

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

JI-SOO LEE,
Patent Owner.

IPR2016-00045
Patent 6,233,518 B1

Before PATRICK R. SCANLON, DANIEL J. GALLIGAN, and
SCOTT C. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request for Rehearing of Final Written Decision
on Remand
37 C.F.R. § 42.71(d)(2)

I. INTRODUCTION

On July 22, 2020, we issued a Final Written Decision on Remand determining challenged claims 45 and 46 of U.S. Patent 6,233,518 B1 (“the ’518 Patent”) to be unpatentable. Paper 43 (the “Final Decision” or “Final Dec.”). Patent Owner subsequently requested, and was granted, a 30-day extension of the deadline for filing a request for rehearing, which reset the deadline to September 21, 2020. Paper 46.

On September 16, 2020, Patent Owner filed a Request for Rehearing of our Final Decision. Paper 48 (“Rehearing Request” or “Reh. Req.”). Patent Owner seeks reconsideration of our determination that claims 45 and 46 of the ’518 Patent were shown to be unpatentable over Yamada and Rosenquist. For the reasons explained below, Patent Owner’s Rehearing Request is *denied*.

II. LEGAL STANDARD

A party requesting rehearing bears the burden of showing that 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 in a motion, an opposition, or a reply.” *Id.*

III. ANALYSIS

Patent Owner argues that our Final Decision overlooked several claim terms and related claim constructions, misapprehended the disclosure of Rosenquist, and erroneously credited testimony from Petitioner’s declarant. Reh. Req. 3–12. None of these arguments is persuasive.

A. Patent Owner Fails to Demonstrate that the Final Written Decision Overlooked Claim Language or Claim Constructions

Patent Owner argues that the Final Decision overlooked three separate claim terms and corresponding constructions. We address each of these arguments in turn.

“receiving a traffic information map which includes . . . a plurality of time-variant image vector entities”

According to Patent Owner, our Decision on Institution correctly determined that Yamada’s system does not receive image vector entities under our construction of that claim term. Reh. Req. 4. In contrast, Patent Owner contends that our Final Decision “discussed only the three claimed components” of the image vector entity limitation (i.e., “attribute-designating statement, “shape-designating statement,” and “position-designating statement”), and “ignored other technically meaning features” contained in our construction of the term “image vector entities.” *Id.* at 4–5. This argument is not persuasive.

Our Decision on Institution was a preliminary decision issued on an incomplete evidentiary record; it was not a final determination as to the patentability of any claim. Paper 7, 2. Thus, it is not surprising that our Final Decision differs in certain respects from our Decision on Institution; these differences do not demonstrate error. Moreover, *inter partes* reviews are adversarial proceedings in which the parties are required to spell out their arguments. After an *inter partes* review was instituted, Patent Owner was required to set forth *all* of its arguments for patentability in the Patent Owner Response (Paper 37). Our scheduling order made clear that any arguments not raised in the Patent Owner Response would be deemed

waived. *See* Paper 33, 5. Our rules do not permit Patent Owner to remain silent during trial, and then raise an issue for the first time in a rehearing request. 37 C.F.R. § 42.71(d) (requiring Patent Owner to specify where each argument in its Rehearing Request “was previously addressed in a motion, an opposition, or a reply”).

Patent Owner asserts that we focused on certain portions of our construction of the claim term “image vector entity” and gave short shrift to other portions. Reh. Req. 4. But the Rehearing Request does not identify anywhere in the Response where Patent Owner made arguments based on the allegedly overlooked portions of our claim construction.¹ Moreover, after Patent Owner filed its Response, Petitioner filed a Reply and supporting testimony explaining how the combination of Yamada and Rosenquist would have taught or suggested all aspects of our construction of the “image vector entity” limitation. *See* Paper 38, 4–13; Ex. 1021 ¶¶ 3–22. Patent Owner elected not to file a sur-reply as it was permitted to do and, thus, did not dispute these contentions in any of its authorized briefing during trial.² *See* Paper 33 (Scheduling Order), 6.

¹ Patent Owner asserts that it “restated the Board’s conclusion of the institution decision” on Page 41 of its Response. Reh. Req. 4 (citing Paper 37, 41). But our Final Decision applied the same claim construction that we adopted in our Institution Decision. *See* Paper 7, 7–10 (construing “image vector entity”); Paper 43, 11, 25 (applying the same claim construction). In addition, page 41 of the Patent Owner Response does not set forth the argument Patent Owner now attempts to raise on rehearing.

² The record establishes that Patent Owner was represented by counsel throughout the remand proceeding, and was well aware of the option to file a sur-reply. Patent Owner’s remand counsel entered its first appearance on August 16, 2019, when it filed updated mandatory notices (Paper 35), a

Patent Owner, having failed to raise its present arguments during trial, may not do so in a rehearing request. *See* Paper 33, 5; 37 C.F.R. § 42.71(d). Our Final Decision could not have misapprehended or overlooked arguments that Patent Owner declined to raise during trial, and that were therefore waived.

“a basic map . . . includes . . . time-invariant image vector entities . . .”

Patent Owner next asserts that our Final Decision overlooked the claim term “a basic map” that includes “time-invariant image vector entities.” Reh. Req. 5–7. The Rehearing Request cites repeatedly to the challenged ’518 Patent (Ex. 1001) and Yamada (Ex. 1007), but fails to cite to any brief in which Patent Owner allegedly raised this argument during trial. *See id.* Moreover, the portion of Patent Owner’s Response directed to the combination of Yamada and Rosenquist never addresses or discusses this

power of attorney (Paper 36), and the Patent Owner Response (Paper 37). The due date for Patent Owner to file a sur-reply was October 11, 2019. Paper 33, 7. On November 12, 2019, after all briefing was complete (*see* Paper 33, 7), Patent Owner’s counsel filed a motion to withdraw. Paper 42. This motion made clear that Patent Owner had been informed of all relevant due dates, including the due date for a sur-reply. Paper 42, 7 (“[Counsel] has informed Patent Owner of the upcoming due dates in this matter, Petitioner’s filings, Patent Owner’s opportunity to file a sur-reply, the due date of filing such sur-reply, and Petitioner’s making of Petitioner’s expert available for deposition.”). We did not grant the motion to withdraw (*see* Paper 44) until after we issued our Final Written Decision (Paper 43). Since the motion was granted, Patent Owner has elected to proceed *pro se*. *See* Paper 45, 2.

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