

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

SIMPLEAIR, INC.,
Patent Owner.

Case CBM2015-00020
Patent 8,601,154 B2

Before JAMES P. CALVE, JUSTIN T. ARBES, and TINA E. HULSE,
Administrative Patent Judges.

ARBES, *Administrative Patent Judge.*

DECISION
Petitioner's Request for Rehearing
37 C.F.R. § 42.71

Introduction

Petitioner filed a Request for Rehearing (Paper 12, “Req. Reh’g”) of our Decision (Paper 11, “Dec.”), dated May 19, 2015, not to institute a covered business method patent review of claims 1–4, 6–11, 13–17, 19–21, 24, 27, and 29–34 of U.S. Patent No. 8,601,154 B2 (Ex. 1001, “the ’154 patent”). Patent Owner filed an Opposition (Paper 13, “Opp.”), pursuant to our authorization provided to the parties by email on June 23, 2015. For the reasons stated below, Petitioner’s Request for Rehearing is *denied*.

Analysis

In determining whether to institute a covered business method patent review, the Board may “deny some or all grounds for unpatentability for some or all of the challenged claims.” 37 C.F.R. § 42.208(b). When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). “An abuse of discretion occurs if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors.” *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004). 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 contends that we abused our discretion in concluding that the information presented in the Petition (Paper 1, “Pet.”) did not establish that the ’154 patent qualifies as a “covered business method patent” under § 18(d)(1) of the Leahy-Smith America Invents Act, Pub. L. No. 112-29,

125 Stat. 284 (2011) (“AIA”). Req. Reh’g 1. First, Petitioner argues that we misapprehended the effect of Patent Owner’s statutory disclaimer of dependent claim 24 on parent independent claim 1. *Id.* at 4. According to Petitioner, the disclaimer of claim 24 removes it from consideration for trial, but does not “negate its role in a proper claim construction” of claim 1 for purposes of determining whether the ’154 patent is a covered business method patent. *Id.* at 4–8. Petitioner contends that under the doctrine of claim differentiation, claim 24 must be taken into account as evidence of the scope of claim 1, such that the “data blocks” recited in claim 1 should be interpreted to cover the “information relating to news, sports, financial markets, weather, an online chat, or an online forum” recited in dependent claim 24. *Id.* at 7–9.

As explained in the Decision, however, the basic deficiency in the Petition was that Petitioner provided no analysis of the language of claim 1 or explanation as to why the particular language of claim 1 meets the standard for covered business method patent eligibility. Dec. 11. Rather, Petitioner simply stated that the claims of the ’154 patent “overlap significantly” with unspecified claims of a related patent that previously was found eligible, without explaining why or how the claims allegedly overlap. *See id.* at 10–11; Pet. 6–7. The test for whether a patent is a covered business method patent is whether the patent “*claims* a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.” AIA § 18(d)(1) (emphasis added); 37 C.F.R. § 42.301(a).

Absent some analysis of the actual language of a claim, it is difficult to see how the test can be met.

Further, Petitioner's arguments as to how claim 1 should be interpreted were not made in the Petition and are inappropriate on rehearing, as we could not have misapprehended or overlooked something not explained adequately in the Petition. For example, Petitioner proposed interpretations for numerous claim terms in its Petition, but did not propose an interpretation for "data blocks" or argue that the '154 patent is a covered business method patent based on the "data blocks" limitations in claim 1. *See* Pet. 5–7, 14–19. A request for rehearing is not an opportunity to supplement a petition by making new arguments or proposing new claim interpretations. Similarly, in its Request for Rehearing, Petitioner cites for the first time dependent claims 19, 27, and 34 of the '154 patent, which recite the display of an "advertisement," and dependent claim 33, which recites similar limitations to claim 24, and argues that they "specify financial aspects" as well. *Req. Reh'g* 1–2, 4. None of these claims, however, were cited in the Petition as a basis for the '154 patent being a covered business method patent; Petitioner solely relied on claims 1 and 24. *See* Pet. 5–7. Therefore, we do not consider these new arguments as well.

Petitioner's arguments also ignore another important aspect of the Decision. Claim 1 recites only generic, context-neutral "data," without specifying the type or nature of the "data," and the Specification of the '154 patent supports such a broad scope. Dec. 12–13; *see* Ex. 1001, col. 8, ll. 9–28 ("The data, which can include but is not limited to stock quotes, weather, lotto, E-mail, etc. is then respectively parsed by parsers. . . . The present invention is not limited to the information sources or parsers

described herein. Rather, any type of information source and corresponding parser may be used.”). Consistent with other Board decisions based on similarly worded context-neutral claims, we determined that claim 1 does not recite an apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service. Dec. 12–13. Thus, even if considered, Petitioner’s new arguments regarding the scope of claim 1 are not persuasive because the claim recites only context-neutral “data.” See Opp. 3–5.

Second, Petitioner argues that Patent Owner engaged in gamesmanship by statutorily disclaiming dependent claim 24, and should not be rewarded for “[a]fter-the-fact claim manipulation techniques.” Req. Reh’g 9–12. Petitioner contends that in determining whether a patent is eligible for covered business method patent review, “the Board must consider the Petition and accompanying evidence according to the challenged claims *at the time* the Petition is filed” because a petitioner cannot anticipate what claims a patent owner might disclaim prior to institution. *Id.* at 11–12. Petitioner also suggests that we could have held Patent Owner’s statutory disclaimer in abeyance under 37 C.F.R. §§ 42.3(a) and 42.7(b), but acknowledges that the disclaimer is “immediately effect[ive for] enforcement” purposes. *Id.* at 12; see 37 C.F.R. § 1.321(a).

Petitioner’s arguments are not persuasive. Our rules permit a patent owner to file a statutory disclaimer with its preliminary response, and “[n]o post-grant review will be instituted based on disclaimed claims.” 37 C.F.R. § 42.207(e). Further, the decision whether to institute a covered business method patent review is based on the “claims” of the patent as they exist at the time of the decision, not as they may have existed at some previous time.

See 35 U.S.C. § 324(a). For example, where a reexamination certificate amending the claims of a patent issues subsequent to a petition but prior to institution, the Board's decision whether to institute is based on the claims of the patent as amended in the reexamination certificate. See *Eizo Corp. v. Barco N.V.*, Case IPR2014-00358, slip op. at 5 (PTAB July 23, 2014) (Paper 11); *GEA Process Eng'g, Inc. v. Steuben Foods, Inc.*, Case IPR2014-00051, slip op. at 2–3, 10–11 (PTAB Mar. 10, 2014) (Paper 14). We also note that, to the extent Petitioner was concerned about being unable to anticipate Patent Owner statutorily disclaiming claim 24, or believed some action from the Board would have been appropriate with respect to the statutory disclaimer, Petitioner could have contacted the Board and sought authorization to file a reply after Patent Owner filed its statutory disclaimer and Preliminary Response, but did not do so.

Third, Petitioner argues that we misapprehended or overlooked “two pieces of evidence” cited in the Petition. Req. Reh'g 13–14. Petitioner points to the “Prior Related Constructions” section of the Petition where it argues that “information source” in claim 1 should be interpreted to mean “one or more content or online service providers that provide data to the central broadcast server, such as an online source of news, weather, sports, *financial information*, games, personal messages, or emails.” *Id.* (citing Pet. 14–16). The “Prior Related Constructions” section of the Petition, however, appears in a different section seven pages after the section labeled “The '154 patent claims methods used in financial services.” See Pet. 5–7, 14. Petitioner does not argue in the standing section that the '154 patent is a covered business method patent based on Petitioner's proposed interpretation of “information source” or any other term. It is not for the

Board to attempt to piece together a petitioner's position based on other, unrelated arguments in a petition, particularly in circumstances like this where Petitioner includes a specific section devoted to covered business method patent eligibility. Again, a request for rehearing may not be used to bolster an initial petition with new arguments not explained sufficiently in a petition.

Petitioner also points to the following sentence from the Petition, which appears prior to Petitioner's discussion of the Specification of the '154 patent: "Here, the challenged claims are directed to generating data, identifying a user and transmitting data to a broadcast server." Req. Reh'g 13–14 (citing Pet. 6). We did not overlook this sentence. We reviewed all of Petitioner's contentions regarding the Specification and found them unpersuasive, particularly in view of the context-neutral nature of the "data" recited in claim 1. *See* Dec. 11–13. Mere disagreement with a decision is not a proper basis for rehearing when a party's arguments were considered and addressed in the decision.

Fourth, Petitioner argues that our determination regarding the context-neutral "data" recited in claim 1 is inconsistent with four other decisions of the Board. Req. Reh'g 14–15. We could not have misapprehended or overlooked any argument based on these decisions, however, as they were not cited in the Petition. Further, we noted in the Decision that other panels of the Board have found patents ineligible for covered business method patent review in similar circumstances. Dec. 13. Moreover, though, every determination of covered business method patent eligibility necessarily will be based on the particular claims and arguments presented in the respective proceeding. Thus, we are not persuaded that our

determination as to the '154 patent, based on the particular facts of this proceeding, was an abuse of discretion.

Fifth, Petitioner states in its Request for Rehearing that “[a]s a matter of first impression, this disclaimer of dependent claims to avoid CBM review warrants expanded panel review.” Req. Reh’g 3. A panel does not have authority to expand a panel; only the Chief Judge, acting on behalf of the Director, may act to expand a panel. See Standard Operating Procedure 1, rev. 14 § III (PTAB May 8, 2015). In this case, the suggestion to expand the panel has been considered, but is not adopted.

Petitioner has not carried its burden of demonstrating that we misapprehended or overlooked any matters argued in the Petition. As such, Petitioner has not shown an abuse of discretion in the Decision not to institute a covered business method patent review.

In consideration of the foregoing, it is hereby:

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

CBM2015-00020
Patent 8,601,154 B2

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