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Paper 10
Date: May 12, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2020-00115
Patent 8,407,609 B2

Before CHARLES J. BOUDREAU, DANIEL J. GALLIGAN, and JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge.*

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

On March 27, 2020, the Board issued an Institution Decision, which exercised discretion under 35 U.S.C. § 314(a) to deny institution of *inter partes* review of claims 1–3 of U.S. Patent No. 8,407,609 B2 ("the '609 patent"). Paper 8 ("Decision"). On April 27, 2020, Petitioner filed a Request for Rehearing. Paper 9 ("Request").

For the reasons provided below, Petitioner's Request is *denied*.

II. BACKGROUND

The '609 patent is asserted against Petitioner in *Uniloc 2017 LLC v. Google LLC*, 2:18-cv-00502 (E.D. Tex.) ("the Texas Litigation"). Paper 1 ("Pet."), 63; Paper 6 ("Prelim. Resp."), 9. According to the district court's Amended Docket Control Order,[1] fact discovery closed on March 30, 2020, expert discovery closed on May 11, 2020, and jury selection will begin on August 17, 2020. Ex. 2002, 1–3. In addition, the district court has invested time and resources in the Texas Litigation: the district court issued a *Markman* order with a detailed discussion of a number of disputed claim terms and phrases (Ex. 2001, 57–78), and the court issued that order within two weeks of its *Markman* hearing (*id.* at 1, 78).

Petitioner's invalidity contentions in the Texas Litigation contain the same arguments as are presented in the Petition for independent claim 1.

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[1] The Amended Docket Control Order (Ex. 2002) is the only evidence in the record regarding the schedule of the Texas Litigation. Although Petitioner argues that the district court *may* modify these deadlines in the future (*see* Request 8–11, 13), Petitioner neither contends that this order has since been amended, nor identifies any prior instances of the district court materially modifying any of these dates.

Compare Pet. 24 (asserting anticipation based on Hayward and obviousness based on Hayward and Middleton), *with* Ex. 2003, 14–15, 18 (same). The Petition also challenges dependent claims 2 and 3 (Pet. 24), which are not currently asserted in the Texas Litigation (Ex. 2003, 1); however, Petitioner has expressly sought to incorporate all of the Petition's contentions into the Texas Litigation (*id.* at 5).

Despite the advanced stage of the Texas Litigation, the Petition addressed neither the stage of, nor the contentions presented in, the Texas Litigation. *See generally* Pet.; *cf.* Consolidated Trial Practice Guide (Nov. 2019) ("Consolidated TPG"), 58, available at https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf (noting that proceedings related to the same patent at a district court may favor denial of a petition and inviting parties to "address in their submissions whether any other such reasons exist in their case . . . and whether and how such factors should be considered" (citing, *inter alia*, *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19–20 (PTAB Sept. 12, 2018) (precedential) ("*NHK*")).[2]

In its Preliminary Response, Patent Owner argued that the Board's precedential decision in *NHK* was "on point" and, thus, that the Board should exercise discretion to deny the Petition. Prelim. Resp. 10–13.

As explained in the Decision, we agreed. Specifically, we concluded that the relevant facts were substantially the same as those presented in *NHK*. Decision 6–9. The district court had scheduled trial for August

[2] Although the Consolidated TPG was published after the Petition was filed, the earlier version (available when the Petition was filed) also includes this guidance. *See* July 2019 Office Trial Practice Guide Update, 84 Fed. Reg. 33,925 (July 16, 2019).

2020—more than seven months before a final written decision would be due—and the record included "no evidence that the district court has granted (or would grant) a stay pending *inter partes* review." *Id.* at 7. Further, Petitioner "present[ed] overlapping arguments in the Texas Litigation and in the Petition." *Id.* at 8 (citing Pet. 24; Ex. 2003, 5, 14–15, 18). Although "the Texas Litigation and the Petition [did] not involve an identical set of claims"—as dependent claims 2 and 3 were not asserted in the Texas Litigation, but were challenged in the Petition—we were not persuaded that this fact alone justified a trial here, as the Board had already instituted two other *inter partes* review proceedings challenging all claims of the '609 patent. *Id.* at 9 (citing *Sling TV, L.L.C. v. Uniloc 2017 LLC*, IPR2019-01367, Paper 7 (PTAB Feb. 4, 2020) (Institution Decision); *Netflix, Inc. v. Uniloc 2017*, IPR2020-00041, Paper 10 (PTAB Mar. 25, 2020) (Institution Decision)). For these reasons, we exercised our discretion to deny the Petition. *Id.* at 10.

III. ANALYSIS

A request for rehearing "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, an opposition, or a reply." 37 C.F.R. § 42.71(d). "The burden of showing a decision should be modified lies with the party challenging the decision." *Id.*

"When rehearing a decision on petition, a panel will review the decision for an abuse of discretion." 37 C.F.R. § 42.71(c); *see Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) ("[T]he agency's decision to deny a petition is a matter committed to the Patent Office's discretion."). "An abuse of discretion is found if the decision: (1) is clearly unreasonable,

arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact finding; or (4) involves a record that contains no evidence on which the Board could rationally base its decision." *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016).

The Request contends that the Decision applied the Board's precedential decision in an "unreasonable" manner and asks the Board to "reweigh the *NHK Spring* factors." Request 1. In support, Petitioner argues that the Decision departed from prior Board decisions (*id.* at 2–6), misapprehended the uncertainty surrounding a "final" decision on validity in the Texas Litigation (*id.* at 6–11), and "undermine[d] Congress' intent" (*id.* at 12–15).

We are not persuaded. Petitioner does not dispute that *NHK* applies and does not contend that we overlooked any relevant arguments or evidence. Petitioner identifies (and we perceive) no place where any of the Request's arguments were previously presented. *See generally* Request; *cf.* 37 C.F.R. § 42.71(d) (requiring identification of "the place where each [allegedly misapprehended] matter was previously addressed in a motion, an opposition, or a reply"). Indeed, Petitioner made the decision not to address *NHK* or the facts relevant to that analysis in its Petition. *See* Decision 5 (citing Pet. i, 60–65); Paper 7, 3 (finding Patent Owner's *NHK* arguments to be foreseeable). We could not have misapprehended or overlooked something Petitioner never presented or explained.

Petitioner's Request also fails to identify an abuse of discretion. Petitioner does not contend that the Decision conflicts with the Board's guidance in the Consolidated TPG or its precedential decision in *NHK*.

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