

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner

v.

PROXYCONN, INC.
Patent Owner

Case IPR2012-00026 (TLG)
Patent 6,757,717 B1

Before SALLY C. MEDLEY, SCOTT R. BOALICK, and THOMAS L.
GIANNETTI, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

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

INTRODUCTION

Petitioner Microsoft Corporation moves for rehearing and reconsideration of that portion of the Decision on Request for Inter Partes Review (“Decision”) denying Petitioner’s request for inter partes review of claims 11, 12, and 14 of United States Patent 6,757,717. Paper 17. For the reasons that follow, Petitioner’s motion is denied.

The applicable standard for this motion is set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. 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, opposition, or a reply.

BACKGROUND

Petitioner sought inter partes review of claims 1, 3, 10-12, 14, and 22-24 of the ’717 patent on September 18, 2012. Paper 6. The ’717 patent is directed to a system and method for data access in a packet switched network. For a fuller description of the technology of the ’717 patent, *see* Decision 2-6. The Petition challenged the enumerated claims as anticipated or obvious over several references, alone and in combination. See Petition 3.

The Board granted the Petition in part and instituted an inter partes review as to claims 1, 3, 10, and 22-24. Decision 26. As to claims 11, 12, and 14, however, the Board determined that the Petitioner had failed to establish a reasonable

likelihood of prevailing, and therefore denied the petition as to those claims. *Id.* Petitioner now seeks reconsideration of that denial.

Claims 11, 12, and 14 are each directed to an embodiment of the invention of the '717 patent that is illustrated in Figures 8, 9, and 10 and described, e.g., at col. 8, ll. 11-39, of the specification. In accordance with that embodiment, a receiver/computer receiving an auxiliary digest issues a “partial” signal to a sender/computer if the received auxiliary digest matches a digest stored in the receiver/computer’s cache memory. Col. 8, ll. 28-31. Upon receiving the “partial” signal the sender/computer sends the difference between the requested data object and the data object corresponding to the digest. *Id.* ll. 34-39. If a negative signal is received from the receiver/computer, the sender/computer sends the requested data object. *Id.* ll. 31-34. Receipt of a positive signal indicates that the data object was found in memory by the receiver/computer. *Id.* ll. 23-26.

Consistent with this description, the claims involved in this motion each recite the following method step:

...receiving a response signal from said receiver/computer at said sender/computer, said response signal containing a positive, partial or negative indication signal for said digital digest....

The Board’s decision construed this language in light of the specification as requiring the receiving of three signals (partial, positive, and negative) as necessary, rejecting Petitioner’s contention that the “partial” and “positive” signals are optional and thus entitled to “no patentable weight.” *See* Decision at 22-24. Because the Perlman, Yohe, and Santos references relied on by Petitioner fail to disclose receiving all these signals the Board denied Petitioner’s request as to those claims. Decision 24.

ANALYSIS

1. Claim Construction

Petitioner's main argument is that in construing the above "receiving" step of claims 11-12 and 14, the Board failed to apply the "broadest reasonable interpretation." Motion 3-4. Petitioner is incorrect. The broadest reasonable interpretation of a claim must be consistent with the specification. *See In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). Petitioner's contention that the alternative signals in the receiving step are "optional" conflicts with Figures 8-10 of the '717 patent and the accompanying written description in the specification discussed supra and at pages 4-6 and 21-22 of the Decision.

Petitioner's newly-cited authorities are unavailing. In *TiVo, Inc. v. EchoStar Communications Corp.*, 516 F.3d 1290, 1298 (Fed. Cir 2008), the Court concluded that the claim term "multitude of standards" includes not only broadcast standards of the type set forth in the claim, but also data standards of the type set forth in the written description portion of the specification. *EchoStar* thus does not support Petitioner's position; instead, it supports the view that claims must always be construed to be consistent with the specification. Petitioner's reliance on *Ex Parte Harris*, 2010 WL 3065978 (BPAI August 4, 2010), on rehearing 2011 WL 309487 (BPAI 2011), is likewise misplaced. This 2-1 decision is non-precedential and thus not binding on this panel. *See* PTAB Standard Operating Procedure (SOP) 2 (Rev. 7). And even if it were precedential, *Harris* would not support Petitioner as the claims there followed an "if ... then" format setting forth a series of conditional steps that led the majority to conclude that the conditions were "mutually exclusive." 2011 WL 309487 at *1. Here, the claim format is different from that in *Harris*, as the method steps are not conditional.

Alternatively, Petitioner contends that the broadest reasonable interpretation of the claims requires but a “single” response signal resulting from “one run or operation of the recited method.” Motion 5-6. We are not convinced by Petitioner’s argument. Petitioner cites nothing in the specification of the ’717 patent that leads to the conclusion that the claims are limited to “one run” of the claimed method. The patent, in fact, is directed to improving the efficiency and speed of data access in packet switched networks, where high data volume (and therefore many messages and responses) would be expected. ’717 patent, col. 1, ll. 61-65. A method limited to a single response would not achieve the stated improvement. Neither the ’717 patent itself nor the cited authorities therefore support Petitioner’s alternative claim construction, based upon its “one run” or other theories.

2. Figure 10

Petitioner suggests that including Figure 10 (showing the receiver) in the Decision was an error. Motion 6-7. It was not. The Decision refers to the embodiment of Figures 8-10, not just Figure 10. See Decision 21. Figure 10 was selected because it shows the three separate signals. In any case, as Petitioner recognizes, claims 11, 12, and 14 recite the receiver in the receiving step reproduced supra. There is no inconsistency between the Board’s construction of the claim language and the patent figures, as Petitioner suggests (Motion 7-8), or any uncertainty from the written description that the receiver/computer shown in Figure 9 must receive the three types of signals as shown. Motion 8. The patent figures support the Board’s construction, not Petitioner’s. See Decision 21-22. Petitioner’s contentions based on the patent figures and the Board’s construction of the term “receiver/computer” are without merit. Motion 7-8.

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