

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T MOBILITY LLC,
Petitioner,

v.

INTELLECTUAL VENTURES II, LLC,
Patent Owner.

Case CBM2015-00185
Patent 5,339,352

Before GEORGIANNA W. BRADEN, FRANCES L. IPPOLITO, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

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

I. INTRODUCTION

AT&T Mobility LLC (“Petitioner”) timely filed a Request for Rehearing under 37 C.F.R. § 42.71(d) on June 2, 2016. Paper 11 (“Req. Reh’g”). Petitioner’s Request for Rehearing seeks reconsideration of our Decision (Paper 10, “Decision”) entered on May 4, 2016, denying institution of a covered business method patent review of claims 1, 2, 5, and 9 of U.S. Patent No. 5,339,352 (Ex. 1001, “the ’352 patent”). *See* Decision 14. Petitioner alleges the Board (1) overlooked important prior decisions supporting consideration of disclaimed, financially explicit dependent claims in determining CBM eligibility of retained antecedent independent claims, and (2) misapprehended the definition of a CBM patent and the subject matter disclosed in the ’352 patent. Reh’g Req. 1–2. Petitioner requests that its Request for Rehearing be referred to an expanded panel for decision. *Id.* at 2.

For the reasons provided below, we *deny* Petitioner’s request.

II. 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 party challenging a decision bears the burden of showing the decision should be modified. *Id.* When rehearing a decision on a petition, a panel will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c).

A. The Subject Matter of the Challenged Patent Claims

Petitioner challenges our decision because it contends we “misapprehended the subject matter claimed by the [challenged patent]” and we “narrowly interpreted the definition of “covered business method patent” in a manner inconsistent with the relevant statutory language, legislative history, and reviewing court decisions.” Reh’g Req. 1–2.

Contrary to Petitioner’s arguments, we did not misapprehend or overlook the nature of the claimed subject matter or its arguments; rather, we disagreed with Petitioner’s position. Decision 10–13. Specifically, we disagreed that the challenged claims recite activities that are “financial in nature, incidental to a financial activity or complementary to a financial activity.” *Id.* As explained in the Decision, we do not find covered business method patent review available for patents that claim generally useful technologies that also happen to be useful to financial applications. *Id.* at 11. We specifically stated:

Although we acknowledge the specification includes at least one illustrative embodiment directed to an application of the claimed method for billing purposes (*see* Ex. 1001, 2:54–64 (describing billing of wireless cellular subscribers)), we find that such an example is insufficient to make the challenged claims of the ’352 patent eligible for covered business method patent review. The primary justification for covered business method review eligibility provided by Petitioner is that the illustrative embodiments in the specification of the ’352 patent merely show that the invention *may* be used for billing. Pet. 9. Mere ability to use the claimed invention in a financial context, standing alone, does not require a finding that the financial prong has been met, especially when the specification as a whole suggests a broader application. *See ServiceNow, Inc.*, CBM2015-00108, slip. op. at 17 (claims were directed to the general utility of managing a conversation in a Web service and did not cover a

financial transaction); *ServiceNow, Inc. v. BMC Software, Inc.*, Case CBM2015-00107, slip op. at 11–12 (PTAB Sept. 11, 2015) (Paper 12) (panel found instructive that the problem addressed by the patent was nonfinancial in nature, and that a significant portion of the specification described the claimed method in general terms). Petitioner’s citations to the specification, however, do not provide a persuasive basis to conclude that the claims deal with the movement of money or are involved directly in a financial transaction in anything other than a tangential way. Rather, we find that the challenged claims recite a method of general utility for providing a directory assistance call completion service to a wireless communication service subscriber, and the cited example from the ’352 patent makes clear that any financial aspect of the invention as discussed in the specification is, at most, a non-limiting example.

Id. at 12–13.

Thus, we concluded in the Decision that the claimed method is of general utility, and Petitioner had not introduced persuasive evidence to show that at least one claim of the ’352 patent recites a method used in the practice, administration, or management of a financial product or service.

Id. at 13.

Petitioner disagrees with our conclusion, arguing that the ’352 patent describes collection of billing information in explicitly non-optional terms: “it is *necessary to capture billing details*...including the [identification] of the actual calling station” in order to make directory assistance call completion services to wireless callers “viable.” Reh’g Req. 13 (citing Ex. 1001, 2:65–3:11). According to Petitioner, “[t]he *only* utility of recording identity information that is described in the specification is allowing accurate *billing* to individual users.” *Id.* at 13–14.

Petitioner, however, fails to acknowledge that one of the main objectives of the ’352 patent was “to provide directory assistance call

completion to all subscribers, including roaming users initiating intra-LATA directory assistance calls from a mobile wireless communication terminal, such as a cellular telephone.” *See* Ex. 1001, 2:47–51. Furthermore, the challenged claims at issue in the Petition are directed to methods of providing directory assistance call completion services. *See* claims 1, 5, and 9.

Petitioner has not shown how we overlooked or misapprehended its arguments or evidence as required by 37 C.F.R. § 42.71(d). Rather, Petitioner uses its Request for Rehearing as an opportunity to reargue its position; a position with which we disagree. Merely disagreeing with our analysis or conclusions does not serve as a proper basis for a rehearing. It is not an abuse of discretion to provide analysis or conclusions with which a party disagrees. Thus, Petitioner’s challenge does not meet the standard set forth for a request for rehearing.

B. Prior PTAB Decisions Regarding CBM Qualifications

Petitioner challenges our decision because it contends that we “overlooked important prior decisions by other PTAB panels, which make clear that the scope of disclaimed, financially explicit dependent claims should be considered in determining CBM eligibility of a retained antecedent independent claim.” *Reh’g* Req. 1. Petitioner specifically cites to (1) *Compass Bank v. Maxim Integrated Products, Inc.*, CBM2015-00102, slip op. at 11–15 (PTAB Oct. 7, 2015) (Paper 16); (2) *American Express Co. v. Maxim Integrated Products, Inc.*, CBM2015-00098, slip op. at 8–9 (PTAB Sep. 22, 2015) (Paper 17); and (3) *J.P. Morgan Chase & Co. v. Intellectual Ventures II LLC*, CBM2014-00157, slip op. at 3 (PTAB Feb. 18, 2015) (Paper 11), to support its position that we should consider disclaimed

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.