

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LOS ANGELES COUNTY METROPOLITAN
TRANSPORTATION AUTHORITY
Petitioner,

v.

TRANSPORT TECHNOLOGIES, LLC
Patent Owner.

Case IPR2016-01633
Patent 6,980,101

Before DAVID C. McKONE, GEORGIANNA W. BRADEN, and
MONICA S. ULLAGADDI, *Administrative Patent Judges*.

ULLAGADDI, *Administrative Patent Judge*.

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

I. INTRODUCTION

Los Angeles County Metropolitan Transportation Authority, Clark Construction Group LLC, and Atkinson Contractors LP (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) for *inter partes* review of claims 1, 3, 5, 6, 8, and 10 (the “challenged claims”) of U.S. Patent No. 6,980,101 B2 (Ex. 1001, “the ’101 patent”). Transport Technologies, LLC (“Patent Owner”) timely filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We instituted trial on all of the challenged claims of the ’101 patent on all grounds of unpatentability alleged in the Petition. Paper 8 (“Institution Decision” or “Inst. Dec.”).

We concluded that the challenged claims of the ’101 patent had not been shown by a preponderance of the evidence to be unpatentable because the challenges to these claims were based on the Draft Ontario Report (Ex. 1005), which we found was not shown to have been publicly accessible and, therefore, was not shown to have been prior art to the ’101 patent. Paper 22, 21–22 (“Final Decision” or “Final Dec.”).

Petitioner filed a request for rehearing (Paper 23, “Rehearing Request” or “Reh’g Req.”) of our Final Decision. Patent Owner requests that we reconsider our decision that the Draft Ontario Report was not shown to have been prior art to the ’101 patent. For the reasons set forth below, the request is denied.

II. STANDARD OF REVIEW

The burdens and requirements of a request for rehearing are stated in 37 C.F.R. § 42.71(d):

(d) *Rehearing*. . . . The burden of showing a decision should be modified lies with the party challenging the decision. The 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.

III. ANALYSIS

A. Whether We Overlooked Petitioner’s Evidence And Misapprehended The Law When We Held That The Research Project Underlying The Draft Ontario Report, But Not The Draft Ontario Report Itself, Was Publicized

Petitioner argues that we overlooked its evidence when we held that “the research project, but not the draft report, was publicized,” and further contends that “Section 102 does not require the very specific publicity requirement imposed by the Board.” Reh’g. Req. 8 (citing Final Dec. 15). Petitioner further argues that “[t]he Draft Ontario Report was a public document, the existence of which was highly publicized,” as was the underlying research project. *Id.* at 4–5, 8 (citing Reply 16; Ex. 1025, 4–18).

In our Final Decision, we fully considered these arguments. Upon doing so, we found that “the research project was publicized on the Enterprise website (*see* Ex. 1025, 14–16),” and further, that “Petitioner does not contend, nor does the record indicate, that the draft report was publicized on the website so as to convey its availability at the Board Meeting (*see id.*)” Final Dec. 15. Thus, we did not overlook Petitioner’s evidence as we considered the underlying research project in the printouts of the Enterprise website to determine whether it provided a “roadmap” to locating the Draft Ontario Report. *See id.*; *see* Reh’g. Req. 12–13 (arguing that we overlooked evidence of publicity and direct communications about the research project when we determined the evidentiary record did not support the finding that a person of ordinary skill in the art would have been independently aware of report). We found that it did not. *Id.*

We made the distinction between the research project and the Draft Ontario Report, in our Final Decision, because the case law requires a sufficient showing with respect to the disclosure upon which Petitioner’s challenge is based. *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981) (A reference is proven to be a “printed publication” “upon a satisfactory showing that *such document* has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” (emphasis added)). This distinction was necessary because Petitioner did not establish that the research project, as publicized on the Internet, discloses all the elements used to establish, for example, its anticipation challenge with respect to the claims of the ’101 patent. *See e.g.*, Ex. 1025, 12, 15, 18; *see* Pet. 23.

Petitioner supports its publicity arguments by further arguing that “the relevant disclosure of the Draft Ontario Report was published on the internet in substantially identical form (the Final Ontario Report) before the critical date of March 14, 2005.” *Id.* at 6–7 (citing Reply 14–15). Petitioner also argues that the “interested public would not have had to rely on the internet to be aware of the Draft Ontario Report,” because “[n]umerous stakeholders (i.e., persons concerned with the art) throughout the world were solicited for their input, [and] apprised of Enterprise’s research.” *Id.* at 5 (citing Reply 16; Ex. 1005, 72–98; Ex. 2014, 69).

We did not overlook these arguments and evidence because Petitioner’s challenge in the Petition was predicated on the dissemination of CDs containing the Draft Ontario Report at the August 2004 Enterprise Board Meeting (“Board Meeting”). Pet. 7 (asserting that the Draft Ontario Report was *published on August 22, 2004*); *see* Ex. 1018, 11. Nevertheless, Petitioner’s proffered evidence regarding soliciting input from and apprising stakeholders of Enterprise research is not persuasive because Petitioner’s witness, Mr. Wong, testified that he did not

know if the Draft Ontario Report was provided to the stakeholders, nor when input was obtained from each stakeholder. Ex. 2014, 69:9–71:10.

*B. Whether We Misapprehended And Overlooked Petitioner’s Evidence
When We Held That The Enterprise Board Did Not Constitute
A Significant Portion Of The Interested Public*

Petitioner argues that we “misapprehended and overlooked Petitioner’s evidence when [we] held that the Enterprise board did not constitute a significant portion of the interested public.” Reh’g. Req. 11 (citing Final Dec. 17, 19). Petitioner further argues that the “the entities represented at the Duluth meeting constituted a significant portion of the interested public,” and that “the evidence of record is that the Draft Ontario Report was accessible to anyone in any of these entities.” *Id.* at 3, 11; *see id.* at 5 (citing Reply 18–19). Petitioner supports its arguments by asserting that “dissemination to a representative of a public entity that does not have the confidentiality concerns of a military or security agency is tantamount to dissemination to the agency itself” (*id.* at 2) and that “availability of a document within a national or state administration or board is sufficient for a printed publication under Section 102 (*id.* at 11 (citing *E.I. Du Pont de Nemours & Co. v. Cetus Corp.*, 19 U.S.P.Q.2d 1174 (N.D. Cal. 1990))).” Petitioner did not make this argument in the Petition or Reply. Thus, we could not have misapprehended or overlooked it. Although Petitioner may disagree with our resolution of the arguments Petitioner presented in its Briefs, such arguments were considered fully in our Final Decision. Final Dec. 18–19.

C. Whether We Misapprehended The Law When We Evaluated The Intent Or Motivation Of The Non-Enterprise Board Members And Whether We Overlooked Petitioner's Evidence In Reaching Our Holding Regarding Confidentiality

Petitioner contends that we “misapprehended the law when [we] evaluated the intent or motivation of the non-Enterprise board members (the engineers from ITS Engineers and Castle Rock) attendance at the Duluth meeting.” Reh’g. Req. 9 (citing Final Dec. 15); *see id.* (citing *Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc.*, 291 F.3d 1317, 1324 (Fed. Cir. 2002); *Garrett Corp. v. United States*, 422 F.2d 874, 878 (Ct. Cl. 1970) (“[D]istribution to commercial companies without restriction on use clearly does [constitute publication].”)). Petitioner also argues that our “holding regarding confidentiality (Final Dec. 20) overlooked Petitioner’s evidence that the Enterprise did not have a policy against distributing drafts.” Reh’g. Req. 13 (citing Reply 17; Ex. 2014, 136).

We did not misapprehend the law when we considered, in our Final Decision, the professional capacity in which the contracting engineers’ attendance was motivated. We determined that this capacity dictated professional norms, and accordingly, the reasonable expectation with respect to confidentiality. Final Dec. 20–21 (citing *Cordis Corp. v. Boston Sci. Corp.*, 561 F.3d 1319, 1334 (Fed. Cir. 2009) (noting that professional norms may support expectations of confidentiality)). We also did not overlook Petitioner’s evidence of Enterprise policy. *See* Reh’g. Req. 13. We considered this evidence and determined that it did not support the finding that the contracting engineers “would have distributed, or in fact did distribute” the Draft Ontario Report outside the Board Meeting, nor was there a showing “that similar documents in the past became available to the public as a result of disclosure by these or similar commercial entities, that these or similar commercial entities typically would make the existence of such documents known

and would honor requests for public access, or that these or similar commercial entities had an incentive to make the document available.” See Final Dec. 20 (citing *Cordis*, 561 F.3d at 1335; Ex. 2015, 94:2–12). After fully considering Petitioner’s arguments and evidence, we ultimately found that “the evidence indicate[d] that Enterprise draft reports are not shared with the public.” Final Dec. 20 (citing Ex. 2015, 94:2–12; *Cordis*, 561 F.3d at 1335); see *id.* at 17.

D. Whether We Misapprehended The Law When We Evaluated Whether Anyone Other Than Messrs. Wong or Legg Actually Obtained Or Viewed The Draft Ontario Report

Petitioner contends that we “misapprehended the law when [we] evaluated whether anyone other than Messrs. Wong or Legg actually obtained or viewed the report.” Reh’g. Req. 10. Petitioner’s argument is misplaced. We did not rule on the basis that Petitioner needs to show the number of people who actually read the document. Rather, after considering all of Petitioner’s evidence, we found that the admissions of Petitioner’s witnesses tended to undermine Petitioner’s arguments that non-final documents, such as the Draft Ontario Report, were non-confidential and distributed outside of the Enterprise group. Final Dec. 15–16.

E. Whether We Overlooked Petitioner’s Testimonial Evidence When We Held That A \$25,000 Fee Was Required For Membership In Enterprise

Petitioner contends that “the Board also overlooked Petitioner’s testimonial evidence when it held that a \$25,000 fee was required for membership in Enterprise.” Reh’g. Req. 13 (citing Final Dec. 17–18). Petitioner argues that “Mr. Legg and Mr. Wong testified that this was considered a voluntary contribution and not a fee” and that “[r]equiring payment before obtaining information would have been contrary to the fundamental premise of the Enterprise.” *Id.* (citing Reply 21–22). Irrespective of how Petitioner’s testimonial

evidence characterizes the sum of money, either as a fee or a contribution, we considered the website evidence and the testimonial evidence and determined that Petitioner did not show persuasively that membership or draft reports could be had without it. Dec. 17–18.

IV. CONCLUSION

For the foregoing reasons and for the reasons set forth in the Final Decision, we are not persuaded that we overlooked or misapprehended Petitioner's arguments or evidence or the law.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request for rehearing is *denied*.

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