

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON INC.,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

Case IPR2014-00536
Case IPR2014-00537¹
Patent 7,315,406 B2

Before THOMAS L. GIANNETTI, JAMES A. TARTAL, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

DECISION
Request for Rehearing
37 C.F.R. § 42.71(d)

¹ This paper address issues in the listed cases. The parties are not authorized to use this heading style for any subsequent papers.

INTRODUCTION

Canon Inc. (“Petitioner”) filed three separate Petitions (Paper 1 in IPR2014-00535 (“IPR535”), IPR2014-00536 (“IPR536”), and IPR2014-00537 (“IPR537”)), each of which sought review of all 31 claims of U.S. Patent No. 7,315,406 B2 (“the ’406 patent”). In our Decision dated September 24, 2014 (Paper 9 in IPR535, IPR536, and IPR537), we (1) instituted *inter partes* review of all 31 claims of the ’406 patent in IPR535, but (2) did not institute review of the same claims of the same patent in IPR536 and IPR537. Petitioner now requests rehearing in IPR536 and IPR537 (Paper 10 in both cases) of our decision not to institute *inter partes* review of the ’406 patent in those cases. Petitioner bases its rehearing requests in those two proceedings on virtually the same arguments; accordingly, they will be addressed together. For the reasons that follow, Petitioner’s requests for rehearing are denied.

The applicable standard for a request for rehearing is set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request 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, opposition, or a reply.

ANALYSIS

Petitioner argues that in not instituting *inter partes* review in IPR536 and IPR537 we relied on 35 U.S.C. §315(d) and 37 C.F.R. §42.1, but “misapprehended” the applicability of each of those provisions to Petitioner’s multiple Petitions. (Paper 10, 5 in both cases.) Petitioner’s argument is unavailing as we did not base our decision on those cited provisions. Instead, we based our decision on 35 U.S.C. §314(a) and 37 C.F.R. § 42.108(b). Thus, our Decision states:

We decline to institute an *inter partes* review of claims 1–31 on the grounds Petitioner advances based on Kaneko or Chizawa in IPR2014- 00536, and Hayashi in IPR2014-00537. See 35 U.S.C. §314(a); 37 C.F.R. § 42.108(b).

Paper 9, 19. Although we also stated that our Decision was “consistent with the authority granted under 35 U.S.C. §315(d),” and with “the objective” of 37 C.F.R. § 42.1, we did not rely upon those provisions.

Petitioner recognizes that “[c]iting to 35 U.S.C. §314(a), the Board asserted that Congress has ‘given the Office discretion whether to institute a review, or not institute a review.’” (Paper 10, 4 in each case.) Petitioner, however, makes no argument that we misapprehended 35 U.S.C. §314(a), and makes no mention of 37 C.F.R. § 42.108(b). That rule provides that “the Board may deny some or all grounds for unpatentability for some or all of the challenged claims.”

Petitioner further argues that “equitable considerations” require institution of *inter partes* review, referring to the fact that separate fees have been paid for the three proceedings. But Petitioner cites no authority

supporting a proposition that the payment of fees requires granting of the petition, and we are aware of none. (*See* Paper 10, 5 in both cases.) Thus, Petitioner particularly argues that:

Denying Petitioner the opportunity to have its grounds of rejection^[2] considered when Petitioner has accounted for the cost of such consideration via separate petition fees is inherently unjust and ignores Congress' intent of providing a forum for such a purpose.

(Paper 10, 11.) Patent Owner's argument fails because all three of its Petitions were reviewed by the Board. Our Decision makes clear that all of the arguments presented by Petitioner in its three Petitions challenging the same claims of the same patent were carefully considered. Patent Owner elected to organize its challenges to the '406 patent across three Petitions, thus gaining the benefit of 180 pages to make its arguments, instead of the 60 pages provided for a single petition. In doing so, Petitioner chose to incur additional fees. Petitioner's separate fee payments, however, did not assure them that three separate trials would be instituted.

CONCLUSION

Petitioner has not carried its burden of demonstrating that our Decision not to institute *inter partes* review in IPR2014-00536 and IPR2041-00537 misapprehended or overlooked any matters. 37 C.F.R. § 42.71(d). For the foregoing reasons, Petitioner's Request is DENIED.

² We note that Patent Owner incorrectly refers to "grounds of rejection." This proceeding is not a patent examination and the panel does not make "rejections."

IPR2014-00536, IPR2014-00537
Patent 7,315,406 B2

PETITIONER:

Justin J. Oliver
Daniel S. Glueck
FITZPATRICK, CELLA, HARPER & SCINTO
Canon406IPR@fchs.com

PATENT OWNER:

Brenton R. Babcock
Ted M. Cannon
KNOBBE, MARTENS, OLSON & BEAR, LLP
2BRB@knobbe.com
2tmc@knobbe.com

Donald Coulman
INTELLECTUAL VENTURES
dcoulman@intven.com