

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.

JOHN L. BERMAN,  
Patent Owner.

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Case IPR2016-01571  
Patent 5,523,791

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Before KEN B. BARRETT, PATRICK M. BOUCHER, and  
MELISSA A. HAAPALA, *Administrative Patent Judges*.

HAAPALA, *Administrative Patent Judge*.

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

Petitioner requests rehearing of our Decision (Paper 10, “Dec.”) denying institution, under 35 U.S.C. § 325(d), of an *inter partes* review of claims 2–8 and 10–15 of U.S. Patent No. 5,523,791. Paper 11 (“Req. Reh’g”), 1. On rehearing, the burden of showing that the Decision should be modified lies with Petitioner, the party challenging the Decision. *See* 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 address in a motion, an opposition, or a reply.” *Id.* Petitioner contends that: (1) the Board overlooked evidence when it declined institution under § 325(d) because the obviousness ground presented was never considered, during original examination or otherwise (Req. Reh’g 2–7); and (2) the Board overlooked newly presented evidence that establishes claims 2–8 and 10–15 as obvious based on Russell and Intel User’s Manual (*id.* at 7–10). Petitioner does not challenge our Decision to deny institution of an *inter partes* review of claims 9 and 16 (Dec. 14). *See id* at 1.

In our Decision, we concluded that Petitioner’s obviousness challenges of claims 2–8 and 10–15 over Russell alone or in combination with Intel User’s Manual relied on the same or substantially the same prior art and arguments previously presented to the Office. Dec. 12. Petitioner argues that we overlooked that the Examiner never rejected the claims as obvious over Russell during prosecution, but rather rejected the claims as “anticipated” by Russell. Req. Reh’g 2–3. Petitioner asserts the Examiner’s comment in the Interview summary that newly added claims overcome Russell merely evidences consideration of *anticipation* for the newly added claims and there is no evidence the Examiner considered obviousness based on Russell. *Id.* at 3. Petitioner further contends that claim 5 (which later

issued as claim 2) differs from the original claims significantly in scope and content and introduced multiple additional “means-plus-function” limitations that never appeared in the original claims or specification. *Id.* at 3–5.

Petitioner’s assertion that the Examiner never considered Russell for obviousness, but rather only for anticipation, is speculative and is premised on the assumption that the Examiner blindly analyzed the reference for compliance with 35 U.S.C. § 102 while ignoring other statutory requirements of patentability such as non-obviousness under 35 U.S.C. § 103. Petitioner presents no persuasive argument or evidence to support that assumption. Our conclusion that Russell was substantially considered during the prosecution of the challenged claims (Dec. 11) is unaltered by Petitioner’s unpersuasive argument that the Examiner did not consider Russell for obviousness.

Furthermore, we disagree with Petitioner that the Examiner did not substantially consider Russell for the newly added claims. Our Decision noted that the Examiner Interview Summary evidences consideration by the Examiner of Russell for the newly added claims. Dec. 11. In particular, the Examiner stated “claims 5, 11, 12, and 18 also overcome Russell.” Ex. 1006, 52. Petitioner’s claim map of the differences between “newly added claim 5” to the original claims is immaterial because the Examiner explicitly indicated that Russell was considered for the limitations of this “newly added claim,” even though it has limitations that differ from the original claims. *See id.*

After concluding the same or substantially the same prior art or arguments were presented previously to the Office, our Decision determined it was appropriate to exercise our discretion to deny institution of these

grounds because Petitioner failed “to present any arguments distinguishing the Examiner’s prior consideration of Russell or to provide a compelling reason why we should readjudicate substantially the same prior art and arguments as those presented during prosecution and considered by the Examiner.” Dec. 12. Petitioner now newly argues that the Petition discusses and addresses teachings of Russell with respect to the “address generator means” limitation of claim 2 that are different from the teachings of Russell the Examiner applied. Req. Reh’g 7–8. Petitioner argues the “address generator means” limitation of claim 2 (old claim 5) was never considered over Russell and that the Petition used *Intel User’s Manual* to illustrate how a person of ordinary skill would understand how Russell meets the “address generator” limitation. *Id.* at 8–9.

But these arguments do not change our conclusion that substantially the same prior art was presented to, and considered by, the Office. Rather, Petitioner’s arguments endeavor to distinguish the Examiner’s prior consideration of Russell to provide a reason why we should readjudicate the same prior art. We decline to alter our decision to exercise our discretion to deny institution based on these new arguments. Moreover, we disagree with Petitioner’s assertion the Examiner did not consider Russell for the “address generator means.” The “address generator means” was present in “newly added claim 5” (issued claim 2) when the Examiner stated “claim[] 5 . . . also overcomes[s] Russell.” *See* Ex. 1006, 42–43, 52.

We conclude that Petitioner has not identified adequately any matter that we misapprehended or overlooked.

In view of the foregoing, it is:

ORDERED that Petitioner’s Request for Rehearing request is *denied*.

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