

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNITED STATES DEPARTMENT OF HOMELAND SECURITY,
Petitioner,

v.

LARRY GOLDEN,
Patent Owner.

Case IPR2014-00714
Patent RE43,990 E

Before LORA M. GREEN, JON B. TORNQUIST, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

CHERRY, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71(d)

Larry Golden ("Patent Owner") timely filed a request for rehearing ("Rehearing Request" or "Request") of our Final Written Decision (Paper 35, "Final Decision" or "Final Dec.") granting-in-part and denying-in-part Patent Owner's non-contingent motion to amend. Paper 36 ("Req.

Reh’g”).¹ In particular, the Request seeks rehearing of the portion of the Final Decision denying Patent Owner’s motion to amend U.S. Patent No. RE43,990 E (Ex. 1001, “the ’990 patent”) to add substitute claims 154–156. *Id.* at 2–3. For the reasons given below, we deny the Rehearing Request.

I. LEGAL STANDARDS

“A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board.” 37 C.F.R. § 42.71(d). “The burden of showing [the] decision should be modified lies with the party challenging the decision.” *Id.* The request for rehearing “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, an opposition, or a reply.” *Id.*

II. ANALYSIS

In our Final Decision, we granted Patent Owner’s non-contingent motion to cancel claims 11, 74, and 81 of the ’990 patent, which were the only claims challenged in this *inter partes* review. We also denied Patent Owner’s non-contingent motion to amend the ’990 patent to add substitute claims 154–156. In particular, we found that Patent Owner had failed to carry Patent Owner’s burden of showing entitlement to the amendment for

¹ Patent Owner sent two emails to the Board on October 2, 2015 and October 11, 2015 arguing that the Board erred in rejecting Patent Owner’s motion to amend. In view of Patent Owner’s *pro se* status, we offered to treat those emails collectively as a request for rehearing. Reh’g Req. 3. In an email on October 24, 2015, Patent Owner accepted that offer. *Id.* at 2–3. Thus, we treat Patent Owner’s October 2, 2015 and October 11, 2015 emails collectively as a request for rehearing. We have entered these emails as a captioned document in the record as Paper 36. We also have entered certain papers attached to the October 2, 2015 email as Exhibits 3008 and 3009 and the paper attached to the October 11, 2015 email as Exhibit 3010.

three independent reasons: (1) substitute claims 154–156 are impermissibly broader than the claims they replaced; (2) Patent Owner failed to show written description support for substitute claims 154–156 as a whole; and (3) Patent Owner failed to show that claims 154–156 were patentable over the prior art of record. Final Dec. 15–21 (improper broadening), 21–22, (written description), 22–31 (prior art of record). Therefore, to succeed on this Rehearing Request, Patent Owner must show that we misapprehended or overlooked matters in reaching each of these determinations. Patent Owner has not done so. We address Patent Owner’s arguments in detail below.

A. Improper Broadening

In the Rehearing Request, Patent Owner argues:

When the Board agreed with the Petitioner, the Examiner of the ‘990 patent, and the Patent Owner that the entire genus of “monitoring equipment” and “communication devices” includes as species cell phones and smartphones, the support for an April 5, 2006 priority date had already been established. Therefore, when the Board writes in its “Final Written Decision”, pg. 15: “to remove any matter in the claims supported only by the disclosure added in the ‘573 application, so that the claims can receive the April 5, 2006 priority date of the ‘118 application” is not true.

Reh’g Req. 4.

We initially note that this argument (and the supporting arguments that appear on Reh’g Req. 4–5) appears to be directed at our decision to institute review on cancelled claims 11, 74, and 81. This and other complaints about our decision to institute review of claims 11, 74, and 81 are not persuasive of error because Patent Owner cancelled claims 11, 74, and 81, so they are no longer at issue in this proceeding. As we explained to

Patent Owner (*see* Paper 23, 2–4; Paper 29, 2; Ex. 1025, 3–10), a non-contingent motion to amend is, in essence, an abandonment of claims 11, 74, and 81, and he bears the burden of showing newly presented claims 154–156 are patentable. If Patent Owner believed that Petitioner failed to show claims 11, 74, and 81 were unpatentable or that our priority date determination for those claims was incorrect, Patent Owner could have filed a contingent motion to amend.

In any event, this priority date argument does not contain any reason why our determination that substitute claims 154–156 are broader in scope than cancelled claims 11, 74, and 81 that they seek to replace was in error. *Reh’g* Req. 4–5. To the extent that Patent Owner does contest our finding that the claims are broader in scope, we do not find it persuasive because Patent Owner does not show amending a claim to replace a particular species with an entire genus would not be broadening. Thus, this argument regarding priority date does not persuade us that we erred in denying Patent Owner’s motion to amend.

Patent Owner goes on to argue that “[t]he Patent Owner was aware and made all claim amendments in accordance to a clause in the general rule of Broad[en]ing that allows for the justifiable deviation from the general rule if there are adequate and persuasive explanations to justify a ‘special circumstance.’” *Id.* at 5. Patent Owner provides no citation for this “clause in the general rule . . . that allows for justifiable deviation from the general rule,” and we are not aware of such a rule in the context of claim amendments in *inter partes* reviews. Indeed, 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121, which govern amendments, contain no such exception. Moreover, even if such an exception existed, Patent Owner made no

arguments in its Patent Owner Response or Motion to Amend that such an exception should apply, so we could not misapprehended or overlooked them.

To the extent that Patent Owner submits that we “coerced” Patent Owner into filing a motion to amend or “advised” him to do so, we note that, as the record reflects (Paper 23, 2–3), Patent Owner filed the motion to amend without ever discussing the motion with the Board. We never advised Patent Owner that a motion to amend was the proper course in this proceeding, and repeatedly warned Patent Owner of the difficulties presented by, and consequences that result from, a non-contingent motion to amend. *See* Paper 23, 2–4; Paper 29, 2; Ex. 1025, 3–10.

B. Lack of Written Description Support

Patent Owner argues that we should also excuse Patent Owner’s failure to identify written description support for the entire claim because of the “special circumstances” discussed above. *Reh’g* Req. 2–3. Without determining whether such an exception exists for the requirement of providing written description support for the entire claim, Patent Owner fails to identify anywhere in the Patent Owner Response or Motion to Amend where this argument was raised. Because the argument was not raised, we could not have misapprehended or overlooked it. Thus, we determine that Patent Owner has failed to show that we erred in our determination that the Motion to Amend failed to show written description support for the claim as a whole.

C. Failure to Show Patentability Over the Prior Art of Record

Patent Owner argues that the Board erred in determining that Patent Owner failed to meet the burden of showing that claims 154–156 were

patentable over the prior art of record for three reasons. Reh’g Req. 7–9. First, Patent Owner argues that Petitioner only introduced Mostov² as prior art under § 102(b) based on a June 6, 2008 priority date. *Id.* at 7–8. Patent Owner argues that Petitioner never alleged that Mostov was prior art under § 102(e). *Id.* This argument does not persuade us that our determination was in error because the burden of showing patentability was on Patent Owner. Mostov unambiguously has a non-provisional filing date that is earlier than the priority date of April 5, 2006 that Patent Owner argued in the Motion to Amend. *See* Paper 26, 2 (arguing for an April 5, 2006 filing date). Thus, the burden was on Patent Owner to show why Mostov did not render the claim unpatentable. *See Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1304 (Fed. Cir. 2015); *see also* 37 C.F.R. § 42.20(c) (movant bears burden of showing entitlement to relief). Patent Owner failed to do so.

Second, Patent Owner now argues that claims 154–156 are entitled to a November 26, 2004 priority date, which is before Mostov’s filing date and provisional date. Reh’g Req. 8–9. Patent Owner does not direct us to where he made this argument in the Patent Owner Response, Motion to Amend, or Reply. Thus, Patent Owner has not demonstrated that we misapprehended or overlooked his argument. Moreover, even if we were able to consider it for the first time on rehearing, Patent Owner fails to attach the complete copy of the Disclosure Document (*see* Ex. 3009), let alone show how the Disclosure Document actually supports claims 154–156, such that the substitute claims are entitled to the earlier filing date. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1379–80 (Fed. Cir.

² Mostov, US 2006/0181413 A1, published Aug. 17, 2006, filed January 30, 2006.

2015) (discussing what is required to meet the burden of showing a claim is entitled to an earlier priority date). Thus, we are not persuaded that we overlooked or misapprehended Patent Owner's argument with respect to entitlement to the November 26, 2004 priority date.

Finally, Patent Owner argues "it is difficult, if not impossible, for someone who is examining the claims for anticipation to establish anticipation without examining each and every element of the broader claims." Reh'g Req. 9. Patent Owner further argues that "Mostov has not identified a single, 'communication device', 'multi-sensor detection device', or a single piece of monitoring equipment that comprises all the elements of any of the claims." *Id.* Patent Owner continues that "Mostov is all over the place and is combining elements to justify anticipation." *Id.* We have reviewed the disclosure of Mostov and Patent Owner's arguments and, respectfully, disagree with Patent Owner's assessment of the reference. Mostov is unambiguous that Figures 1, 3, and 22 are all part of a single embodiment. See Ex. 1003 ¶ 40 ("Fig. 22 shows a diagrammed depiction of one exemplary Network Operations Center depicted in Fig. 1."), 46 ("FIG. 3 is a block diagram illustrat[ing] one exemplary CSD 300. CSD 300 may, for example, represent CDS 140 of Fig. 1."). Thus, a single embodiment disclosed in Mostov meets the limitations of the substitute claims. For example, as we explained with respect to claim 154, Mostov discloses in Figures 1, 3, and 22, a PC ("[a] communication device . . . for monitoring products") at monitoring site (NOC 170 (or 2200)) that can communicate with CSDs ("multi-sensor detection device") via cellular or satellite communications, the CSDs include sensors and can be activated or deactivated by the PC at the monitoring site (Ex. 1003 ¶ 113). Final Dec.

29; *see also id.* at 29–31 (similar analysis for claims 155 and 156). Patent Owner does not explain with any specificity how this analysis is in error. Thus, we are not persuaded that we erred in finding that Patent Owner failed to demonstrate the patentability of claims 154–156 over the prior art of record.

D. Conclusion

We have reviewed Patent Owner’s other arguments and find them to be without merit. For the reasons given, Patent Owner has not shown anything that we misapprehended or overlooked in our Final Decision and that our Final Decision denying Patent Owner’s Non-Contingent Motion to Amend the ’990 patent to add substitute claims 154–156 was in error.

III. ORDER

Accordingly, it is:

ORDERED that Patent Owner’s Request for Rehearing (Paper 36) is *denied*.

IPR2014-00714
Patent RE43,990 E

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