

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AVIGILON USA CORPORATION, INC. and  
AVIGILON CORPORATION  
Petitioner,

v.

JDS TECHNOLOGIES, INC.,  
Patent Owner.

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Case IPR2016-00520  
Patent 6,891,566 B2

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Before JONI Y. CHANG, DAVID C. McKONE, and  
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

McKONE, *Administrative Patent Judge*.

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

## I. INTRODUCTION

On June 8, 2016, we issued a Decision Denying Institution (Paper 9, “Dec.”) declining to institute an *inter partes* review of claims 1, 6–10, 16–24, and 28 of U.S. Patent No. 6,891,566 B2 (Ex. 1001, “the ’566 patent”). Petitioner filed a Request for Rehearing (Paper 21, “Req.”), requesting reconsideration of our decision not to institute. Req. 1–2.

## 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.*

As summarized in the Decision Denying Institution, Petitioner proposed a combination of AXIS Manual and Schell in which a standard Web browser, taught in AXIS Manual, controlled a network interface card (“NIC”), allegedly inherently disclosed in AXIS Manual, to perform NIC functionality described in Schell. Dec. 17. The Request confirms that this

was indeed Petitioner's theory. Req. 9 ("Mr. Gafford explained how the Web browser expressly disclosed in the AXIS Manual would *necessarily* have operated through an NIC."). The Petition addressed the alleged teachings of AXIS Manual as to controlling an NIC at pages 21, 22, and 27 of the Petition, which cited pages 18, 22, 41, and 49 of AXIS Manual and paragraphs 39, 86, 89, 101, and 102 of Mr. Gafford's testimony. We considered this evidence, along with additional testimony from Mr. Gafford (Ex. 1008 ¶¶ 97–98, 116–19). Dec. 17–20. We ruled that AXIS Manual did not disclose an NIC or using a Web browser to direct a microprocessor to control an NIC. *Id.* at 19–20. In doing so, we ruled that the testimony of Mr. Gafford cited by Petitioner in support of its theory did not disclose the underlying facts or data on which his opinions were based. *Id.* (citing 37 C.F.R. § 42.65(a)).

Petitioner argues that we erred by refusing to consider and credit Mr. Gafford's testimony on the state of the art, including NICs and Common Gateway Interface ("CGI") parameters. Req. 5–6. Petitioner contends that our Decision was "based on an incorrect conclusion of law that an expert cannot testify on the state of the art." *Id.* at 1. According to Petitioner, by overlooking this evidence, we incorrectly "found that a Network Interface Controller (NIC) and CGI parameters used to create custom webpages were not well-known in the art." *Id.* at 1.

As an initial matter, we did not find that NICs and CGI parameters were not well-known. The '566 patent describes examples of both in the prior art. Ex. 1001, 1:63–2:5 (describing commercially available cameras controlled in part using CGI); 5:21–26 (a client computer can be a conventional computer that includes an NIC). Nor did we conclude that an

expert cannot testify about the state of the art. Rather, we concluded, after considering the evidence Petitioner cited, that Petitioner was not reasonably likely to show that AXIS Manual inherently disclosed a Web browser directing a microprocessor to control an NIC. Dec. 20.

Petitioner contends that “[a]n expert’s testimony on the state of the art must be considered at face value,” and that “[d]isputes over whether the support provided by the expert (whether based on his or her experience or a printed publication) are issues of credibility to be decided at trial, not at the institution stage.” Req. 6–7. Petitioner cites to no persuasive support for the proposition that we must, at the institution stage of a proceeding, simply accept unsubstantiated expert testimony. To the contrary, Rule 42.65(a) provides that “[e]xpert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”

According to Petitioner, we misinterpreted Rule 42.65(a) “as requiring written documentation for each and every statement in an expert declaration” and, accordingly, applied the rule too stringently. Req. 7–8. We held Mr. Gafford’s testimony to no such requirement. Nevertheless, the testimony cited in the Petition (Ex. 1008 ¶ 39, 86, 89, 101–02) does not identify any basis at all (whether experience or publication) for Mr. Gafford’s conclusory assertions of fact. As such, that testimony is entitled to little weight.

Petitioner further argues that “Mr. Gafford provided abundant explanation for why NICs and CGI parameters were well-known in the art and were necessarily present in the system described in the AXIS Manual.” Req. 8. Specifically, as to Mr. Gafford’s testimony, Petitioner contends that we overlooked paragraphs 37–44, 51, and 82–89 in the Gafford Declaration,

supposedly cited at pages 21–22 of the Petition. Req. 3–4. Nevertheless, the Petition only cited to paragraphs 39, 86, 88, and 89 of Mr. Gafford’s testimony in support of its arguments at pages 21–22 of the Petition. We could not have overlooked or misapprehended the additional testimony that Petitioner did not cite.

Apparently acknowledging that it did not expressly cite much of the testimony on which it now seeks to rely, Petitioner argues that each of the paragraphs of Mr. Gafford’s Declaration that we cited to in the Decision Denying Institution “incorporates by reference the paragraphs of support that preceded them” by virtue of their use of language such as “[t]herefore, in my opinion,” “[a]ccordingly,” and “thus.” Req. 11 n.3. In particular, Petitioner appears to contend that the paragraphs we cited sweep in all of paragraphs 37–47 of the Gafford Declaration, which, Petitioner argues, includes “a more fulsome description of network communication protocols.” *Id.* at 11. None of the paragraphs we cited in the Decision provides any specificity as to what it might be incorporating, and words such as “thus” and “therefore” provide no such clarity.

In any case, it was Petitioner’s burden to identify, in the Petition, “[t]he exhibit number of the supporting evidence relied upon to support the challenge and the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge.” 37 C.F.R. § 42.104(b)(5). We fully considered the evidence cited in the Petition. Much of the evidence now cited in the Request was not cited in the Petition. As provided in this Rule, “[t]he Board may exclude or give no weight to the evidence where a party has failed to state its relevance

or to identify specific portions of the evidence that support the challenge.”  
*Id.*

Petitioner contends that the Petition cited to testimony in which “Mr. Gafford explained that the Web browser ‘necessarily directs the microprocessor to access camera images from the video server in the same way I described herein (i.e., via a NIC in the client computer).’” Req. 10–11. The Request inaccurately contends that this testimony occurred in paragraph 89 of Mr. Gafford’s testimony, which was cited in the Petition. *Id.* Rather, this testimony was in paragraph 90 of Mr. Gafford’s testimony, which was not cited in the Petition. Thus, we could not have overlooked or misapprehended it.

As to our conclusion that Mr. Gafford did not state the bases for his testimony, Petitioner argues that “Mr. Gafford relied on his experience and on written documentation to bolster his opinions about the state of the art and what a person of ordinary skill in the art would have known.” Req. 8. As explained above, in the testimony cited in the Petition, Mr. Gafford does not identify the bases for his testimony, whether it be experience or documentation.

As to written documentation, Petitioner now argues that, in paragraph 44 of Mr. Gafford’s testimony, he identified the Nelson reference (Ex. 1020) as providing a basis to find that controlling an NIC would have been inherent in AXIS Manual. Req. 11–12 (citing Ex. 1020, 1:54–58). The Petition did not cite to paragraph 44 of Mr. Gafford’s testimony. Therefore, we could not have overlooked it. Moreover, the extent of Mr. Gafford’s testimony about Nelson in paragraph 44 is as follows: “Various publications from the 1980s and 1990s describe these standard Internet operating

principles. One known publication is Nelson (Ex. 1020), which provides a good overview of Internet protocols and processes.” Ex. 1008 ¶ 44. Mr. Gafford does not identify what disclosure in Nelson, if any, he relies on.<sup>1</sup> In any case, his general citation to various publications, including Nelson, describing Internet operating principles is insufficient to support Petitioner’s contention that AXIS Manual inherently discloses an NIC.

Petitioner also argues that we overlooked admissions in the ’566 patent. Req. 3. Petitioner contends that it “offered the declaration of [Mr. Gafford] in part to corroborate the Patent’s admission regarding the state of the art.” *Id.* at 1. According to Petitioner, “[m]ost importantly, the ’566 Patent admits that an NIC was known in the art.” *Id.* at 12 (citing Ex. 1001, 5:22–26); *accord id.* at 10 (“[T]he ’566 patent admits that an NIC is prior art.”). Petitioner does not state where it raised this argument in the Petition. Thus, we could not have overlooked or misapprehended it. In any case, Petitioner’s position in the Petition was not that NICs were known (they were). Rather, Petitioner sought to establish that AXIS Manual necessarily, and thus inherently, discloses a Web browser directing a microprocessor to control an NIC. Pet. 21–22; Req. 9. The ’566 patent’s statement that a client computer can be a conventional personal computer including an NIC does not support a finding that AXIS Manual necessarily discloses an NIC by virtue of disclosing a standard Web browser.

Finally, Petitioner argues that we misapprehended paragraph 89 of Mr. Gafford’s testimony regarding CGI parameters. Req. 14–15. Petitioner

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<sup>1</sup> Petitioner now identifies column 1, line 29, through column 2, line 24, of Nelson. Req. 4. Petitioner does not say where Petitioner or its expert previously addressed this citation.

now argues that “[s]etting up a custom webpage using CGI parameters was only an optional, alternative disclosure of the AXIS Manual,” and that we overlooked the disclosure at page 18 of AXIS Manual showing an attempt to access camera images. *Id.* To the contrary, we fully considered Petitioner’s arguments as to page 18 of AXIS Manual, including Petitioner’s citations to paragraphs 39 and 89 of Mr. Gafford’s testimony, and concluded that none of this evidence supported a finding that AXIS Manual necessarily discloses using a Web browser to direct a microprocessor to control an NIC. Dec. 18–20. Petitioner does not persuasively show in the Request that this conclusion is unsupported by substantial evidence.

### III. CONCLUSION

Petitioner has not shown that we abused our discretion in declining to institute an *inter partes* review of the ’566 patent. Accordingly, Petitioner’s request for rehearing is denied.

### IV. ORDER

Petitioner’s Request for Rehearing is denied.

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PETITIONER:

Cyrus Morton  
ROBINS KAPLAN LLP  
[cmorton@robinskaplan.com](mailto:cmorton@robinskaplan.com)

PATENT OWNER:

Marc Lorelli  
BROOKS KUSHMAN P.C.  
[jdsc0109ipr1@brookskushman.com](mailto:jdsc0109ipr1@brookskushman.com)