

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

INTELLECTUAL VENTURES II, LLC,
Patent Owner.

Case IPR2016-01404
Patent 6,968,459 B1

Before THOMAS L. GIANNETTI, PATRICK M. BOUCHER, and
KAMRAN JIVANI, *Administrative Patent Judges*.

JIVANI, *Administrative Patent Judge*.

DECISION

Granting Motion to Excuse Late Filing of
Petitioner's Request for Rehearing

37 C.F.R. § 42.5(c)(3)

Denying Petitioner's Request for Rehearing

37 C.F.R. § 42.71

I. INTRODUCTION

Petitioner Unified Patents Inc. sought *inter partes* review of claims 1, 2, 13–15, 18, 33, 34, 39, 46, and 48 of U.S. Patent No. 6,968,459 B1 (“the ‘459 patent”). Paper 2. Patent Owner Intellectual Ventures II, LLC filed a Preliminary Response. Paper 8. Upon consideration of the Petition and Preliminary Response, we instituted an *inter partes* review of claims 1, 2, 13, 14, 33, 34, 39, 46, and 48 pursuant to 35 U.S.C. § 314. Paper 9.¹

During the trial, Patent Owner filed a Patent Owner Response (Paper 19) and observations on cross examination (Paper 30). Petitioner filed a Reply to the Patent Owner Response (Paper 23, “Reply”) and a reply to Patent Owner’s observations (Paper 31). An oral hearing was conducted on November 14, 2017. The record contains a transcript of the hearing (Paper 33, “Tr.”). Upon consideration of the complete trial record, we determined that Petitioner had failed to show by a preponderance of the evidence that any of the challenged claims are unpatentable. Paper 34 (“Decision”).

Petitioner filed a Request for Rehearing (Paper 35, “Reh’g Req.”), requesting reconsideration of our Decision and a Motion to Excuse Late Filing of Petitioner’s Request for Rehearing (Paper 36, “Motion”).² We

¹ We did not institute, however, review of claims 15 and 18 because we determined that Petitioner had not established a reasonable likelihood it would prevail with respect to those claims. *Id.*

² After Petitioner filed its Request for Rehearing, the Supreme Court issued its decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018), concerning final written decisions issued by the Board addressing fewer than all claims a petitioner challenged in a petition. Neither party asserts that the Court’s decision in *SAS Institute* requires additional consideration in this proceeding.

have considered Petitioner's Motion and its Request for Rehearing. For the following reasons, Petitioner's Motion is *granted* and its Request is *denied*.

I. UNOPPOSED MOTION TO EXCUSE LATE FILING

Petitioner filed its Request for Rehearing on February 10, 2018, one day after the filing deadline of February 9, 2018. Motion 1. Our rules provide that “[a] late action will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.” 37 C.F.R. § 42.5(c)(3). Petitioner asserts that both good cause and the interests of justice support excusing its late filing because: (1) Petitioner timely served its Request on Patent Owner's counsel, (2) Petitioner attempted to file timely its Request, and (3) Petitioner filed its Request the next day. Motion 1.

Petitioner asserts that both of its in-house counsel, who are backup counsel of record in this proceeding, attempted to file the Request for Rehearing on February 9, 2018, but were unable to do so because they lacked filing privileges for our electronic filing system. Motion 1. Petitioner's outside counsel could not be reached at the time of attempted filing and Petitioner's lead outside counsel was unavailable due to an urgent family health matter. *Id.* at 1–2. In-house counsel then attempted to contact the Board via email telephone and timely served its Request for Rehearing on Patent Owner's counsel. *Id.* at 2. Outside counsel subsequently filed the Request for Rehearing the next day. *Id.* at 2. Patent Owner has not filed an opposition to the motion.

Under these circumstances, we find Petitioner has shown good cause to excuse its delay of filing by one day. In particular, good cause is demonstrated here by lead counsel's unavailability due to an urgent family

health matter, back-up counsel's attempts to file, and back-up counsel's timely service on opposing counsel. Accordingly, Petitioner's Motion to Excuse Late Filing of Petitioner's Request for Rehearing is *granted*.

II. ANALYSIS OF REHEARING REQUEST

Of the challenged claims, claims 1, 15, 18, 33, and 39 of the '459 patent are independent. Claim 1 illustrates the claimed subject matter, and is reproduced below.

1. A method comprising:

sensing whether a storage device has device-specific security information stored thereon;

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

operating the computer in a restricted-access mode when the storage device does not have the device-specific security information, wherein in the restricted-access mode the computer permits read access to the storage device and prevents write access to the storage device.

Ex. 1001, 9:16–28.

In our Decision, we determined, “[b]ased on the complete evidentiary record before us, [that] Petitioner has not identified in Bensimon explicit or inherent disclosure of the claimed restricted-access mode.” Decision 16. We explained that “[c]laim 1 requires operating in restricted-access mode ‘when the storage device does not have the device-specific security information.’” *Id.* (citing Ex. 1001, 9:24–26). We observed that “Petitioner identifies Bensimon’s read/write password, alone or in combination with the password-enabling flag, as *the* device-specific security information, yet Petitioner does not identify in Bensimon an explicit disclosure that

Bensimon’s storage device operates in the claimed restricted-access mode when *the read/write password* is absent from the device.” *Id.* at 16–17 (citing Reply 16–22). For this reason, we found Petitioner failed to establish by a preponderance of the evidence that any of the challenged claims are unpatentable. *Id.* at 18–19.

In its Request for Rehearing, Petitioner asserts that we found Bensimon “taught all of the elements of the claim in ‘one possible mode of operation.’” Reh’g Req. 1 (citing Decision 17). According to Petitioner, “[t]he 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.” *Id.* at 1–2. Petitioner elaborates, “the Board found that Bensimon discloses a ‘restricted-access mode’ by disclosing a ‘write protection’ mode. *Id.* at 3 (citing Decision 16–17).

“The burden of showing a decision should be modified lies with the party challenging the decision . . .” who “must specifically identify all matters the party believes [we] 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).

Petitioner’s argument is predicated upon a mischaracterization of our factual findings. Petitioner asserts that we found Bensimon “taught all of the elements of the claim in ‘one possible mode of operation.’” Reh’g Req. 1 (citing Decision 17). We, however, made no such finding. The phrase that Petitioner attributes to us—namely, “one possible mode of operation”—does not appear anywhere in our Final Written Decision. *Compare* Reh’g Req. 1 (citing Decision 17) *to* Decision 17. Contrary to Petitioner’s assertions, we did not find “that Bensimon sometimes teaches all of the elements of the

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