

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION and
HTC AMERICA, INC.,
Petitioner,

v.

INVT SPE LLC,
Patent Owner.

Case IPR2018-01556
Patent 7,206,587 B2

Before THU A. DANG, KEVIN F. TURNER, and BARBARA A. BENOIT,
Administrative Patent Judges.

DANG, *Administrative Patent Judge.*

DECISION
Patent Owner's Request for Rehearing
37 .F.R. § 42.71

I. INTRODUCTION

Petitioner filed a Request for Rehearing (Paper 12, “Req. Reh’g”) of our Decision (Paper 11, “Dec.”) denying institution of *inter partes* review of claim 4 of U.S. Patent No. 7,206,587 (Ex. 1001, “the ’587 patent”). In the Decision, we denied institution of a trial on Petitioner’s asserted ground that claim 4 is unpatentable under 35 U.S.C. § 103 as obvious over Padovani and Gils. Dec. 17. For the reasons stated below, Petitioner’s Request for Rehearing is *denied*.

II. ANALYSIS

When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The party requesting rehearing bears the burden of showing an abuse of discretion, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d).

Petitioner argues “the Decision misapprehended what the broadest reasonable interpretation (‘BRI’) of independent Claim 4 requires, by improperly reading in limitations found in Claim 3.” Req. Reh’g 1. Further, Petitioner argues that “the Board improperly disregarded part of Dr. Min’s testimony as allegedly ‘uncorroborated’ and ‘conclusory.’” *Id.* at 2.

In particular, Petitioner contends “under the BRI the coding device of Claim 4 does not require and has not been construed to require the use of multiple coding schemes.” *Id.* at 11. According to Petitioner, “the Board confused the requirements of Claim 4 with the limitations of Claim 3.” *Id.*

Thus, according to Petitioner, “Claim 4 is rendered obvious through the application of a single coding scheme,” wherein the Board erred “in overlooking HTC’s single coding scheme argument.” *Id.* at 12.

Petitioner then contends that “the Decision was clearly erroneous because the relationship between a bit’s position and its significance was well known and is a matter of common sense,” wherein “no expert testimony is required.” *Id.* at 12–13. According to Petitioner, “[b]ecause Dr. Min’s testimony merely confirmed what was well known and common sense, it should not have been disregarded, and Patent Owner’s unsupported, unconventional claim construction should not be given credence.” *Id.* at 13. Petitioner contends that “[t]here is no expert testimony in the record disputing Dr. Min’s testimony” (*id.*), and further, “no evidence exists in the ’587 Patent, Padovani, or Gils that teaches against this common understanding of ‘the most significant bit.’” *Id.* at 14. Further, “[t]he Petition used Gil’s teaching of better protecting higher order bits to support the motivation to provide greater protection for the decimal integer portion of the 3-bit DRC message than the decimal fraction portion” (*id.* at 15 (citing Pet. 32–33)), wherein “[t]he Board overlooked the Petition’s use of this teaching, focusing instead on Dr. Min’s alleged lack of corroborating evidence.” *Id.*

We have considered all arguments Petitioner set forth in the Request but do not find an abuse of discretion. In the Request, Petitioner fails to show a matter the Board overlooked or misapprehended.

Although Petitioner argues that “the Decision misapprehended what the broadest reasonable interpretation (‘BRI’) of independent Claim 4 requires” (Req. Reh’g 1), in our Decision, we did not provide any claim

construction. *See generally* Dec. As we noted in the Decision, “[t]he Petition does not assert any term in claim 4 . . . requires construction,” and “Patent Owner ‘does not believe that any claim terms require express construction to deny the Petition.’” Dec. 6 (citing Prelim. Resp. 13).

In our Decision, we addressed the arguments that Petitioner made in the Petition concerning the *motivation to combine* Padovani and Gils. Dec. 12–14. In particular, we addressed Petitioner’s own contention that “‘a POSITA would have been motivated to provide greater protection for certain bits . . . ,’ and thus, use ‘different coding schemes for the different parts.’” *Id.* at 13 (citing Pet. 33 (citing Ex. 1017 ¶ 132) (emphasis added)). As set forth in the Decision, *in response to Petitioner’s own contention* that it would have been obvious to use different coding schemes, we found that “Petitioner does not identify any passage or combination of passages in Padovani that teaches or suggests providing, or even the need to provide, greater protection for one decimal portion than the other decimal portion, let alone by using ‘different coding schemes for the different parts.’” *Id.* at 14 (citing Pet. 33).

Based on the foregoing discussion, Petitioner fails to show an overlooked or misapprehended material matter amounting to an abuse of discretion in determining Petitioner fails to show sufficiently that “one of ordinary skill in the art would have used Gil’s techniques to encode Padovani’s DRC message in the manner required by the claims.” Dec. 16–17.

As to Petitioner’s contention that “the Decision was clearly erroneous because the relationship between a bit’s position and its significance was well known and is a matter of common sense” (Req. Reh’g 12–13),

Petitioner is rehashing arguments previously presented without indicating a matter misapprehended or overlooked by the Board. Contrary to Petitioner's contention that the Board overlooked the Petition's use of "Gil's teaching of better protect higher order bits to support the motivation to provide greater protection for the decimal integer portion of the 3-bit DRC message than the decimal fraction portion" (*id.* at 15), we did consider the sections of Gil relied on Petitioner (Dec. 12–13), but found Petitioner's arguments unpersuasive.

We are also unpersuaded by Petitioner's contention that "the Board improperly disregarded part of Dr. Min's testimony as allegedly 'uncorroborated' and 'conclusory.'" Req. Reh'g 2. As we noted in the Decision, and as pointed out by Patent Owner, Petitioner's Declarant, Dr. Min's testimony "merely repeats the allegations of the Petition without any explanation or citation to any supporting or corroborating evidence." Dec. 15 (citing Prelim. Resp. 20). That is, "[t]here is no proffered evidence that it was well understood by a POSITA at the time that the leftmost bit in binary numbers, and specifically in the DRC message of Padovani, is the 'most significant bit.'" *Id.* 15–16 (emphasis added) (citing 37 C.F.R. § 42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight."); *In re Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004) ("[T]he Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations[.]")).

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