

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUGHES NETWORK SYSTEMS, LLC and
HUGHES COMMUNICATIONS, INC.,
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner.

Case IPR2015-00081
Patent 8,284,833 B2

Before KALYAN K. DESHPANDE, GLENN J. PERRY, and
TREVOR M. JEFFERSON, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

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

I. INTRODUCTION

Hughes Network Systems, LLC and Hughes Communications, Inc. (collectively, “Petitioner”) filed a Request for Rehearing of the Board’s Decision (Paper 18, “Dec.”) , dated April 27, 2015, which denied institution of *inter partes* review of claims 1, 2, 4, 6, 8, 9, 10, 11, and 13 of U.S. Patent No. 8,284,833 B2 (Ex. 1007, “the ’833 patent”). Paper 19 (“Req. Reh’g”). In general, Petitioner contends that we should have instituted review of claims 1, 2, 4, 6, 8, 9, 10, 11, and 13 on the grounds of anticipation by McKay Software,¹ and obviousness over McKay Software and Kernighan² and over the ’710 patent³ and Hennessy.⁴ Req. Reh’g 3-7. For the reasons stated below, Petitioner’s request for rehearing is *denied*.

II. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co. Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). The request must identify specifically all matters that the dissatisfied party believes that the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

¹ McKay Ra.c Software File (Ex. 1019) (“McKay Software”).

² Kernighan et al., *THE C PROGRAMMING LANGUAGE*, Prentice Hall Software Series, 1988 (Ex. 1067, “Kernighan”).

³ U.S. Patent No. 7,116,710 B1 (Ex. 1001, “the ’710 patent”).

⁴ Hennessy et al., *COMPUTER ORGANIZATION & DESIGN, THE HARDWARE / SOFTWARE INTERFACE*, Morgan Kaufmann Publishers, Nov. 8, 1994 (Ex. 1020, “Hennessy”).

III. DISCUSSION

In our Decision, we determined that Petitioner did not “set forth a persuasive analysis supported by factual evidence in concluding that the ’710 patent specification does not support the ’833 claims, and, therefore, the ’833 claims are not entitled to the priority claimed by the ’710 patent.” Dec. 8. Specifically, we agreed with California Institute of Technology (“Patent Owner”) that Petitioner has failed to “precisely identify what ‘claim limitations’ or ‘elements’ of the ’833 patent claims are unsupported by the ’710 patent specification.” *Id.* (citing Paper 13, 17–18). Accordingly, we determined that the ’710 patent does not qualify as prior art. *Id.* at 10. We also determined that Dr. David J. MacKay testifies that the MacKay Software was “available to the public for download at least by December 9, 2006” and the ’833 patent, as a continuation of the ’710 patent, claims a priority date of at least May 18, 2001, and, therefore, the MacKay Software does not qualify as prior art. *Id.* at 9–10 (quoting Ex. 1060 ¶ 83).

Petitioner argues that we misapprehended or overlooked Petitioner’s discussion of specific claim limitations in its Petition. Req. Reh’g 4. Petitioner directs us to several passages in the Petition and several passages in the Declaration of Henry D. Pfister. *Id.* We are not persuaded by Petitioner that we misapprehended or overlooked these passages in the Petition in rendering our Decision. For example, Petitioner argues that the Petition discussed “[t]he ’710 patent does not disclose that the repeated bits are stored and read from the first set of memory locations,’ as recited by claim 8.” *Id.* (citing Pet. 49). First, Petitioner’s argument demonstrates that the phrase “as recited by claim 8” is absent in the Petition. Second, we had considered this argument and determined that this argument does not clearly specify what “claim limitations” or “elements” of

claims 1 and 8 are not supported by the '710 patent specification. Dec. 8. Even adding the mere phrase “as recited by claim 8” does not identify what “claim limitations” or “elements” of claim 8 are not supported by the '710. Petitioner provides several other examples that are deficient for the same reasons. Accordingly, we do not agree with Petitioner that we misapprehended or overlooked Petitioner’s argument. Furthermore, a mere allegation that a “claim limitation” or “element” is not supported by the '710, without a persuasive analysis supported by factual evidence, is not persuasive.

Petitioner further argues that the “reasonable likelihood” requirement is “flexible” and does not require Petitioner to prove a negative at the outset before trial is instituted. Req. Reh’g 5. We are not persuaded that we misapprehended the “reasonable likelihood” requirement. 35 U.S.C. § 314 (a) requires that Petitioner must demonstrate a reasonable likelihood it would prevail in showing the unpatentability of at least 1 of the challenged claims in order to institute *inter partes* review of the challenged claims. As discussed above, we determined that Petitioner has not demonstrated a reasonable likelihood it would prevail. We are not persuaded that there is a “flexibility” in 35 U.S.C. § 314(a) such that Petitioner does not have to demonstrate a reasonable likelihood it would prevail. Accordingly, we are not persuaded by Petitioner’s argument that we misapprehended the “reasonable likelihood” requirement set forth by 35 U.S.C. § 314(a).

We are also not persuaded by Petitioner’s argument that “[f]or the '833 claims to be entitled to priority, the Board would need to find that these undisclosed elements are described in the '710 patent disclosure inherently or using some other terminology.” Req. Reh’g 6–7. Petitioner also argues that Patent Owner “has not shown where these elements are disclosed in the priority

document” and relies on “inherency.” Req. Reh’g 8–9. As discussed above, 35 U.S.C. § 314(a) requires that Petitioner demonstrated a reasonable likelihood it would prevail in showing the unpatentability of a challenged claim. In other words, the burden of proof lies with Petitioner. The Board and Patent Owner are not required to demonstrate a reasonable likelihood that the ’710 patent specification supports the claim elements of the ’833 patent.

We are also not persuaded by Petitioner’s argument that the our Decision for IPR2015-00081 is inconsistent with our Decision Denying Institution for IPR2015-00061 because we determined that Ping⁵ does not inherently disclose elements of the ’833 claims. Req. Reh’g 8–9. As discussed above, Patent Owner is not required to demonstrate the patentability of the ’833 claims, and, accordingly, we did not misapprehend or overlook this argument.

In conclusion, Patent Owner fails to demonstrate that we misapprehended or overlooked Petitioner’s arguments regarding claims 1, 2, 4, 6, 8, 9, 10, 11, and 13 in our Decision.

IV. ORDER

Accordingly, it is hereby

ORDERED that Petitioner’s request for rehearing is *denied*.

⁵ L. Ping et al., “Low Density Parity Check Codes with Semi-random Parity Check Matrix,” ELECTRONIC LETTERS, THE INSTITUTION OF ELECTRICAL ENGINEERS, Jan. 7, 1999 (IPR2015-00061 Ex. 1014, “Ping”).

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