Trials@uspto.gov
571-272-7822

Paper 11
Date: September 30, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNDER ARMOUR, INC.,
Petitioner,

v.

ADIDAS AG,
Patent Owner.

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Case IPR2015-00694
Patent 7,292,867 B2

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Before JENNIFER S. BISK, MICHAEL J. FITZPATRICK, and JUSTIN BUSCH, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

DECISION
Denying Request for Rehearing
*37 C.F.R. § 42.71*

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## I. INTRODUCTION

Petitioner, Under Armour, Inc., filed a Petition to institute an *inter partes* review of various claims of U.S. Patent No. 7,292,867 B2 ("the '867 patent") pursuant to 35 U.S.C. § 311(a). Paper 1 ("Pet."). We entered a Decision Denying Institution of *Inter Partes* Review. Paper 9 ("Decision" or "Dec.").

Petitioner has now filed a Request for Rehearing of that Decision. Paper 10, ("Request" or "Reh'g Req."). The Request seeks rehearing of the portion of our Decision denying institution on the fourth and fifth grounds of unpatentability asserted in the Petition, namely the following:

claims 1, 3, 9, 10, 12, 15, 16, 18, 23, and 24 as anticipated by Benefon (Ex. 1006)[1]; and

claim 17 as obvious over Benefon and eTrex (Ex. 1010)[2].

Reh'g Req. 1.

"When rehearing a decision on petition, a panel will review the decision for an abuse of discretion." 37 C.F.R. § 42.71(c). "The burden of showing a decision should be modified lies with the party challenging the decision[,]" which party "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 Request for Rehearing is *denied*.

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[1] *BENEFON ESC!, Owner's Manual* (2001).
[2] *eTrex Summit Personal Navigator, Owner's Manual and Reference Guide*, GARMIN Corporation (Feb. 2001).

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## II. ANALYSIS

The Petition asserted that claims 1, 3, 9, 10, 12, 15, 16, 18, 23, and 24 were anticipated by Benefon and that claim 17 would have been obvious over Benefon in view of eTrex. Pet. 8.

Independent claim 1 requires that the processing unit "outputs said plurality of waypoints within the route and at least a portion of said athletic performance information [including athletic performance information indicative of velocity] to said wireless communication network during traversal of the route via said wireless wide-area network transceiver." Independent claim 16 is directed to a computer readable medium and contains a limitation corresponding to the just quoted limitation of claim 1.

To meet these limitations, the Petition argued "the disclosure in Benefon 2001 that position/tracking updates utilize 'Mobile Phone Telematics Protocol' or 'MPTP' confirms that speed is contained within those updates,"[3] and "[o]ne of ordinary skill in the art would understand that the content of a position/tracking message was defined by the protocol used (i.e., MPTP) and the data accommodated by that protocol." Pet. 40 (citing Ex. 1004 ¶ 96).

The evidence cited to support the inherency position—Ex. 1004 ¶ 96—is declaration testimony by Shawn Burke, Ph.D. In that paragraph,

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[3] Petitioner's use of the word "confirms" is a reference to a purported express disclosure of these limitations by Benefon, of which we were not persuaded. *See* Dec. 12 ("This [Benefon] excerpt does not disclose transmission of speed or direction data. It discloses storing such data, and notes that the stored speed and direction data can be updated as new position data is received. Ex. 1006, 140.").

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Dr. Burke testified: "This protocol [i.e., MPTP] was known in the art at the time the 867 Patent was filed, *see* J. Hjelm, *Creating Location Services for the Wireless Web* (available March 19, 2002[]) ("Hjelm") [Ex. 1011, 4–5], and was structured so that position updates *always* included the speed and heading of the sending unit. [*Id.* at 7] (table 10.2)." Ex. 1004 ¶ 96 (Dr. Burke's emphasis).

We reviewed the evidence Dr. Burke identified as underlying his opinion, i.e., table 10.2 on page 7 of Hjelm, and we stated the following:

> Table 10.2 is labeled "Position and Status Reporting Message." Ex. 1011, 7 (table 10.2). It mentions, among other things, "Speed" and "Direction," but under each of those entries, table 10.2 states "Can be blank if not available." *Id.* Thus, not only does Dr. Burke fail to explain how table 10.2 purportedly evidences that speed and direction data are "always" included in a Benefon position update, table 10.2 suggests that the opposite is true.

Dec. 14.

In its Request for Rehearing, Petitioner does not contest our finding that Hjelm table 10.2 fails to support Dr. Burke's opinion that, using MPTP, "position updates always include the speed." Ex. 1004 ¶ 96. Instead, Petitioner creates a new legal theory, stating:

> 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,

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> 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.

Reh'g Req. 2.

Thus, Petitioner suggests that, even though Benefon does not explicitly disclose the limitation at issue, it is not required to *necessarily* function in accordance with the claims it allegedly anticipates, but instead, need simply be *capable* of functioning in such a way. We could not have overlooked or misapprehended this new argument, which was not raised in the Petition. For that reason alone the Request for Rehearing is denied.

Nonetheless, we address this argument and the case law cited by Petitioner for the first time in its Request for Rehearing. Neither case supports Petitioner's novel anticipation position. In fact, Petitioner's reliance on the cases is troubling.

In *Kennametal*, the issue was not whether a limitation not expressly disclosed in an anticipatory reference was inherently present. Indeed, the Court of Appeals noted that "all the limitations of Kennametal's claim are specifically disclosed in Grab [the anticipatory reference]." *Kennametal*, 780 F.3d at 1382. The issue in *Kennametal* was whether a specific combination of those limitations would have been "immediately envisage[d]" by a person of ordinary skill in the art. *Id*. at 1383; *see also id*.

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