

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPPORATION,
Petitioner,

v.

COREL SOFTWARE, LLC,
Patent Owner.

Case IPR2016-01086
Patent 8,700,996 B2

Before RAMA G. ELLURU, JAMES A. TARTAL, and
DANIEL N. FISHMAN, *Administrative Patent Judges*.

FISHMAN, *Administrative Patent Judge*.

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

I. INTRODUCTION

Corel Software, LLC (“Patent Owner”) requests rehearing (“Reh. Req.,” Paper 18) of our Decision on Institution (“Dec.,” Paper 14) granting *inter partes* review of dependent claims 3 and 24 of U.S. Patent No. 8,700,996 B2 (Ex. 1001, the “’996 patent”). In the Request for Rehearing, Patent Owner argues our decision misapprehended or overlooked certain matters in granting the review. For the reasons below, the request is *denied*.

II. LEGAL STANDARD

When rehearing a decision whether to institute *inter partes* review, we 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,” and, “[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 the record. 37 C.F.R. § 42.71(d).

III. DISCUSSION

Patent Owner argues our Decision on Institution relies on Petitioner’s assertion that CorelDRAW’s “Align and Distribute” dialog box (Ex. 1004) discloses the “identifying but not executing” limitation of claim 1 (from which claim 3 depends). Reh. Req. 5 (citing Dec. 21). Patent Owner further argues the Petition asserts that the “Preview” button must be clicked to perform the “identifying but not executing” recitation of claim 1, but “[t]he Petition says nothing about hovering in this embodiment.” *Id.* Thus, Patent

Owner asserts the “Align and Distribute” dialog box is asserted in the Petition “only against claim 1, and not against claim 3.” *Id.* at 6.

Based on our reliance on Petitioner’s assertions regarding the “Align and Distribute” dialog box, Patent Owner contends our Decision on Institution “makes a factually incorrect statement” when it asserts in “***each cited figure***,” CorelDRAW shows an example of hovering when the “Align and Distribute” dialog box does not show such hovering. Reh. Req. 6–7 (citing Dec. 24). Patent Owner argues the “Align and Distribute” dialog box relied on in our institution for claim 1 does not show hovering over a drop down list and, therefore, the Board “overlooked the fact that the sole embodiment for which the Board found a reasonable likelihood of success for claim 1 does not disclose ‘hovering’ as recited in claim 3, and the Petition did not contend otherwise.” *Id.* at 7. Patent Owner asserts the same issue is overlooked in our institution for claim 24 for the same reasons as claim 3. *Id.*

We are not persuaded our Decision overlooked or misapprehended any matters. Our Decision on Institution determines, based on a *reasonable likelihood* standard, that the “Align and Distribute” dialog box discloses “identifying but not executing” as well as the ability to view the effects of the identified command by “updating the display of the portion of the document on the display.” Dec. 21–22 (citing Pet. 22–24, 26–33). Claim 1 does not recite “hovering,” but more broadly recites “identifying but not executing” a command. Reliance on the “Align and Distribute” dialog box of CorelDRAW does not preclude “identifying but not executing” that includes “hovering” (positioning a cursor above a command). As exemplified in the additional figures of CorelDRAW cited by Petitioner in

analysis of claim 3, several menus and dialog boxes of CorelDRAW at least suggest “hovering” by positioning a cursor above a command to identify a command without executing the command. Dec. 24–25 (citing, e.g., Ex. 1004, 515, 522, 527, 530, 535, 557); *see also* Pet. 33–34. Our Decision’s reference to “each cited figure” is a reference to these additional figures referred to in the immediately preceding paragraph of the Decision. *See* Dec. 24. Although the “Align and Distribute” dialog box of CorelDRAW does not expressly depict hovering to identify a command, it does not preclude the additional use of hovering to identify a command as disclosed in these other cited figures of CorelDRAW. In other words, in view of the many disclosures of hovering in CorelDRAW, our Decision on Institution determined, based on a reasonable likelihood standard, that it would have been suggested that a user may hover over, for example, an alignment option on the dialog box to identify the command and then click “Preview” to view its effect in the displayed portion of the document, still without executing the command until a user clicks “OK.” *See* Dec. 25 (“Petitioner has sufficiently shown that the cited figures of CorelDRAW would have suggested to the ordinarily skilled artisan that the highlighted command in each cited figure was ‘identified’ by user action that positioned the cursor over that command—i.e., by hovering the cursor over that command.”).

IV. CONCLUSION

We have reviewed all of the arguments in the Request for Rehearing and find them to be without merit. Patent Owner has not persuasively shown that the Decision instituting *inter partes* review of challenged claims 3 and 24 of the ’996 patent misapprehended or overlooked any matters and,

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thus, we are not persuaded the Decision on Institution constituted an abuse of discretion.

V. ORDER

In view of the foregoing discussion, it is hereby:

ORDERED that Patent Owner's Request for Rehearing is *denied*.

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