

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SEABERY NORTH AMERICA INC.,  
Petitioner,

v.

LINCOLN GLOBAL, INC.  
Patent Owner.

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Case IPR2016-00840  
Patent RE45,398

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Before THOMAS L. GIANNETTI, JENNIFER S. BISK, and  
JESSICA C. KAISER, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a) and 37 C.F.R. § 42.73*

## I. INTRODUCTION

Seabery North America Inc. (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–19 to institute an *inter partes* review of claims all 195 claims of U.S. Patent RE45,398 (Ex. 1001, “the ’398 patent”). Paper 5 (“Petition” or “Pet.”). Lincoln Global, Inc. (“Patent Owner”) filed a preliminary response. Paper 9 (“Prelim. Resp.”). Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we granted Petitioner’s request and instituted an *inter partes* review on 151 of the 195 claims. Paper 11, 32.

Following institution, Patent Owner filed a Response to the Petition (Paper 33, “PO Resp.”) and Petitioner filed a Reply (Paper 42, “Pet. Reply”). In addition, and with our authorization, Patent Owner filed two separate sur-replies directed to specific issues that came up during the trial. Papers 52 and 53. These will be discussed in more detail *infra*.

The extensive record in this case also includes transcripts of several telephonic hearings requested by the Board or the parties. *See* Ex. 1037 (transcript of October 31, 2016 hearing); Ex. 1048 (transcript of November 15, 2016 hearing); Ex. 1049 (transcript of January 9, 2017 hearing); Ex. 1053 (transcript of February 22, 2017 hearing); Ex. 2023 (transcript of May 16, 2017 hearing). In addition, a final oral hearing was held on July 10, 2017. A transcript of that hearing has been entered in the record. Paper 59 (“Hr’g Tr.”)

For the reasons discussed below, Petitioner has shown by a preponderance of the evidence that all representative claims of the ’398 patent are unpatentable. *See infra*. In addition, we determine that by

consent of the parties, the remaining claims in this *inter partes* review stand or fall with those representative claims. Therefore, the remaining claims are also unpatentable.

## II. PRELIMINARY MATTERS

### A. Representative Claims

Because the trial involved over 150 claims, we ordered the parties to meet and confer “to discuss ways to streamline this proceeding,” including choosing no more than 20 representative claims for trial. Paper 12, 3. If the parties could not agree on representative claims, we authorized the parties to each submit a proposed list of such claims. *Id.* The parties eventually agreed on the following claims of the ’398 patent as representative: claims 9, 12, 14, 23, 24, 33, 52, 81, 89–92, 95, 96, 137–141, and 168. Paper 25, 2. We then ordered the parties each to submit a memorandum “associating each of the . . . representative claims with one or more of the remaining claims of the ’398 patent for which trial was instituted.” *Id.* We clarified this directive by the following explanation:

The Board intends that by ‘associating’ a particular claim with a representative claim, the party agrees that a decision as to the patentability of the representative claim [will] be binding also as to the associated claim.

*Id.* at 3 n.1

Accordingly, the parties each submitted a memorandum on representative claims, as required by our order. Paper 27 (Patent Owner’s memorandum); Paper 28 (Petitioner’s memorandum). While there was a considerable amount of overlap in the parties’ submissions, for the purpose of this Decision, we adopt Patent Owner’s presentation of representative claims and associated remaining claims. *See infra.* Furthermore, we

acknowledge Patent Owner's representation that Patent Owner "currently believes each representative claim and its associated remaining claims stand or fall together." Paper 27, 1. Patent Owner did not alter this representation in its Patent Owner Response. *See generally* PO Resp.

#### B. Motion to Exclude

The principal reference relied on by Petitioner against all challenged claims is a thesis authored by Dorin Aiteanu, a Ph.D. candidate at the University of Bremen, Germany. Petitioner contends that the thesis was publicly accessible in March 2006, several years before the March 2010 filing date of the application for the '398 patent. Petitioner relies mainly on the testimony of Dr. Axel Graeser, who was on the faculty of the University of Bremen and supervised Aiteanu's thesis.

Patent Owner's motion does not seek to exclude the thesis itself. Instead, Patent Owner contests Petitioner's proofs that the Aiteanu thesis qualifies as a printed publication under 35 U.S.C. § 102(b). *See* discussion *infra*. Thus, Patent Owner's motion to exclude evidence (Paper 49) narrowly focuses on certain testimony about the thesis from Dr. Graeser, and on certain dates appearing on Exhibit 1003, one of the copies of the Aiteanu thesis submitted by Petitioner.<sup>1</sup>

Although not entirely clear from Patent Owner's motion, it appears Patent Owner objects to Dr. Graeser's use in his testimony of the terms

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<sup>1</sup> Petitioner has introduced three copies of the Aiteanu thesis: Exhibits 1003 and 1019 (submitted with the Petition) and Exhibit 1050 (introduced during the trial). The minor differences between the copies are discussed *infra*.

“publish” or “published” in reference to the thesis, on the ground that it constitutes “unqualified expert testimony.” Paper 49, 1; Paper 56, 1. Thus, Patent Owner seeks to exclude certain statements from Dr. Graeser’s declaration that Patent Owner contends contains “publication date assertions” or alleged “legal conclusions” as to when the thesis was published. Paper 49, 1–2; Paper 56, 1–2. Petitioner responds that Dr. Graeser’s testimony “is factual, not an expert opinion.” Paper 55, 2.

We deny Patent Owner’s motion to exclude this testimony. We do not understand Dr. Graeser’s testimony to be expressing an expert opinion on this issue. Thus, Rules 702 and 703 of the Federal Rules of Evidence, cited by Patent Owner, are inapplicable. Rather, we determine that Dr. Graeser has demonstrated personal knowledge of the matter and is therefore competent to present factual testimony on the public accessibility of the Aiteanu thesis under Rules 601 and 602 of the Federal Rules of Evidence.

Likewise, we deny Patent Owner’s motion to exclude certain dates appearing in Exhibit 1003. Patent Owner contends that the dates are “inadmissible hearsay.” Paper 49, 2. Petitioner responds that the dates are not hearsay, and, alternatively, that a hearsay exception (the business records exception of Rule 803(6) or, alternatively, the “residual” exception of Rule 803) applies. Paper 55, 21–22.

As Petitioner points out, other panels of the Board have admitted such dates over hearsay objections. *See* Paper 55, 19–20. We agree with the view that the dates are not hearsay because they are not assertions. We, therefore, deny Patent Owner’s motion to exclude these dates. We are supported in this by cases such as *United States v. Snow*, 517 F.2d 441, 445 (9th Cir. 1975), where a red tape bearing the defendant’s name affixed to a

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