

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

Case CBM2015-00174
Patent 7,810,144 B2

Before MICHAEL W. KIM, PATRICK R. SCANLON, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

ABRAHAM, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner Motorola Mobility LLC filed a Request for Rehearing of our Decision (Paper 8, “Dec.”) denying institution of covered business method patent (“CBM patent”) review of claims 10, 14, 15, and 41 of U.S. Patent No. 7,810,144 B2 (Ex. 1001, “the ’144 patent”). Paper 9 (“Req. Reh’g”). In our Decision, we determined that the information presented in the Petition does not establish that the ’144 patent qualifies as a covered business method patent under § 18 of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”). Dec. 13.

For the reasons that follow, Petitioner’s Request for Rehearing is *denied*.

II. STANDARD OF REVIEW

The party challenging a decision in a request for rehearing bears the burden of showing the decision should be modified. 37 C.F.R. § 42.71(d). 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.” *Id.* Upon a request for rehearing, the decision on a petition will be reviewed for an abuse of discretion. 37 C.F.R. § 42.71(c).

III. DISCUSSION

1. *CBM Standing*

Petitioner contends that in our Decision, we “declined to look to features in the specification of the ’144 patent in determining whether the claims are directed to a ‘method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service’ under AIA § 18(d)(1),” and

that we “misapprehended or overlooked that the features in the specification relied on by Petitioner explain that the claimed methods are ‘used in the practice, administration, or management of a financial product or service,’ and that the intended scope of CBM review includes such claims.” Req. Reh’g 2. Petitioner cites to pages 2–8 of the Petition in support of its contentions, which contain Petitioner’s entire argument that the ’144 patent qualifies as a CBM. *See id.* at 2–4; Pet. 2–8. Thus, it appears that Petitioner contends that the Board misapprehended or overlooked Petitioner’s argument that the Specification of the ’144 patent “makes clear that the claimed file transfer method supports the practice, administration, and management of a financial product or service, in particular, a financial credit system.” Req. Reh’g 3.

We are unpersuaded that we overlooked or misapprehended Petitioner’s argument. To the contrary, as stated explicitly at pages 6–7 of our Decision, we acknowledged expressly Petitioner’s arguments on pages 2–8 of the Petition, and, in evaluating those arguments, determined that

Petitioner’s contentions based on the Specification do not show how the ’144 patent “claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service” or claims “activities that are financial in nature, incidental to a financial activity or complementary to a financial activity.”

Id. at 12. In any case, we have reconsidered Petitioner’s arguments anew, but, nevertheless, determine that our previous analysis of and disagreement with Petitioner’s argument, as articulated on pages 10–13 of the Decision, is still correct.

Specifically, we are unpersuaded that we “declined to look to features in the specification” (Req. Reh’g 2) or “refus[ed] to look to the specification of the ’144 patent” (*id.* at 14) in determining that the information presented in the Petition does not establish that the ’144 patent qualifies as a CBM. As an initial matter, we note that in the Petition, Petitioner identified certain disclosures in the ’144 patent discussing the International Postal Service business model, including the use of a crediting system in that business model (Pet. 4), but that the Petition did not identify further the majority of the citations or arguments,¹ for example, in the paragraph spanning pages 4–6 of the Rehearing Request. Nevertheless, it is unnecessary to parse which portions of the ’144 patent were cited in the Petition, as the Board, in actuality, considered the *entire* Specification of the ’144 patent (including those portions cited for the first time in the Rehearing Request) despite the fact that Petitioner directed us to only a small portion of the Specification in support of its position that the ’144 patent is a CBM. *See* Pet. 3–5. To that end, we note that Petitioner did cite what we would also characterize as the strongest evidence that the ’144 patent is a covered business method patent. We just disagree, for the reasons set forth on pages 10–13 of the Decision, that those citations are as intertwined throughout the ’144 patent to the degree advocated for by Petitioner. Specifically, we note that the citations outside of the International Postal Service business model section are, as noted on page 12 of the Decision, sparse, non-limiting, and only used as

¹ Petitioner does not identify where the statements such as “the specification of the ’144 patent only contemplates systems that include the financial credit system” and “the ’144 patent does not contemplate the claimed file transfer method being implemented without a financial credit system” appear in the Petition. *See* 37 C.F.R. 42.71(d).

exemplary substitutes for otherwise generic data, with no indication of any special treatment for any data that is allegedly financial in nature.

Moreover, given that the claims are one step removed from the Specification, the fact that Petitioner's disagreement appears to be with the characterization of certain portions of the Specification underscores even more the lack of a sufficient relationship between the claims and "finance."

Relatedly, Petitioner asserts that the Board misapprehended or overlooked the above-identified portions of the '144 patent in stating, on page 12 of the Decision, that "the International Postal Service business model and the associated crediting system appear to be described in only one discrete portion of the Specification . . . with no clear ties to specific claim language." Our analysis here is the same as set forth *supra*, and we note further that the Petition itself states that "[w]ithin the *International Postal Service business model*, the claimed file transfer method supports the 'credit system [that] controls the number of transmissions a specific sending PC may send.'" Pet. 4 (emphasis added).

Petitioner also argues that our analysis is inconsistent with past Board decisions finding patents to be CBM patents, and refers to the discussion of other cases in the Decision as being "incorrect." Req. Reh'g. 9–12. Generally, we note that the decisions to which Petitioner cites are not precedential and are not binding on this panel. Furthermore, we disagree that our Decision is inconsistent and incorrect. Our review of the allegedly conflicting decisions reveals that the determination of whether a patent is a CBM is a highly fact dependent inquiry. *See, e.g., Motorola Mobility LLC v. Intellectual Ventures I LLC*, CBM2015-00005, slip. op. at 7–8 (Mar. 27, 2015) (Paper 10); *Informatica Corp. v. Protegrity Corp.*, CBM2015-00010,

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