

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FIRST DATA CORPORATION,  
Petitioner,

v.

COQUI TECHNOLOGIES, LLC,  
Patent Owner.

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Case IPR2015-01667  
Patent 7,580,864 B2

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Before GRACE KARAFFA OBERMANN, BRYAN F. MOORE, and  
JENNIFER S. BISK, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

DECISION  
Denying Petitioner's Request for Rehearing  
*37 C.F.R. § 42.71(d)*

## INTRODUCTION

Petitioner, First Data Corporation, filed a Request for Rehearing (Paper 7, “Reh’g Req.”) of our Decision Denying Institution of *Inter Partes* Review (Paper 6, “Institution Decision” or “Inst. Dec.”). The Request seeks rehearing of our Decision with respect to not instituting trial on claims 1 and 5 of U.S. Patent No. 7,580,864 B2 (“the ’864 patent”) as unpatentable under 35 U.S.C. § 103(a) over Stoutenburg (Ex. 1002) and Karas (Ex. 1004). Reh’g Req. 2.

“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). “The burden of showing a decision should be modified lies with the party challenging the decision[,]” which party “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.” 37 C.F.R. § 42.71(d).

For the reasons discussed below, Petitioner’s Request for Rehearing is *denied*.

## ANALYSIS

In the Decision to Institute, we explained that the Petition appeared to offer the disclosures in Karas as alternatives to corresponding disclosures of Stoutenburg for certain limitations, but never indicated that Stoutenburg has any deficiencies related to those limitations. Inst. Dec. 10–11. Based on this flaw, we were not persuaded that Petitioner had shown sufficiently “which portion of Karas Petitioner is relying on, and what portion of Stoutenburg that teaching is meant to supplement.” *Id.* at 11. In addition, the Petition did not explain sufficiently why general language in Stoutenburg, stating that modifications to examples could be

made, would “inspire a person of ordinary skill to look to Karas or which portions of Karas, specifically, that person would be interested in.” *Id.* at 12.

In its request, Petitioner argues that we “overlooked or misapprehended the arguments presented in the Petition regarding *how* and *why* a person of ordinary skill in the art at the time of the alleged invention would have been motivated to combine the teachings of Stoutenburg with those of Karas.” Reh’g Req. 2.

To support its assertion that it sufficiently explained how to combine the two references, Petitioner repeats certain sentences from the Petition highlighting the following points: (1) both Stoutenburg and Karas disclose the “gifting” requirement of claim 1, (2) the systems in the two references are “highly compatible,” and (3) Karas discloses its “gifting” function using certain details, such as a “payment enabler.” *Id.* at 4–6. According to Petitioner, this is enough to explain how the two systems are combined. *Id.* at 6. We disagree.

We see nothing in the request that illuminates the issues specifically addressed in our Decision, namely, the difficulty we had understanding what deficiencies of Stoutenburg Petitioner was proposing would be supplemented by Karas and, assuming a combination of teachings, the details of such combination. Dec. 9–13. Petitioner does not point to anything in the Petition that we overlooked or misapprehended that explains what deficiency in Stoutenburg would lead a person of ordinary skill to look to Karas to supplement its teaching. From the generous use of emphasis in Petitioner’s request, we speculate that Petitioner is now arguing that Karas is being relied on for teaching “using the gift certificates” as recited in the preamble of claim 1 and that, perhaps, Stoutenburg itself, does not disclose this element. See Reh’g Req. 5 (quoting the Petition, but emphasizing “Stoutenburg to teach ‘*gifting*’ funds” and “Karas *also* teaches *gifting*”).

*certificates*").<sup>1</sup> To the extent that this is Petitioner's argument, we are not persuaded that we misunderstood or overlooked this argument in the Petition, but instead find our inability, even at this juncture, to determine Petitioner's position on this issue, exemplifies the problems we encountered with the Petition. Moreover, even if we were persuaded by this argument, it does not explain how Karas's function of gifting certificates is to be combined with Stoutenburg's system. Simply stating that the systems are "highly compatible" does not suffice. *Id.* at 5 (quoting Paper 2 ("Pet."), 27).

Similarly, Petitioner asserts that we "overlooked or misapprehended the Petition's discussion of the motivation offered in Stoutenburg for combining the stored value card embodiment of Stoutenburg, with a 'value transfer system [that] *effectuates payment* for a purchased stored value card' as disclosed in Karas." *Id.* at 7 (quoting Pet. 27). Although Petitioner has repeated this section of its argument from the Petition adding emphasis on "*payment*" and "*the value system effectuates payment*," (*Id.* at 7–8) we still do not understand from Petitioner's argument, why a person of ordinary skill would have been motivated to look to Karas based on Stoutenburg's general statement that its examples are merely illustrative. We are, thus, not persuaded that denying institution on this basis was an abuse of our discretion.

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<sup>1</sup> Petitioner's statement that "Karas *also* teaches *gifting certificates*" (emphasis added by Petitioner), however, could also lead to a conclusion that *both* Stoutenburg and Karas teach gifting certificates.

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Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314 (a), Petitioner's Request for Rehearing is *denied*.

PETITIONER:

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