

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.,
Petitioner,

v.

UNILOC 2017, LLC,
Patent Owner.

IPR2020-00420
Patent 6,868,079 B1

Before JAMESON LEE, SALLY C. MEDLEY, and JASON M. REPKO,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

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

I. INTRODUCTION

On July 14, 2020, Petitioner filed a Request for Rehearing (Paper 8, “Reh’g Req.”) under 37 C.F.R. § 42.71(d) to seek modification of the Board’s Decision Denying Institution of *Inter Partes* Review (Paper 7, “Decision” or “Dec.”) of claims 1–5, 7, and 17 of U.S. Patent No. 6,868,679 B1 (“the ’079 patent”). The Request is *denied*.

II. STANDARD OF REVIEW

When rehearing a decision on institution, we do not review the merits of the decision *de novo*, but instead review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). The party requesting rehearing has the burden to show that the decision should be modified. 37 C.F.R. § 42.71(d). Additionally, the 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.” *Id.*

III. ANALYSIS

Institution of review was discretionarily denied under 35 U.S.C. § 314(a), after consideration of various factors regarding the filing of multiple petitions against the same patent, including the factors set forth and discussed in *General Plastic Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 9–10 (PTAB Sept. 6, 2017) (precedential as to Section II.B.4.i). Decision 16.

A. Which Claims were Asserted against Petitioner

Petitioner argued that claims 1–5 and 7 were not previously challenged in any petition and Patent Owner asserted claims 1–5 and 7 against Petitioner’s products. Pet. 71 n.2. Petitioner, however, submitted nothing to show that Patent Owner asserted claims 1–5 and 7 against Petitioner. We looked outside of the record to the docket sheet in the record of the related litigation between Patent Owner and Petitioner, obtained a copy of the Complaint, and noted that only claim 17 was identified in the Complaint and that there is no amended Complaint. Decision 15. We determined that “claims 1–5 and 7 have not been shown [by Petitioner] to be involved in a district court litigation.” Decision 15.

In the Request for Rehearing, Petitioner argues that “public documents on the district court Docket Report confirm Petitioner’s original statement (see Pet. at 71, n. 2) that claims 1–5 and 7 (and claim 17) are asserted against its products in district court litigation,” citing a Stay Order which includes the statement: “The asserted claims of the ’079 patent are claims 1, 2, 3, 4, 5, 7, and 17.” Reh’g Req. 3. Petitioner argues in the Request for Rehearing that the Board reviewed “select district court pleadings and arrived at the incorrect conclusion that claims 1–5 and 7 are not asserted.” *Id.* at 1. These arguments are misplaced.

First, the Board could not be faulted for not searching and reviewing every single document in the related litigation. It was incumbent upon Petitioner to submit and identify material to support its assertions. Although we were willing to inspect the Complaint and any Amended Complaint, we were not willing to go further. It matters not whether a plaintiff asserting patent infringement is required to identify all asserted claims in the

Complaint. The bottom line is that Petitioner submitted nothing to support its assertion, and we need not even have looked in the Complaint.

Second, we did not find, as Petitioner asserts in the Rehearing Request, that claims 1–5 and 7 “*are not asserted*” by Patent Owner. Reh’g Req. 1. Instead, we determined that “claims 1–5 and 7 have not been shown [by Petitioner] to be involved in a district court litigation.” Decision 15. The two concepts are entirely different. That Petitioner failed to show what was alleged is not an incorrect conclusion, no matter what Petitioner now can demonstrate. The focus is on what Petitioner had shown, not what is demonstrated now in a Request for Rehearing.¹

Third, Petitioner states: “Patent Owner did not contest Petitioner’s statement identifying the asserted claims in its Patent Owner Preliminary Response.” Reh’g Req. 5. Petitioner further states: “Petitioner had no reason to believe these undisputed facts would be questioned or that additional evidence would be necessary to prove up Petitioner’s unchallenged representations.” *Id.* at 5–6. These arguments are misplaced.

The effect of Patent Owner not disputing an assertion in the Petition is that if the Board were to agree with the assertion, Patent Owner could not complain that the assertion is not true. It does not require the Board to agree with the assertion. As we noted in the Decision, there was another factual

¹ Petitioner requests entry of the district court’s Stay Order into the official record as Exhibit 1042. Reh’g Req. 12–14. That paper was not before the Board when the Decision was rendered on June 18, 2020. A Request for Rehearing is not time to submit new evidence for consideration. Given that we did not find that Patent Owner did not assert claims 1–5 and 7, but only that Petitioner failed to show that Patent Owner asserted claims 1–5 and 7, we see no good cause for entering the paper into the record now. Accordingly, the request is *denied*.

assertion by Petitioner, undisputed by Patent Owner, which is untrue. Specifically, we noted: “Petitioner erroneously states that it does not challenge any of the same claims challenged in IPR510. Pet. 72 n.3. The Petition in IPR510 challenges claim 17 and 18 of the ’079 patent. IPR2019-00510, Paper 2, 1.” Decision 14 n.11. Thus, there was reason not to assume every assertion by Petition was true, even in the absence of an affirmative dispute by Patent Owner. In thinking that it had no reason to believe certain factual assertions would be questioned, Petitioner took a calculated risk in not providing sufficient evidentiary support. By choosing which assertions to support with evidence and which not, Petitioner is responsible for its own miscalculation. If there was not another factual misstatement, we might not have questioned the factual assertion here. But there was, and we did. The lack of evidentiary support cannot be cured in Request for Rehearing. Also, Petitioner’s assertions about the claims were not the sole basis for discretionary denial. Rather, it was “treated as an additional factor weighing against institution, *aside from the General Plastic factors discussed above.*” Decision 16 (emphasis added).

B. Accounting for a 10 Month Period

In the Decision, in discussing *General Plastic* factor 5, we stated that “Petitioner’s accounting must begin from when it first learned that Patent Owner had filed suit accusing products designed and manufactured by Petitioner of infringing claims of the ’079 patent.” Decision 12. Rather than accounting for the entire 10 month period from March 26, 2019 to January 17, 2020, the Petition only addressed 4 months. Pet. 73. Now, in the Request for Rehearing, Petitioner provides for consideration an explanation that purportedly covers the entire 10 month period. Reh’g Req. 7–10. The discussion and change of focus from 4 months to 10 months

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