

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION,
Petitioner,

v.

CELLPORT SYSTEMS, INC.,
Patent Owner.

Case IPR2015-01422
Patent 5,732,074

Before JAMESON LEE, JAMES B. ARPIN, and SCOTT C. MOORE,
Administrative Patent Judges.

MOORE, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Toyota Motor Corporation (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–21 (Paper 2, “Pet.”) of U.S. Patent No. 5,732,074 (Ex. 1001; “the ’074 Patent”). Cellport Systems, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

On this record and for the reasons discussed below, we do not institute an *inter partes* review of any claim of the ’074 Patent. The Petition is *denied*.

II. BACKGROUND

A. *Related Proceedings*

This is the second petition for *inter partes* review of the ’074 Patent filed by Petitioner. On February 2, 2015, Petitioner filed its Petition in IPR2015-00633, seeking *inter partes* review of claims 1–21 of the ’074 Patent. IPR2015-00633, Paper 2. On August 14, 2015, we instituted an *inter partes* review as to claims 12–21 of the ’074 Patent. IPR2015-00633, Paper 11.

The ’074 Patent is also the subject of two patent infringement lawsuits filed by Patent Owner: *Cellport Systems, Inc. v. Toyota Motor Sales, U.S.A., Inc.*, Case No. 14-cv-1632 (D. Colo.); and *Cellport Systems, Inc. v. BMW of North America, LLC*, Case No. 14-cv-1631 (D. Colo.). Pet. 2; Paper 5.

B. The '074 Patent

The '074 Patent is directed generally to facilitating the communication of information between a remote computer and a vehicle. Ex. 1001, Abstract. For example, the '074 Patent describes a communication system that is compatible with standardized network communication links, such as the Internet and a controller area network used in vehicles. *Id.* The system uses a controller inside the vehicle to facilitate communication between the remote computer (which uses, e.g., an Internet-based communication link) and the controller area network used within the vehicle. *Id.*

Figure 1, reproduced below, illustrates an embodiment of the claimed subject matter.

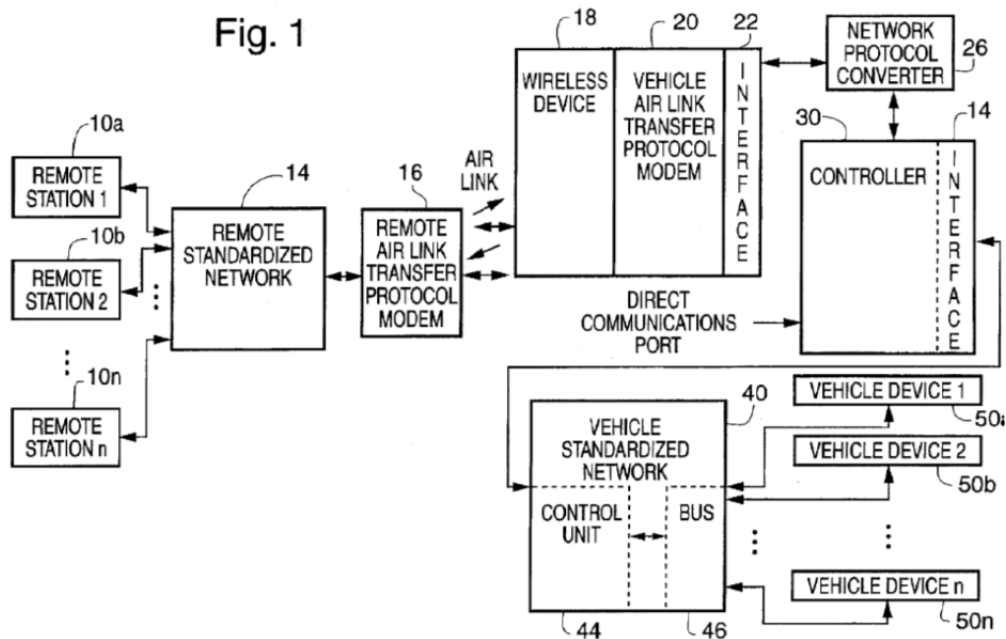


Figure 1 is a block diagram that depicts the general components of an apparatus for bi-directional communication between one or more remote stations 10a–10n and a vehicle. Ex. 1001, 5:26–29, 41–43. The remote

stations communicate by way of a standardized remote network communications link 14, such as the Internet. *Id.* at 5:49–62. The remote stations transmit information to, and receive information from, the vehicle over an airlink by way of remote airlink transfer protocol modem 20, which may use a cellular digitized packet data (“CDPD”) configuration. *Id.* at 5:63–6:8.

Wireless device 18 is located at the vehicle and also has the capability to receive and transmit information via the airlink. Ex. 1001, 6:3–5.

Wireless device 18 is associated operatively with modem 20, and communicates with controller 30 (also contained within the vehicle) through network protocol converter 26 using device interface 22. *Id.* at 6:5–14.

Controller interface 34 (misabeled “14” in Figure 1) electrically links controller 30 with vehicle standardized network 40. *Id.* at 6:37–39. Like remote standardized network 14, vehicle standardized network 40 is an established and previously developed type of network. *Id.* at 6:45–47.

Vehicle standardized network 40 interfaces with certain components in a vehicle (i.e., physical vehicle devices 50a–50n), and provides message and data-handling functions associated with sending and receiving data to or from physical vehicle devices 50a–50n. *Id.* at 6:39–50.

Figure 2 of the '074 Patent further illustrates an embodiment of the claimed subject matter and is reproduced below.

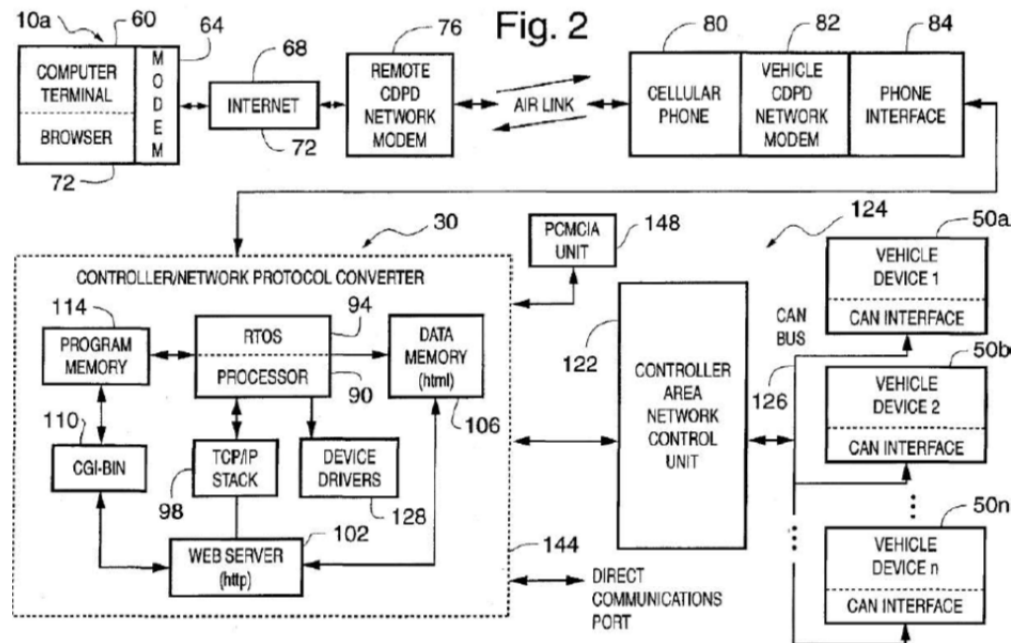


Figure 2 is a detailed block diagram that illustrates greater details of a particular embodiment of the apparatus depicted in Figure 1. Ex. 1001, 5:29–30, 7:23–25, Fig. 2. In this embodiment, remote station 10a communicates with modem 76 using the Internet 68 (the standardized remote network communications link). *See id.* at 7:25–36. Controller 30 communicates with physical vehicle devices 50a–50n via controller area network 124 (the vehicle standardized network), and controller area network 124 includes control network 122 and bus 126. *See id.* at 10:10–50. In this embodiment, the network protocol converter (which was depicted as a separate component in Figure 1) is integrated into controller 30. *See id.* at 8:1–8, 24–29, Fig. 2. Controller 30 also includes processor 90 and web server 102. *Id.* Web server 102 is a commercially available Internet-related product that services information related requests in http (hypertext

transmission protocol) format. *Id.* at 8:40–45. Controller 30 further includes CGI-bin (common gateway interface-binary) 110, which acts as a link between the web server and a number of short executable programs stored in program memory 114. *Id.* at 8:58–63.

C. Illustrative Claim

Challenged claims 1, 3, 4, 5, 7, 12, 16, and 21 are independent. Each of the remaining challenged claims depends, directly or indirectly, from one of these independent claims. Claim 1 is illustrative and is reproduced below.

1. An apparatus for information transmission involving one or more remote stations and a vehicle, comprising:
 - at least a first remote station including computer means located at a distance from a vehicle;
 - a wireless device for location in the vehicle for use in sending and receiving information including data relative to said first remote station over an airlink;
 - a plurality of different vehicle devices associated with the vehicle and with each of said vehicle devices for at least one of receiving and sending said information;
 - controller means including processing means in the vehicle for controlling the sending and receiving of said information using said wireless device between said first remote station and the vehicle, said controller means further including first standard network communication means for use in presenting information for transmission over the airlink in a first format that is acceptable to a first standardized network that includes the airlink, wherein said first network communication means enables said information to be provided to multiple users that utilize different makes of communication equipment, different processing hardware and different applications software executable by said processing means of said controller

means, said first standard network communication means including a web server in the vehicle for responding to a plurality of service related requests and providing said information in said first format for transmission to said computer means at said first remote station using said wireless device; and

a second standard network communication means, different from said first standard network communication means, in communication with said controller means for presenting information in a second format that is acceptable to a second standardized network, with said second standardized network communication means communicating with said vehicle devices for sending and receiving said information relative thereto and in which said controller means enables said information to be properly communicated between said first and second standardized networks.

Ex. 1001, 14:55–15:27.

D. References Relied Upon

Petitioner alleges that the challenged claims are unpatentable over the following references:

References	Exhibit Nos.
Jonathan Magid et al., THE WEB SERVER BOOK, TOOLS & TECHNIQUES FOR BUILDING YOUR OWN INTERNET INFORMATION SITE (Ventana Press, 1 st ed. 1995) (“Magid”)	1007
Y. U. Cao et al., <i>A Remote Robotics Laboratory on the Internet</i> (UCLA Commotion Lab. 1995) (“Cao”)	1019
CAN Specification, Version 2.0 (Robert Bosch GmbH 1991) (“CAN”)	1023
US 5,309,351 (filed Sept. 2, 1992, issued May 3, 1994) (“McCain”)	1029

US 4,658,509 (filed Sept. 12, 1985, issued Apr. 21, 1987) (“Juengel”)	1030
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E. Asserted Grounds of Unpatentability

References	Statutory Basis	Challenged Claims
Cao and CAN	35 U.S.C. § 103	21
Cao, CAN, and Magid	35 U.S.C. § 103	1–7, 9, 10, 12, 13, and 16–19
Cao, CAN, Magid, and McCain	35 U.S.C. § 103	8 and 15
Cao, Magid, and Juengel	35 U.S.C. § 103	11, 14, and 20

III. ANALYSIS

A. Claim Construction

1. Claim Construction Standard

The’074 Patent will expire on January 16, 2016, which is before any final decision likely would be issued. Pet. 10; Prelim. Resp. 9. Both parties have proposed that the claims be construed in accordance with the standard used by U.S. district courts and set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (en banc). Pet. 9–10; Prelim. Resp. 9.

Pursuant to 37 C.F.R. § 42.100(b), “[a] claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” But here, given the patent’s pending expiration, we will analyze Petitioner’s arguments through the lens of the claim construction standard that will apply to any final written decision. Thus, we construe the claims in accordance with the standard set

forth in *Phillips*.¹ 37 C.F.R. § 42.5(b); cf. *In re Rambus Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012) (“While claims are generally given their broadest possible scope during prosecution, the Board’s review of the claims of an expired patent is similar to that of a district court’s review.”) (internal citation omitted).

“In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). The words of a claim generally are given their ordinary and customary meaning, which is the meaning the term would have to a person of ordinary skill at the time of the invention, in the context of the entire patent including the specification. *See Phillips*, 415 F.3d at 1312–13. Claims are not interpreted in a vacuum but are a part of and read in light of the specification. *See Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116 (Fed. Cir. 1987). Although it is improper to read a limitation from the specification into the claims, the claims still must be read in view of the specification. *See Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1347 (Fed. Cir. 2004).

2. “controller means”; “processing means”

Each of independent claims 1, 3, 4, 5, and 7 recites a “*controller means* including *processing means* in the vehicle for controlling the sending

¹ Our constructions of the disputed claim terms set forth below likely would have been the same had we applied broadest reasonable interpretation standard.

and receiving of said information using said wireless device between said first remote station and the vehicle” (emphasis added). Because the claim terms “controller means” and “processing means” include the word “means,” they are presumptively means-plus-function claim limitations under 35 U.S.C. § 112, ¶ 6,² and would be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015) (en banc). This presumption, however, “can be rebutted if the evidence intrinsic to the patent and any relevant extrinsic evidence so warrant.” *Personalized Media Commc’ns, LLC v. Int’l Trade Comm’n*, 161 F.3d 696, 704 (Fed. Cir. 1998).

The parties propose the following constructions for these claim terms (see Pet. 10–11; Prelim. Resp. 13–15):

² Paragraphs 1 through 6 of 35 U.S.C. § 112 were replaced with §§ 112(a) through 112(f) when § 4(c) of the Leahy-Smith America Invents Act (“AIA”) took effect on September 16, 2012. Because the patent application resulting in the ’074 Patent was filed before the effective date of the AIA, we will refer to the pre-AIA version of 35 U.S.C. § 112.

Claim Term	Petitioner's Construction	Patent Owner's Construction
controller means	35 U.S.C. § 112, ¶ 6, claim limitation. <u>Identified Function:</u> Controlling the sending and receiving of said information using said wireless device between said first remote station and the vehicle. <u>Corresponding Structure:</u> Processor 90, TCP/IP stack 98, data memory 106, and program memory 114.	<i>Not</i> a 35 U.S.C. 112, ¶ 6, claim limitation. “A controller”
processing means	35 U.S.C. § 112, ¶ 6, claim limitation. <u>Identified Function:</u> Processing. <u>Corresponding Structure:</u> A microprocessor.	35 U.S.C. § 112, ¶ 6, claim limitation. <u>Identified Function:</u> Controlling the sending and receiving of said information using said wireless device between said first remote station and the vehicle. <u>Corresponding Structure:</u> Processor 90 in conjunction with real time operating system 94.

Patent Owner argues that the presumption that the “controller means” is a means-plus-function limitation is overcome because this limitation lacks an associated function. Prelim. Resp. 13. We agree. The grammatical structure of the claim and, in particular, the fact that the functional language

cited by Petitioner appears immediately after the recitation of the “processing means” evidences an intent to associate this functional language with the “processing means” claim limitation. Thus, for purposes of this Decision, we construe “processing means” as a means-plus-function claim limitation having a recited function of “controlling the sending and receiving of said information using said wireless device between said first remote station and the vehicle.”

“Structure disclosed in the specification qualifies as ‘corresponding structure’ if the intrinsic evidence clearly links or associates that structure to the function recited in the claim.” *Williamson*, 792 F.3d at 1352. The Specification of the ’074 Patent indicates that the sending and receiving of vehicle information between the remote station and the vehicle is controlled by processor 90 in conjunction with real time operating system 94. *See* Ex. 1001, 8:1–23, 13:54–56. Data memory 106 is not linked clearly to the recited function because data memory 106 merely stores information, and does not control the sending and receiving of information. *See id.* 8:45–58, 9:31–45, 10:58–64, 13:8–10, 23–26. Thus, the structure in the Specification that corresponds to the “processing means” is “processor 90 in conjunction with real time operating system 94.”

Despite the rebuttable presumption, we do not construe “controller means” as a means-plus-function claim limitation. The presumption is overcome because the claim language does not link the “controller means” to a specific recited function. *See York Prod., Inc. v. Cent. Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1574 (Fed. Cir. 1996) (“Without a ‘means’ sufficiently connected to a recited function, the presumption in use of the word ‘means’ does not operate.”). In addition, the presumption is overcome

when the claim specifies detailed structure sufficient to perform any recited or implicit function, e.g., controlling. *See TriMed, Inc. v. Stryker Corp.*, 514 F.3d 1256, 1259–60 (Fed. Cir. 2008) (“Sufficient structure exists when the claim language specifies the exact structure that performs the functions in question without need to resort to other portions of the specification or extrinsic evidence for an adequate understanding of the structure.”); *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1376 (Fed. Cir. 2003). Each of independent claims 1, 3, 4, 5, and 7 recites that the “controller means” *includes* the “processing means” and the “first standard network communication means.” As discussed herein, the processing means and the first standard network communication means are means-plus-function claim limitations that are defined in terms of specific structures disclosed in the Specification. Moreover, the recited “controller” is also a structure that is sufficient to perform any recited or implicit function of the “controller means.” The rebuttable presumption also is overcome because the controller means claim limitation is associated with these structures. Thus, in accordance with the ordinary and customary meaning of the claim language, and consistent with the Specification (*see* Ex. 1001, 2:66–3:29, 6:11–37, 8:1–45), for purposes of this Decision, we construe “controller means” as “a controller.”

3. “first standard network communication means”

Each of independent claims 1, 3, 4, 5, and 7 also recites a “controller means further including *first standard network communication means* for use in presenting information for transmission over the airlink in a first format that is acceptable to a first standardized network that includes the

airlink” (emphasis added). The parties propose the following constructions for the “first standard network communication means” claim limitation (see Pet. 11; Prelim. Resp. 15–17):

Claim Term	Petitioner’s Construction	Patent Owner’s Construction
first standard network communication means	35 U.S.C. § 112, ¶ 6, claim limitation. <u>Identified Function:</u> Presenting information for transmission over the airlink in a first format that is acceptable to a first standardized network that includes the airlink. <u>Corresponding Structure:</u> A CDPD network interface or two-way paging interface in conjunction with a controller.	35 U.S.C. § 112, ¶ 6, claim limitation. <u>Identified Function:</u> Use in presenting information for transmission over the airlink in a first format that is acceptable to a first standardized network that includes the airlink. <u>Corresponding Structure:</u> Network protocol converter 26.

The proper function associated with a means-plus-function limitation is the function explicitly recited in the claim. *In re Teles AG Informationstechnologien*, 747 F.3d 1357, 1367–68 (Fed. Cir. 2014) (“[t]he statute does not permit limitation of a means-plus-function claim by adopting a function different from that explicitly recited in the claim”) (citation omitted). Each of independent claims 1, 3, 4, 5, and 7 recites the

following function for the first standard network communication means: “use in presenting information for transmission over the airlink in a first format that is acceptable to a first standardized network that includes the airlink.” Thus, for purposes of this Decision, this is the proper recited function of the “first standard network communication means.”

The Specification of the '074 Patent links network protocol converter 26 to the recited function of the first standard network communication means claim limitation. See Ex. 1001, 6:19–31. Petitioner argues that the CDPD paging interface and two way paging interface described at column 2, lines 31–52, of the '074 Patent are structures that correspond to this claim limitation. Pet. 12. These structures, however, are not clearly associated or linked in the Specification to the recited function of the first standard network communication means limitation. See Ex. 1001, 2:31–52; *Williamson*, 792 F.3d at 1352. Thus, the structure in the Specification that corresponds to the “first standard network communication means” is “network protocol converter 26.”

4. Other Disputed Claim Terms

Petitioner and Patent Owner have proposed constructions for several other claim terms. However, “claim terms need only be construed ‘to the extent necessary to resolve the controversy.’” *Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)); see also *EMI Grp. N. Am., Inc. v. Intel Corp.*, 157 F.3d 887, 895 (Fed. Cir. 1998) (holding that the construction of a given claim term was “irrelevant” because it did

not affect the underlying controversy between the parties). No express constructions for the other claim terms are necessary at this time.

B. Asserted Grounds of Unpatentability

1. Overview

Petitioner argues that challenged claims 1–21 are unpatentable under 35 U.S.C. § 103. Pet. 9. A patent claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which such subject matter pertains.” The question of obviousness under 35 U.S.C. § 103 is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art;³ and (4) objective evidence of nonobviousness, i.e., secondary considerations.⁴ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

2. Obviousness of Claims 1–11

a. Overview of Cao

Cao is a technical paper that describes remote robotics laboratory system that includes a base station and ten (10) small mobile robots. Ex. 1019, 1, 6. The mobile robots include on-board Unix-based workstations. *Id.* at 1. The base station and the on-board Unix workstations of the robots

³ For purposes of this Decision, we consider the cited references to be representative of the level of ordinary skill in the art. See *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

⁴ The current record does not contain arguments regarding secondary considerations.

communicate using Proxim radio modems and the TCP/IP protocol. *See* Ex. 1019, 6.

b. Overview of CAN

CAN is a technical specification for a Controller Area Network (“CAN”). *See* Ex. 1023, 1, 8.

c. Overview of Magid

Magid is a book that describes tools and techniques for building Internet information sites. Ex. 1007, 1. Magid describes the use of web servers (Ex. 1009, 7–8) and common gateway interface (“CGI”) scripts (*see id.* at 27–28), in order to implement an Internet website.

d. Overview of McCain

McCain is a U.S. patent that describes a data and communication system that provides for the interchange of data between a host computer, individual personal computers, a hand-held computing unit, and factory machinery. Ex. 1029, Abstract.

e. Overview of Juengel

Juengel is a U.S. patent that describes a battery operated probe. Ex. 1030, Abstract. The probe detects a low-battery condition, and wirelessly transmits information to a remote receiver indicating that the battery power in the probe is low. *Id.*

f. Analysis

For the reasons that follow, we are not persuaded that the information presented in the Petition shows that there is a reasonable likelihood that the Petitioner will prevail in its obviousness challenge to claims 1–11.

Each of independent claims 1, 3, 4, 5, and 7 recites the “first standard network communication means” claim limitation. Claims 2, 6, and 8–11 depend from claim 1 and, thus, incorporate this limitation by way of dependence. A petition for *inter partes* review “must specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4). Because the “first standard network communication means” is a means-plus-function claim limitation, Petitioner is required to show that *both* the recited function of this claim limitation and the corresponding structure or an equivalent are present in the applied references. *Fresenius USA, Inc. v. Baxter Int’l, Inc.*, 582 F.3d 1288, 1299 (Fed. Cir. 2009) (“[A] challenger who seeks to demonstrate that a means-plus-function limitation was present in the prior art must prove that the corresponding structure—or an equivalent—was present in the prior art.”).

The Petition does not identify any structure in the applied references that is allegedly identical or equivalent to the corresponding structure of the “first standard network communication means” claim limitation, i.e., network protocol converter 26. Petitioner’s entire argument concerning the “first standard network communication means” of claims 1, 3, 4, 5, and 7, is reproduced below:

Cao discloses a “first standard network communications means” (i.e., wireless Proxim radio link with base station) that uses Internet Protocol for “presenting information for transmission over the airlink in a first format that is acceptable

to a first standardized network that includes the airlink” (i.e., TCP/IP format). *See* Ex. 1019 at 6; *see also supra* Section VIII.A.4.

Pet. 40. Though Petitioner alleges that the “wireless Proxim radio link with base station” of Cao performs the recited *function* of the “first standard network communication means,” Petitioner does not compare the *structure* of the “wireless Proxim radio link with base station” of Cao to the structure of network protocol converter 26. Cited Section VIII.A.4 of the Petition similarly does not address the structure of the “wireless Proxim radio link with base station” of Cao. *See* Pet. 18–20. Thus, the Petition does not identify any structure in the applied references that is allegedly identical or equivalent to the corresponding structure of the “first standard network communication means” claim limitation.

For the foregoing reasons, the Petition fails to show persuasively that the “first standard network communication means” claim limitation is found in the references that Petitioner relies upon with respect to claims 1–11. Thus, the information presented in the Petition is not sufficient to demonstrate a reasonable likelihood that Petitioner will prevail in demonstrating that claims 1–11 are unpatentable.

3. Obviousness of Claims 12–21

We already have instituted *inter partes* review as to claims 12–21 of the ’074 Patent. IPR2015-00633, Paper 11. We have discretion to decline to institute a second *inter partes* review as to these claims. *See* 35 U.S.C. § 314(a) & 37 C.F.R. § 108 (institution is discretionary); 35 U.S.C. § 325(d) & 37 C.F.R. 42.122(a) (termination is discretionary where there are multiple proceedings before the Office involving the same patent); *see also Asustek*

Computer, Inc. v. Exotablet, Ltd., Case IPR2015-00043, slip op. at 9–10 (PTAB Apr. 23, 2015) (Paper 6) (declining to institute a second review challenging the same claims on different grounds). We construe our rules to secure the just, speedy, and inexpensive resolution of every proceeding. 37 C.F.R. § 42.1(a). We approach our discretion to decline review on a case-by-case basis. *See, e.g., Conopco, Inc. v. Procter & Gamble Co.*, Case IPR2014-00628, slip op. at 10 (PTAB Oct. 20, 2014) (Paper 21).

The Petition in IPR2015-00633 was filed on February 2, 2015. IPR2015-00633, Paper 1. The Patent Owner filed its Preliminary Response in IPR2015-00633 on May 20, 2015. IPR2015-00633, Paper 8. The Petition in this proceeding was not filed until June 19, 2015. Paper 2.

The 4½ month delay between Petitioner’s first and second Petitions is problematic for several reasons. *First*, the timing of this Petition makes consolidation impractical, and, thus, frustrates the interest of judicial economy. The oral hearing in IPR2015-00633 is set for April 14, 2016. IPR2015-00633, Paper 12. Thus, it would not be practical to institute a second *inter partes* review and consolidate that proceeding with IPR2015-00633. *See* 35 U.S.C. § 315(d). Assuming that Petitioner has shown here a reasonable likelihood that claims 12–21 are unpatentable, two separate trials would be necessary, requiring the parties, as well as the Board, to expend significant additional resources. *Second*, even if we were to institute a second *inter partes* review involving claims 12–21, Petitioner might be unable to “maintain” the second *inter partes* review upon issuance of a final written decision in IPR2015-00633. 35 U.S.C. § 325(e)(1) provides that any final written decision in IPR2015-00633 on the patentability of claims 12–21 would preclude Petitioner from “maintain[ing] a proceeding before the

Office . . . on any ground that the petition raised or reasonably could have raised during [the earlier] post-grant review.” Thus, instituting a second *inter partes* review may result in a significant waste of time and resources for the parties and for Board. See 37 C.F.R. § 42.1(b) (“This part shall be construed to secure a just, speedy, and inexpensive resolution of every proceeding.”). *Third*, the timing of the second Petition raises the potential for gamesmanship. Petitioner did not file this Petition until one month after Patent Owner filed its Preliminary Response in IPR2015-00633. The timing of the second Petition gave Petitioner the opportunity to preview the arguments set forth in the Patent Owner Preliminary Response in IPR2015-00633.

Petitioner also has not provided an adequate explanation for the 4½ month delay between the filing of this Petition and the filing of its previous Petition. Though Petitioner alleges that it was not aware of Cao “at the time it filed Petition No. 2015-00633” (Pet. 2), Petitioner does not state when and under what circumstances, during the 4½ months that preceded the filing of the current Petition, it became aware of Cao. Cao is a technical paper that was published by a major research university in the United States, and, thus, it is not clear on this record why Petitioner was unable to locate Cao at an earlier date. See Ex. 1019, 1.

We further note that Petitioner has not identified any meaningful distinctions between the arguments regarding claims 12–21 in this Petition and the arguments Petitioner set forth in its earlier Petition. For instance, Petitioner does not explain in what ways the grounds asserted against claims 12–21 in this proceeding are superior to the grounds against the same claims and on the basis of which we instituted trial in IPR2015-00633.

In view of the foregoing, we exercise our discretion and decline to institute a second *inter partes* review as to claims 12–21 of the '074 Patent.

IV. ORDER

Accordingly, it is

ORDERED that the Petition is *denied*, and no *inter partes* review is instituted as to any claim of the '074 Patent.

IPR2015-01422
Patent 5,732,074

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