

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

NONEND INVENTIONS N.V.,
Patent Owner.

Case IPR2016-00174
Patent 8,090,862 B2

Before MICHAEL W. KIM, JENNIFER S. BISK, and
DANIEL N. FISHMAN, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*.

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

I. BACKGROUND

On May 8, 2017, we issued a Final Written Decision in this proceeding. Paper 26 (“Decision” or “Dec.”). In the Decision, we held Petitioner demonstrated, by a preponderance of the evidence, that claims 1–6 and 8–18 of U.S. Patent No. 8,090,862 B2 (“the ’862 patent”) (Dec. 32–33) are unpatentable as anticipated by Shastri¹, and claims 1–20 are unpatentable over Goldszmidt² or over Goldszmidt in combination with Lumelsky³ (*id.* 45–46). On June 5, 2017, Petitioner filed a Request for Rehearing challenging our determination that Petitioner waived any arguments regarding Real Party in Interest, and erroneously found Patent Owner failed to antedate the Shastri reference. Paper 27 (“Request”).

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” “An abuse of discretion occurs if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors.” *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004) (citing *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000)). On rehearing, the burden of showing the Decision should be modified lies with the party challenging the Decision—here, Patent Owner. 37 C.F.R. § 42.71(d). “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.” *Id.*

¹ U.S. Patent Publication 2002/0065922 A1.

² U.S. Patent 6,195,680 B1.

³ U.S. Patent 6,377,996 B1.

Furthermore,

[a] request for rehearing is not an opportunity merely to disagree with the panel’s assessment of the arguments or weighing of the evidence, or to present new arguments or evidence. It is not an abuse of discretion to have performed an analysis or reached a conclusion with which Petitioner disagrees, and mere disagreement with the Board’s analysis or conclusion is not a proper basis for rehearing.

Sophos, Inc. v. Finjan, Inc., Case IPR2015-01022, at 3–4 (PTAB Jan. 28, 2016) (Paper 9).

For the reasons that follow, Petitioner’s request for rehearing is *denied*.

II. ANALYSIS

A. *Waiver of Argument*

Our Scheduling Order made clear that any “arguments for patentability” not raised in Patent Owner’s Response are deemed waived. Paper 11, 2–3 (“The patent owner is cautioned that any argument for patentability not raised in the response will be deemed waived.”). Patent Owner argues,

Nonend’s argument regarding the real-party in interest cannot fairly be characterized as an “argument for patentability.” Rather, it was an argument that the petition should have never been taken up and could not be continued to be considered when it was not being prosecuted in the name of the real parties in interest.

Request 2. Thus, Patent Owner contends it was not provided “fair notice” that its preliminary arguments relating to real party in interest would be waived if not re-stated in its Response. *Id.*

Initially, we deny Patent Owner’s Request because it fails to identify specifically an argument that we misapprehended or overlooked as required

by our rules. Patent Owner's argument that it received insufficient notice that its preliminary arguments regarding real party in interest (Paper 7, 4–13) would be waived fails to identify an argument we overlooked or misapprehended. Instead, Patent Owner's argument challenges the propriety of our cautionary order that such arguments not raised in its Response will be waived. Arguments that are not raised in Patent Owner's Response could not have been overlooked or misapprehended.

Furthermore, recent case law supports our Decision's analysis that Patent Owner waived its arguments relating to real party in interest.

NuVasive waived its public accessibility arguments before the PTAB and may not raise them on appeal. NuVasive challenged the public accessibility of the prior art references during the preliminary proceedings of the inter partes review, J.A. 159–63 (section of NuVasive's Preliminary Response that addresses public accessibility), but failed to challenge public accessibility during the trial phase, J.A. 227–93 (NuVasive's Trial Response that fails to address public accessibility).

In re Nuvasive, Inc., 842 F.3d 1376, 1380 (Fed. Cir. 2016)

Even assuming, *arguendo*, that Patent Owner did not waive arguments relating to real party in interest, our Decision on Institution already determined that these arguments in Patent Owner's Preliminary Response were not persuasive. Paper 10, 6. Furthermore, Patent Owner's Response failed to provide any further argument on that issue, and even considering the issue anew, based on the arguments set forth in Patent Owner's Preliminary Response, we are unpersuaded our determination requires alteration.

B. Antedating Shastri

Patent Owner argues the “only evidence of record supported Nonend’s position that the inventors of the patents-in-suit had an invention date before the effective date of the Shastri reference.” Request 3. Patent Owner further contends “the Board discounted the only evidence of record . . . [and, thus,] shifted the burden of persuasion back to Nonend.” *Id.*

Our Decision did not improperly shift the burden of persuasion back to Patent Owner. As we observed in our Decision, Patent Owner complied with its burden to produce evidence supporting its position that the patent at issue antedates Shastri. Dec. 18–19 (“We find that Patent Owner has met that burden by producing the Declarations of the inventors of the ’862 patent (Exs. 2018, 2019) and corroborating evidence (Exs. 2020–2027, 2029) that allegedly show conception prior to Shastri, and reasonable diligence through filing of a patent application (constructive reduction to practice) to antedate the filing of Shastri. PO Resp. 11–13.”). As an initial matter, we disagree with Patent Owner’s argument that it provided the *only* evidence relating to antedating Shastri. Petitioner did provide cross-examination testimony of Patent Owner’s declarants—the inventors of the ’862 patent—concerning this issue, which is “evidence.” Even putting that aside, however, what Patent Owner is actually asserting is that the evidence Patent Owner provided supports only its position, and that, relatedly, Petitioner cannot use that same evidence to support Petitioner’s position. That assertion has no merit. While certainly a party would be expected to present evidence that, on balance, would favor their position, the evidence itself is merely objective information that can be used by any party, as appropriate. To that end, a party submitting evidence submits it at their own peril. In that vein,

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.