

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS, INC.  
Petitioner

v.

INTELLECTUAL VENTURES II, LLC  
Patent Owner

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U.S. Patent 6,968,459  
IPR2016-01404

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**REQUEST FOR REHEARING**

## I. INTRODUCTION

In its Final Written Decision, the Board found all challenged claims 1, 2, 13, 14, 33, 34, 39, 46, and 48 not unpatentable based on finding the independent claims not anticipated by *Bensimon*. See *Unified Patents Inc. v. Intellectual Ventures II LLC*, IPR2016-01404, Paper 34, at (Jan. 10, 2018). In doing so, the Board found that the primary reference on which review was instituted, *Bensimon et al.*, U.S. Patent 5,533,125, issued July 2, 1996 (Ex. 1004, “Bensimon”) taught all of the elements of the claim in “one possible mode of operation.” Paper 34, at 17. The Board reasoned that because that mode did not *need* to occur, *Bensimon* did not anticipate the claim. It thus found that the “restricted-access mode” limitation was not taught.

The Federal Circuit holds that “a prior art product that sometimes, but not always, embodies a claimed method nonetheless teaches that aspect of the invention.” *Hewlett-Packard Co. v. Mustek Sys., Inc.*, 340 F.3d 1314, 1326 (Fed. Cir. 2003); *Power Integrations, Inc. v. Fairchild Semiconductor Int’l, Inc.*, 843 F.3d 1315, 1337 (Fed. Cir. 2016) (applying *Hewlett* holding to anticipation); *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1002 (Fed. Cir. 2016). The Board found that *Bensimon* sometimes teaches all of the elements of the claim, but

misapprehended that this meant the claims were not anticipated. This was legal error. Petitioner respectfully requests the Board find the challenged claims 1, 2, 13, 14, 33, 34, 39, 46, and 48 unpatentable.

## II. ARGUMENT

### A. Legal Standard

Parties may file a single request for rehearing without prior authorization from the Board. 37 C.F.R. § 42.71(d). On rehearing, the burden of showing the Decision should be modified lies with the party challenging the Decision. *Id.* “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.*

### B. *Bensimon* discloses the “restricted-access mode” limitation

Claim 1<sup>1</sup> requires, *inter alia*:

[1] operating a computer in a full-access mode when the storage device has the device-specific security information, wherein in the full-access mode the computer permits both read and write access to the storage device; and

[2] operating the computer in a restricted-access mode when the storage device does not have the device-specific security information,

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<sup>1</sup> Claim 1 is representative of all the challenged independent claims. Paper 34, 5.

As a result, only this claim is discussed here.

wherein in the restricted-access mode the computer permits read access to the storage device and prevents write access to the storage device.

The Board did not dispute that *Bensimon* discloses [1] by disclosing a “read/write protection mode” wherein the device has a “read/write password” that corresponds to the claimed “device-specific security information,” but the Board held that *Bensimon* did not disclose [2]. Paper 34, 15-17.

Regarding [2], the Board found that *Bensimon* discloses a “restricted-access mode” by disclosing a “write protection” mode. *Id.*, 16-17. The Board also found that *Bensimon* expressly disclosed two configurations for the device when the read/write password was absent: “write protection” mode and “no protection” mode. *Id.* What determines which of these two configurations options is available is the presence of another password, the “write-protection” (i.e., read-only) password. *Id.* The Board concluded that *Bensimon*’s express disclosure of two configurations that depended on the presence of a password other than the read/write password did not satisfy the claims “because claim 1 requires operating in restricted access mode when the storage device does not have the device-specific storage information[.]” *Id.*, 17. That is, the Board held that the claims were not anticipated because *Bensimon* discloses the claimed arrangement only some of the time and not all of the time—*Bensimon* discloses the claimed arrangement only the times it is configured with the “write-protection” password. *Id.* This was legal error.

The Federal Circuit has long held that “a prior art product that sometimes, but not always, embodies a claimed method nonetheless teaches that aspect of the invention.” *Hewlett–Packard Co. v. Mustek Sys., Inc.*, 340 F.3d 1314, 1326 (Fed. Cir. 2003); *Power Integrations, Inc. v. Fairchild Semiconductor Int’l, Inc.*, 843 F.3d 1315, 1337 (Fed. Cir. 2016) (applying *Hewlett* holding to anticipation); *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1002 (Fed. Cir. 2016).

The PTAB has applied this principle many times. *See, e.g., Google LLC et al. v. Fujinomaki*, IPR2016-01522, Paper 31 at 37-38 (Jan. 8, 2018) (Final Written Decision) (finding that prior art that sometimes embodies a claimed method anticipates and thus renders the claims unpatentable); *Ameriforge Grp., Inc.*, IPR2015-00233, Paper 37 at 22-23 (May 16, 2016) (Final Written Decision) (same); *RPX Corp. et al. v. Iridescent Networks, Inc.*, IPR2017-01661, Paper 9 at 21 (Dec. 13, 2017) (Institution Decision) (instituting where this was the case); *Ex Parte Mary Lou Kesse, Zhiyong Wei, & Liangtao Zhu*, Appeal No. 2014-002007, “Decision on Appeal” at 12 (May 20, 2016) (affirming examiner’s rejection in these circumstances).

In view of this longstanding precedent, the Board has *already* found that *Bensimon* discloses the “restricted-access mode” limitation. As discussed above, this panel acknowledged that *Bensimon* expressly discloses its device operating in a

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