

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

MPH TECHNOLOGIES OY,  
Patent Owner,

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Case IPR2019-00820  
Patent 7,937,581 B2

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**PATENT OWNER'S REQUEST FOR REHEARING  
OF DECISION GRANTING INSTITUTION OF *INTER PARTES* REVIEW**

Patent Owner respectfully requests rehearing of the Board’s decision on behalf of the Director to institute *inter partes* review. The decision declined to exercise discretion under 35 U.S.C. § 325(d) to reject the Petition despite the fact that the two primary references in the Petition were previously discussed extensively and applied in rejections by the Examiner during the original prosecution. The decision relied on the panel’s views that (i) the Examiner’s use of the two references in separate rejections, rather than combined in a single rejection, weighed *against* exercising discretion under 35 U.S.C. § 325(d); and (ii) an implicit difference of opinion with the Examiner concerning how best to apply one of those references constitutes an “error” under factor (e) of *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (informative) (precedential as to factors). The panel’s decision conflicts with § 325(d) and with the Board’s precedential and informative decisions interpreting and applying § 325(d).

The panel misapprehended or overlooked that § 325(d) and prior Board decisions interpreting § 325(d) establish that (1) 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; and (2) the panel’s difference of opinion with the examiner concerning what a particular applied reference would have suggested to

POSITA is insufficient to supply the type of error contemplated by factor (e) of the *Becton, Dickinson* test (“whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art”).

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). These issues warrant the attention of the Precedential Opinion Panel.

Rehearing should be granted, and institution denied.

**1. The Examiner’s Separate Rejections Based On References Relied On In The Petition Does Not Weigh *Against* Exercising Discretion Under § 325(d) Merely Because The Separately Applied References Were Not Applied Together In The Exact Combination In The Petition.**

During the original prosecution of the challenged patent, Patent Owner received and overcame separate rejections over the principal references now relied upon in the Petition. The panel nonetheless refused to exercise discretion under § 325(d) primarily because those applied references were not explicitly combined together by the Examiner in a single rejection. This was error.

The decision recognized that the Ishayama and Ahonen references relied on in the Petition were already applied by the Examiner in rejections during original prosecution. However, the Decision rejected that consideration as support for denial under § 325(d) on the basis that the two previously presented and discussed references were not combined in the same rejection:

Although we agree with Patent Owner that Ishiyama and Ahonen were considered during examination, and that each was relied on in combination with other references in the Examiner’s rejections, as we discuss below with respect to factor (d), Ishiyama and Ahonen were the subject of different rejections, and they were never combined by the Examiner.

Decision at 13; *see also id.* at 15 n.9 (concluding that Examiner’s Notice of Allowance “d[id] not evidence that the Examiner combined Ishiyama and Ahonen”).<sup>1</sup>

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<sup>1</sup> The Petition raised a third reference, Murakawa, which was not considered by the Examiner. The panel found that Murakawa is not materially cumulative of the previously-applied Ahonen, even though “Murakawa and Ahonen disclose forwarding messages to other terminals via a security gateway,” because “Murakawa and Ahonen are materially different in address changing.” Decision at 12-13. However, it is impossible for a difference in address changing between Murakawa and Ahonen to be “materially” different for § 325(d) purposes in this case. As Patent Owner argued, POPR at 22, and the Decision acknowledges just two pages later, the Petition relies on Murakawa for its alleged “security gateway and/or other terminal” disclosure, *not* its “address changing” disclosure. Decision at 14.

Because the Examiner used the relied-upon references in *separate* rejections, and not in the exact combination of those references presented by the Petition, the panel found “this factor weigh[s] against denying institution” under § 325(d). Decision at 14–16. However, the panel’s holding is diametrically contrary to *Becton, Dickinson*, which addressed materially the same facts and came to exactly the opposite conclusion.

In *Becton, Dickinson*, the Board held that the Examiner’s separate rejections using the multiple references relied upon in the Petition, which were relied upon by the Petition in a different combination, weighed *in favor of*, not against, exercising discretion under § 325(d):

[Petitioner’s references] were substantively considered, *albeit in separate obviousness rejections*, during prosecution of the parent application from which the ’762 patent issued as a continuation. ... [T]he asserted prior art for this ground of unpatentability, i.e. [Petitioner’s references], were each considered by the Examiner, albeit in separate obviousness rejections, during prosecution. This is not a case where the prior art was simply listed in an IDS during prosecution. Both [Petitioner’s references] were included as a basis for, and evaluated with respect to obviousness rejections in the parent application over claims with scope similar to that of the ’762 patent, as evidenced by the Terminal Disclaimer filed by Applicant in the prosecution leading to allowance of the ’762 patent.

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