

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Under Armour, Inc.
Petitioner,

v.

adidas AG,
Patent Owner

Case No. IPR2015-00694

Patent No. 7,292,867

**PETITIONER'S REQUEST FOR REHEARING
PURSUANT TO 37 C.F.R. § 42.71**

I. INTRODUCTION

Under Armour, Inc. (“Petitioner”) respectfully requests rehearing of the Board’s July 16, 2015 Decision (“Decision”) denying institution of a trial based on Grounds 4 and 5, which challenged claims 1, 3, 9, 10, 12, 15, 16, 17, 18, 23 and 24 of U.S. Patent No. 7,292,867 (“the 867 Patent”) based on the Benefon *ESC!:* *Owner’s Manual* [UA-1006] (“the Benefon publication”).

In its Decision, the Board concluded that the Benefon publication and the Hjelm publication [UA-1011], which was cited as extrinsic evidence, do not disclose that speed data is *always* included in a Mobile Phone Telematics Protocol (“MPTP”) position message. Decision [Paper No. 9] at 14. On that basis alone, the Board declined to institute Grounds 4 and 5. Petitioner respectfully submits that this was an abuse of discretion because (1) the law does not require that Petitioner demonstrate that an MPTP position message always includes speed data; and (2) Petitioner submitted evidence that an MPTP position message necessarily accommodates speed data (*i.e.*, includes a dedicated field for speed data).

Petitioner presented uncontested evidence that the Benefon publication discloses transmitting position and tracking messages using a publicly known protocol—MPTP. Petition at 40. Petitioner further submitted extrinsic evidence, the Hjelm publication, to show that an MPTP position message includes a dedicated field for speed data. *Id.* Neither the Patent Owner—who did not even

raise this issue in its preliminary response—nor the Board relied on any evidence suggesting that an MPTP position message does not include a speed field.

Accordingly, the *only* evidence of record before the Board clearly showed that the Benefon publication, viewed with appropriate extrinsic evidence, discloses a mobile phone that was capable of transmitting a message including speed data.

Under the correct legal standard, this was sufficient to meet Petitioner’s burden of proof. As a prior art publication, it was not necessary for Petitioner to demonstrate that the Benefon publication discloses that every MPTP position message always includes speed data. *See Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1383 (Fed. Cir. 2015) (“Though it is true that there is no evidence in Grab of actual performance of combining the ruthenium binder and PVD coatings, this is not required. Rather, anticipation only requires that those suggestions be enabled to one of skill in the art.”) (quotations and citations omitted); *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1379 (Fed. Cir. 2001) (“[A]nticipation does not require actual performance of suggestions in a disclosure. Rather, anticipation only requires that those suggestions be enabling to one of skill in the art.”). In accordance with this precedent, Petitioner was only required to show that the Benefon publication discloses a mobile phone that is capable of transmitting speed data over a wireless network. Petitioner did so. It is uncontested that the Benefon publication discloses

a phone that is capable of transmitting an MPTP position message, and that the Hjelm textbook shows that it was common knowledge that an MPTP position message includes a dedicated field for speed. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (“This modest flexibility in the rule that ‘anticipation’ requires that every element of the claims appear in a single reference accommodates situations where the common knowledge of technologists is not recorded in the reference; that is, where technological facts are known to those in the field of invention, albeit not known to judges.”).

Petitioner thus submits that the Board’s reason for declining institution as to Grounds 4 and 5—that Dr. Burke was incorrect in asserting that *every* MPTP position message includes actual speed data—was a legally insufficient basis for denying institution. It is true that the Hjelm textbook states that the speed field can be blank if speed data is not available. But the possibility that in actual practice the speed field may not always be populated with data is irrelevant to the issue of anticipation based on a printed publication. Furthermore, the fact that Petitioner used extrinsic evidence to show what was common knowledge regarding the dedicated fields in an MPTP position message did not require that Petitioner show that every position message necessarily always includes speed data. Instead, Petitioner was only required to show that an MPTP position message necessarily

includes a dedicated field for speed, which can be populated with speed data when available. Petitioner did so.

Accordingly, Petitioner respectfully requests rehearing of the Board's Decision, and asks that *inter partes* review of claims 1, 3, 9, 10, 12, 15, 16, 17, 18, 23 and 24 be instituted based on Grounds 4 and 5 presented in the Petition.

II. APPLICABLE RULES

“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). “An abuse of discretion may arise if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if an unreasonable judgment is made in weighing relevant factors.” *Daicel Corp. v. Celanese Int'l Corp.*, IPR2015-00173, Decision on Request for Rehearing [Paper No. 15] at 2 (PTAB June 26, 2015).

A request for a rehearing is further governed by 37 C.F.R. § 42.71(d), which states the following:

(d) Rehearing. 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, an opposition, or a reply. A

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