
From: Dinesh Melwani <DMelwani@bomcip.com>
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To: Precedential_Opinion_Panel_Request
Cc: OLNNovoluto1302 (OLNovoluto1302@oshaliang.com); 'Dunn@oshaliang.com'; 'Margonis@oshaliang.com'; 'Cooper@oshaliang.com'; Andrew Sutton; Dinesh Melwani
Subject: IPR2020-00007: EIS GMBH v. Novoluto GMBH - Request for Rehearing by Precedential Opinion Panel
Attachments: AS-FILED PETITIONERS REQUEST FOR REHEARING.pdf

To the Board:

Based on my professional judgment, I believe the Board panel Decision Denying Institution of *Inter Partes* Review (IPR2020-00007, Paper 12) is contrary to the following regulation: 37 C.F.R. § 42.108(c). Based on my professional judgment, I also believe the Board panel decision is contrary to the precedents of the Board in *Blue Coat Sys., Inc. v. Finjan, Inc.*, IPR2016-01444, Pap. 11 (Jul. 18, 2017), and other decisions discussed below, insofar as the denial of institution rests on the Board's failure to view material disputed facts in the light most favorable to the Petitioner:

- *Blue Coat Sys., Inc. v. Finjan, Inc.*, IPR2016-01444, Pap. 11 at 21-22 (Jul. 18, 2017) (“The contrary positions of the parties’ declarants in their testimonial evidence creates a genuine issue of material fact, which we resolve in the light most favorable to Petitioner for purposes of this Decision.”)
- *Incyte Corp. v. Concert Pharm., Inc.*, IPR2017-01256, Pap. 14 at 24 (Apr. 9, 2018) (“At this stage of the proceeding, when faced with competing testimonial evidence that raises a genuine issue of material fact, we must view the evidence in the light most favorable to the petitioner for purposes of our Decision.”)
- *Apple, Inc. v. Personalized Media Comm. LLC*, IPR2016-01520, Pap. 10 at 8 (Mar. 31, 2017) (“[A]ny genuine issues of material fact should be viewed in the light most favorable to the petitioner solely for purposes of deciding whether to institute an *inter partes* review.”)
- *TCT Mobile, Inc. et al. v. Wireless Protocol Innovations, Inc.*, IPR2016-01492, Pap. 7 at 8 FN2, *see also* 12 (Feb. 13, 2017) (“[e]ven if we were to conclude that [PO’s expert’s] testimony regarding claim interpretation were probative and directly contradictory to [Petitioner’s expert’s] testimony on the same issue, 37 C.F.R. §42.108(c) would require that we resolve any such contradiction in TCT’s favor at this stage.”)
- *Pungkuk EDM Wire Mfg. Co. v. Ki Chul Seong*, IPR2016-00763, Pap. 14 at 15 (Sept. 8, 2016) (“[a]lthough we find Patent Owner’s arguments reasonable, Patent Owner’s testimonial evidence concerning disputed material facts will be viewed in the light most favorable to Petitioner for purposes of deciding whether to institute [IPR]....Accordingly, on the present record, we find that Petitioner has demonstrated a reasonable likelihood.”)
- *nXn P’ners, LLC v. Nissan Chem. Indus., Ltd.*, IPR2016-00694, Pap. 7 at 18 (Aug. 31, 2016) (“we view the disputed facts in the light most favorable to Petitioner ...”).
- *SPTS Tech. Ltd. v. Plasma-Therm LLC*, IPR2017-01792, Pap. 8 at 30 (Feb.6, 2018) (“To the extent that [declarant] testimony creates a genuine issue of material fact regarding whether a POSITA would have been discouraged from making the proposed combination ... we view that dispute in the light most favorable to Petitioner at this stage of the proceeding. 37 C.F.R. § 42.108(c).”)

The Panel erred in denying institution. A genuine issue of material fact at the institution stage “will be viewed in the light most favorable to the petitioner.” 37 C.F.R. § 42.108(c). This “allows the petitioner to have an opportunity to cross-examine the declarant during the trial.” July 2019 PTAB Trial Practice Guide Update. Where “[t]he contrary positions of the parties’ declarants in their testimonial evidence creates a genuine issue of material fact,” the Board **must** “resolve in the light most favorable to Petitioner” for purposes of institution. *Blue Coat Sys., Inc. v. Finjan, Inc.*, IPR2016-01444, Pap. 11, 21-22 (Jul. 18, 2017) (emphasis added); *Incyte Corp. v. Concert Pharm., Inc.*, IPR2017-01256, Pap. 14, 24 (Apr. 9, 2018); *Apple, Inc. v. Personalized Media Comm. LLC*, IPR2016-01520, Pap. 10, 8 (Mar. 31, 2017).

Here, the Board made a series of unsupported factual findings regarding the teachings of the prior art references, repeatedly credited Patent Owner’s conclusory declarant testimony over Petitioner’s evidence, and relied on a dictionary definition presented in the preliminary response to find that the *Taylor* prior art reference contains an additional feature that is not actually disclosed. Dec. 8-13. But, as explained in *Blue Coat Sys., Inc.*, whether a prior art reference discloses a claim limitation to a person of ordinary skill in the art is a triable question of fact, which must be resolved in the light most favorable to the Petitioner for purposes of institution. IPR2016-01444, Pap. 11, 18-22 (favoring petitioner’s evidence and granting institution where the parties presented conflicting testimonial evidence regarding the teachings of a prior art disclosure). The panel Decision here indicates that Petitioner’s evidence at the institution stage is not viewed in the light most favorable to the Petitioner, but instead, that the Board may credit Patent Owner’s declarant testimony over a Petitioner’s declarant testimony at the institution stage. Guidance from the Precedential Opinion Panel on this issue of exceptional importance therefore is necessary in order to establish clear guidelines regarding what it means to view the petitioner’s evidence “in the light most favorable to the petitioner.” 37 C.F.R. § 42.108(c).

The Petitioner also filed Precedential Opinion Panel requests in two related matters, IPR2019-01302 (pap. 19) concerning U.S. Pat. No. 9,937,097 and IPR2019-01444 (pap. 15) concerning U.S. Pat. No. 9,763,851. Both requests were denied in those matters on April 6, 2020. IPR2019-01302 (pap. 21); IPR2019-01444 (pap. 16). Petitioner further filed a related civil action in the Eastern District of Virginia against Andrei Iancu, in his official capacity as Under Secretary of Commerce of Intellectual Property and Director of the United States Patent and Trademark Office, and the United States Patent and Trademark Office (collectively, the “PTO”). *EIS GmbH v. Andrei Iancu et al.*, 1:20-cv-00430 (E.D. Va. Apr. 17, 2020). This civil action alleges that the PTO’s decision to deny Precedential Opinion Panel review requested in both IPR2019-01302 (pap. 21) and IPR2019-01444 (pap. 16) was contrary to the requirements of the Administrative Procedure Act, 5 U.S.C. §§ 701-06.

Petitioner therefore respectfully requests that the Board convene a Precedential Opinion Panel to consider the accompanying rehearing request (timely filed earlier today), and all other matters that it chooses to consider.

Respectfully submitted,
/s/ Dinesh Melwani, Reg. No. 60,670
Attorney of Record for Petitioner EIS GMBH



BOOKOFF McANDREWS

Dinesh N. Melwani | Partner
| [Bookoff McAndrews PLLC](#) | www.bomcip.com
| +1.202.808.3497 | dmelwani@bomcip.com
| 2020 K Street NW, Suite 400 | Washington, DC 20006



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