

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,
Petitioner,

v.

CORE WIRELESS LICENSING S.A.R.L.,
Patent Owner.

Case IPR2015-01986
Patent 8,165,049 B2

Before JAMESON LEE, DAVID C. McKONE, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

McKONE, *Administrative Patent Judge*.

DECISION
Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

On April 1, 2016, we issued a Decision on Institution (Paper 7, “Dec.”) instituting an *inter partes* review of claims 11–14, 17, and 28–31 of U.S. Patent No. 8,165,049 B2 (Ex. 1001, “the ’049 patent”), and declining to institute a review of claim 15. Petitioner filed a Request for Rehearing (Paper 11, “Req.”), requesting reconsideration of our decision not to institute as to claim 15. Req. 1.

II. ANALYSIS

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may be indicated 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. *See Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). The burden of showing that the Decision should be modified is on Petitioner, the party challenging the Decision. *See* 37 C.F.R. § 42.71(d). In addition, “[t]he request 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.*

Claim 15 recites, *inter alia*,

the filtering parameter comprises the information on at least one class of a number of classes agreed on in advance, on the basis of which the electronic information has been classified into the

class, the class denoting whether the electronic information is a personal message, a commercial advertisement or information relating to a specific subject.

In the Petition, “Petitioner note[d] that ‘a personal message, a commercial advertisement or information relating to a specific subject’ is a Markush group.” Pet. 30. Petitioner did not introduce evidence or argument explaining this position, nor did Petition address the other language of claim 15. On the record presented in the Petition, we concluded that Petitioner “oversimplified claim 15 into setting forth a Markush group of restricted members such that the satisfaction of merely one meets the claim.” Dec. 27.

Addressing arguments from Patent Owner, we agreed with Patent Owner that “the required classification scheme has to have been agreed to in advance, and has to be cognizant of all three categories—‘a personal message,’ ‘a commercial advertisement,’ and ‘information relating to a specific subject.’” *Id.* at 26–27. We concluded that, in light of its remaining language “[c]laim 15 requires a plurality of classes agreed to in advance, including the specific categories of ‘personal message,’ ‘a commercial advertisement,’ and ‘information relating to a specific subject.’” *Id.* at 27. In light of this conclusion, we found that Petitioner did not show that the prior art taught claim 15. *Id.*

In the Request, Petitioner argues that we misapprehended the broadest reasonable interpretation of claim 15 and should have construed “a personal message, a commercial advertisement or information relating to a specific subject” to be a Markush group. Req. 3–4. Petitioner contends that language such as “wherein R is A, B, C or D” defines a Markush Group. Req. 5–6 (quoting *Abbott Labs. v. Baxter Pharm. Prods., Inc.*, 334 F.3d

1274, 1280 (Fed. Cir. 2003); citing *In re Harnisch*, 631 F.2d 716, 724 (CCPA 1980)). For a more detailed analysis of Markush claims, Petitioner refers to our decision in *LG Electronics, Inc. v. Core Wireless Licensing S.A.R.L.*, Case IPR2015-01988 (PTAB April 1, 2016) (Paper 7), denying institution as to claim 11 of related U.S. Patent No. 8,792,398 B2 (“the ’398 patent”), which included language similar to that of claim 15. *Id.* at 3.¹ According to Patent Owner, in IPR2015-01988, we denied *inter partes* review of claim 11 “for the same reason that the Board now denies review of Claim 15 of the ’049 patent—because the Board disagreed with Petitioner’s contention that the contested claim language is a Markush group.” *Id.*

As explained above, however, Petitioner’s failure to show a reasonable likelihood of success as to claim 15 turned on its failure to show the claimed classification scheme in the prior art, not the presence or

¹ Petitioner has filed a Request for Rehearing in IPR2015-01988 (Paper 11) making essentially the same arguments for claim 11 of the ’398 patent as it does for claim 15 of the ’049 patent. We concurrently are denying that request for essentially the same reasons.

absence of a Markush group in claim 15.² Dec. 26–27. In the Request, Petitioner disagrees with our conclusion that claim 15 contemplates a classification scheme with at least these three classes, wherein a filtering parameter within claim 15 denotes one of these three classes. Req. 7–8. Petitioner argues that “[claim 15] does not explicitly link the ‘number of classes agreed on in advance’ with ‘a personal message, a commercial advertisement or information relating to a specific subject,’” and, thus, “nothing in claim 15 requires the ‘number of classes agreed on in advance’ to include all three of ‘a personal message, a commercial advertisement or information relating to a specific subject.’” *Id.* at 7.

Petitioner did not present this argument (or evidence to support it) in the Petition. Thus, we could not have misapprehended or overlooked it. A request for rehearing is not an opportunity for a party to introduce new argument, bolster insufficient argument, or mend gaps in the evidence relied

² As we explained in IPR2015-01988, Paper 7, at 10–11, the claim language in question does not recite “consisting” or other language indicating a closed group; thus “a personal message, a commercial advertisement or information relating to a specific subject,” as recited in claim 15, is presumptively open. *See Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d 1367, 1372 (Fed. Cir. 2005). Although, as Petitioner notes, the format used in claim 15 would be “atypical” for a Markush group, Req. 5, it could be permissible in certain circumstances. *See* Manual of Patent Examining Procedure (“MPEP”) §§ 803.02, 2173.05(h) (9th ed., rev. 07.2015, Nov. 2015). For example, atypical language might be sufficient when the members of the group belong to an art-recognized class or if the specification describes common properties of the group members. *See id.* § 803.02. Petitioner did not introduce argument or evidence in the Petition as to why atypical language should be read as a Markush group in this case. Accordingly, we could not have misapprehended or overlooked such argument or evidence.

on in the Petition. *See* 37 C.F.R. § 42.71(d). In any case, Petitioner’s new argument simply disagrees with our reading of the claim limitation at issue. Whether the linkage is recited “expressly” is not determinative. We note that the filtering parameter can be any one of the three identified classes and the corresponding class still has to be one of the multiple classes previously agreed to in advance. A reading that is without this linkage would be unreasonably broad. We maintain our construction of claim 15 for the reasons stated in the Decision, at 26–27.

II. CONCLUSION

Petitioner has not shown that we abused our discretion in declining to institute an *inter partes* review of claim 15. Accordingly, Petitioner’s request for rehearing is denied.

III. ORDER

Petitioner’s Request for Rehearing is denied.

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