17. Patent Owner mischaracterizes the findings underlying our determination that this factor weighs against denying institution. We did not rely merely on the Examiner's use of "the relied-upon references in *separate* rejections and not in the exact combination of those references presented by the Petition," as Patent Owner contends. Reh'g Req. 4. Rather, our determination was based on findings detailed in our Decision on Institution and summarized below.

IPR2019-00819 (Patent 7,620,810 B2)

IPR2019-00820 (Patent 7,937,581 B2)

We found in our Decision on Institution that the Examiner did not apply Ishiyama—the primary reference cited in the instant Petition—to the challenged claims of the '810 or '581 patents. *See* Dec. on Inst. 12; *see also* *Apple Inc. v. MPH Techs. Oy*, IPR2019-00820, Paper No. 10, *12. In particular, during prosecution of the '810 patent application, the Examiner used Ishiyama with Ala-Laurila in an obviousness rejection of then-pending claims 1–10. Ex. 1003, 216–19 (citing Ex. 1004, 6:13–23, 6:54–7:23, 11:29–58, and for claim 6, citing Ex 1004, 2:63–3:14). In the context of independent claim 1, the Examiner relied on Ala-Laurila for elements a) and b) and applied Ishiyama only against element c) of claim 1. *Id.*

In response to the non-final rejection in which Ishiyama was applied, independent claim 1 was amended as follows (with underlining denoting additions and strikethroughs denoting deletions):

1. (Currently amended) A method for ensuring secure forwarding of a message in a telecommunication network, having at least one mobile terminal and another terminal and a security gateway therebetween, the method comprising:

a) establishing a secure connection between a first address of the mobile terminal and an first address of the security gateway ~~other terminal~~, the secure connection defined by at least the addresses of the mobile terminal and the security gateway ~~two terminals~~,

b) the mobile terminal changing ~~moving~~ from the first address ~~of the mobile terminal~~ to a second address, and

c) while at the second address, the mobile terminal sending a request message to the first address of the security gateway ~~other terminal~~ to request the security gateway ~~other terminal~~ to change the secure connection to be defined between the second address and the first address of the security gateway ~~other terminal~~, and

in response to the request message from the mobile terminal, the security gateway ~~other terminal, while at the first~~

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