

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUNIPER NETWORKS, INC., BROCADE COMMUNICATIONS SYS.,
INC., RUCKUS WIRELESS, INC., HEWLETT PACKARD ENTERPRISE
COMPANY, HP INC., ARUBA NETWORKS, INC., AND ARRIS
GROUP, INC.,
Petitioner,

v.

MOBILE TELECOMMUNICATIONS TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2017-00642
Patent 5,590,403

Before MEREDITH C. PETRAVICK, SCOTT A. DANIELS, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

DECISION
ON PETITIONER'S REQUEST FOR REHEARING
37 C.F.R. § 42.71(d)

Petitioner, as captioned above, filed a Petition to institute *inter partes* review of claims 1 and 10 of Patent No. 5,590,403 (“the ’403 patent”) pursuant to 35 U.S.C. § 311–319. Paper 1 (“Pet.”). Mobile Telecommunications Technologies, LLC. (“Patent Owner”) filed a Corrected Preliminary Response. Paper 22 (“Prelim. Resp.”).¹ We denied institution of *inter partes* review because, in part, we determined that prior art Petitioner asserted was presented previously to the Office and was considered substantively by the Examiner during examination. Thus, we exercised our discretion under 35 U.S.C. § 325(d). Paper 24 (“Decision on Institution” or “Dec.”). Petitioner requests partial rehearing of our Decision on Institution. Ex. 1023 (“Req. Reh’g”); see Paper 30.

For the reasons that follow, we *deny* Petitioner’s Request for Rehearing.

I. BACKGROUND

A. PROSECUTION HISTORY OF THE ’403 PATENT

The ’403 patent describes a mobile communication system “providing two-way communication capability between a central network and a mobile unit over a relatively large area” to allow for rapid communication of large messages and efficient use of system resources. Ex. 1001, 1:10–14. The ’403 patent issued from application number 07/973,918, filed on November 12, 1992. Ex. 1002, 1 (“Prosecution File”).² Claims 1 and 4 in the filed application issued as claims 1 and 10 of the ’403 patent. *Id.* at 3 (index of

¹ We refer to the Corrected Preliminary Response (Paper 22) when citing to Patent Owner’s brief.

² Cites to the Prosecution File refer to the continuous pagination Petitioner provides in the footer of Exhibit 1002.

claims showing where original claim 1 issued as final claim 1 and original claim 4 issued as final claim 10). In discussing the prosecution history, we refer to the numbering of the issued claims.

After issuing a restriction requirement grouping claims 1 and 10 together, the Office mailed a First Office Action that made two statements relevant to our discussion. First, the Examiner stated that claim 1 would be allowable if rewritten to overcome the rejection made under 35 U.S.C. § 112, second paragraph. *Id.* at 178. Second, the Examiner rejected claim 10 under 35 U.S.C. § 103 as being unpatentable over Jasinski (U.S. Patent No. 4,968,966 (Exhibit 1004)). *Id.* at 182.

The applicant argued against both rejections. With regard to claim 1, the applicant argued, in part, that a § 112 rejection is not proper given the definiteness of the claims, and that “[s]ince, as recognized by the Examiner, the prior art in this case does not affect the scope of claim 1, neither can 35 U.S.C. § 112.” *Id.* at 197–198. With regard to claim 10, the applicant argued that Jasinski did not disclose two limitations: (1) “dynamically reassigning one or more of the base transmitters in the first set of base transmitters assigned to the first zone to the second set of base transmitters assigned to the second zone as a function of the messages to be communicated in an area, thereby creating an updated first set of base transmitters and an updated second set of base transmitters”; and (2) “transmitting substantially simultaneously in simulcast a third information signal and a fourth information signal by the updated first and second sets of transmitters, respectively.” *Id.* at 201–202.

The arguments proved persuasive, because, although other pending claims were rejected anew in the next Office Action, claims 1 and 10 were

deemed allowable over the prior art of record. *Id.* at 210, 221. After further prosecution, the applicant cancelled the remaining rejected claims, and the Office issued a Notice of Allowability. *Id.* at 225–226. In that Notice, the Examiner provided an Examiner’s Statement of Reasons for Allowance as follows:

As to claim 1, the prior art of record fails to show a simulcast system for transmitting from the first and second sets of transmitters a first blocks of information over a first time period and respectively transmitting the second and third blocks of information over a second time period from the first and second sets of transmitters.

As to claim [10], the prior art of record fails to show a simulcast system for transmitting from the first and second blocks of information, dynamically reassigning one or more base transmitters and transmitting the third and fourth blocks of information to the mobile receivers.

Id. at 227. The patent issued with claims 1 and 10 after the issue fee was paid. *Id.* at 260–263.

B. ASSERTED PRIOR ART AND GROUNDS

Petitioner identified the following prior art in its challenge of unpatentability:

- 1) *Jasinski*: U.S. Patent No. 4,968,966 (Exhibit 1004); and
- 2) *Thro*: U.S. Patent No. 4,670,906 (Exhibit 1005).

The grounds of unpatentability presented in the Petition relied upon the above prior art as follows (Pet. 12):

Reference[s]	Basis	Claim challenged
Jasinski	§ 103	1
Thro	§ 103	10

Reference[s]	Basis	Claim challenged
Thro and Jasinski	§ 103	10

C. CHALLENGED CLAIMS

The challenged claims are reproduced below.

1. A method for information transmission by a plurality of transmitters to provide broad communication capability over a region of space, the information transmission occurring during at least both a first time period and a second time period and the plurality of transmitters being divided into at least a first and second set of transmitters, the method comprising the steps of:

- (a) generating a system information signal which includes a plurality of blocks of information;
- (b) transmitting the system information signal to the plurality of transmitters;
- (c) transmitting by the first and second sets of transmitters a first block of information in simulcast during the first time period;
- (d) transmitting by the first set of transmitters a second block of information during the second time period; and
- (e) transmitting by the second set of transmitters a third block of information during the second time period.

10. A method of communicating messages between a plurality of base transmitters and mobile receivers within a region of space divided into a plurality of zones with each zone having at least one base transmitter assigned thereto, the communication method comprising the steps of:

- (a) transmitting substantially simultaneously a first information signal and a second information signal to communicate messages to the mobile receivers, the first information signal being transmitted in simulcast by a first

set of base transmitters assigned to a first zone, and the second information signal being transmitted in simulcast by a second set of base transmitters assigned to a second zone;

(b) dynamically reassigning one or more of the base transmitters in the first set of base transmitter assigned to the first zone to the second set of base transmitters assigned to the second zone as a function of the messages to be communicated in an area, thereby creating an updated first set of base transmitters and an updated second set of base transmitters; and

(c) transmitting substantially simultaneously a third information signal and a fourth information signal, the third information signal being transmitted in simulcast by the updated first set of base transmitters, and the fourth information signal being transmitted in simulcast by the updated second set of base transmitters to communicate additional messages to said mobile receivers.

D. DECISION DENYING INSTITUTION

In our Decision on Institution, we denied the Petition. Dec. 15. With regard to the Jasinski grounds,³ we evaluated Patent Owner's arguments that Jasinski had been presented previously to the Office during prosecution and that the panel should deny those grounds under 35 U.S.C. § 325(d). We found Patent Owner's arguments persuasive. In particular, we noted, after considering a variety of factors, that "Jasinski was the subject of substantive discussion and studied evaluation in the rejection of claims of the '403 patent." Dec. 12. We also found unpersuasive Petitioner's arguments

³ When referring to the Jasinski grounds, we include the ground where Jasinski is asserted alone (for claim 1) and the ground where Jasinski is asserted in combination with Thro (for claim 10).

that the Examiner did not consider certain teachings in Jasinski with regard to claim 1. *Id.* at 10–11. We also determined that there is substantial overlap in the arguments presented in the Petition and those presented during examination with regard to the limitation of “dynamically reassigning,” recited in claim 10. *Id.* at 11. We concluded: “[w]e find that the Examiner was aware of the contents of Jasinski in material respects applicable to both claim 1 and claim 10, and that we have been shown no reason sufficient to reevaluate Jasinski with respect to any of the challenged claims.” *Id.* at 13.⁴

II. ANALYSIS

A. REQUEST FOR REHEARING

A party requesting rehearing has the burden to show a decision should be modified by specifically identifying all matters the party believes were misapprehended or overlooked, and the place where each matter was addressed previously in a motion, opposition, or a reply. 37 C.F.R. § 42.71(d). When rehearing a decision on institution, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may arise 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. *Star Fruits S.N.C. v. United States*, 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

⁴ With regard to the ground based solely on Thro, we determined that the Petition failed to show that Thro discloses the “dynamically reassigning” limitation. Dec. 13–15. That determination is not part of the request for rehearing, and, therefore, we do not discuss it further.

F.3d 1305, 1315–16 (Fed. Cir. 2000).

Petitioner challenges our exercise of discretion to deny institution as to claim 1. Req. Reh’g 13. In particular, Petitioner argues that “[b]ecause the Examiner did not articulate a specific basis for concluding that Jasinski fails to disclose these elements of claim 1, Petitioner could not point to specific errors in the Examiner’s application of Jasinski to claim 1.” *Id.* at 13.

Concerning claim 10, Petitioner argues that we misapprehended the ground presented. In particular, Petitioner points out that it asserted a combination of Thro with Jasinski, and that our determination that Jasinski was considered for claim 10 during examination overlooks or misapprehends that (1) the Examiner did not consider Thro in combination with Jasinski as Petitioner has; (2) there is no evidence that the Examiner considered the specific embodiment of Jasinski that Petitioner cited at column 12, lines 41–48; and (3) the Examiner’s Statement of Reasons for Allowance does not indicate that the withdrawal of the Jasinski rejection was based on the portion of the “dynamically reassigning” limitation for which Petitioner relies on Jasinski. Req. Reh’g 4–11.

At the heart of Petitioner’s arguments is a disagreement with our finding that the evidence of record supported our conclusion that the Examiner fully considered Jasinski for both claim 1 and claim 10. More importantly, Petitioner argues the inequities of applying our discretion under § 325(d) when prior art was before the Examiner, but not analyzed in detail or applied to the pertinent claim. Req. Reh’g 14. According to Petitioner: “If the Board is to refuse to consider whether the prior art discloses the limitation the Examiner alleged were missing, the Board would effectively

create an irrebuttable presumption that the Examiner's inaction was correct and deprives the petitioner of the best way to show Examiner error." *Id.*

In view of these arguments, we explain below in more detail the factors that the panel considered in exercising discretion under § 325(d) when the same or substantially the same prior art or arguments have been presented previously during examination. We also reiterate below our findings in connection with the Office's evaluation of Jasinski during examination. Finally, we determine, as discussed further below, that, as a matter of procedural fairness and in consideration of agency resources, the extent to which the Examiner evaluated the prior art on the merits and applied it to at least one issued claim warrants exercising discretion under § 325(d) on grounds based in whole or in part on the prior art previously presented during examination.

B. DISCRETIONARY NON-INSTITUTION UNDER SECTION 325(D)

1. Evaluation by the Board

Section 325(d) states that "[i]n determining whether to institute . . . the Director may take into account whether, and reject the petition . . . because, the same or substantially the same prior art or arguments previously were presented to the Office." In evaluating under § 325(d) whether to exercise our discretion regarding institution when the petition asserts prior art or arguments alleged to have been presented previously during examination, panels have considered several *non-exclusive* factors:

- 1) The similarities and material differences between the asserted art and the prior art involved during examination;

- 2) The cumulative nature of the asserted art and the prior art evaluated during examination;
- 3) The extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- 4) The extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- 5) Whether Petitioner has shown that the Examiner erred in evaluating the asserted prior art; and
- 6) The extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Each case is evaluated on its own facts, and each case may include some or all of the above-identified factors. Further, additional circumstances, not fitting within any of the listed factors, may be relevant to our exercise of discretion under § 325(d) in the context of examination.⁵

The Board has articulated these factors in various cases involving the applicability of § 325(d) in the context of examination.⁶ We are also

⁵ See, e.g., *Kayak Software Corp. v. IBM*, Case CBM2016-00075, slip op. at 7–8 (PTAB Dec. 15, 2016) (Paper 16) (evaluating, among other factors, the 11 years of prosecution history, which included multiple appeals to the Board where some of the references were at issue).

⁶ See, e.g., *Palo Alto Networks v. Finjan*, Case IPR2015-01999, slip op. at 6–8 (PTAB Mar. 29, 2016) (Paper 7) (evaluating the similarities between the asserted art and the references relied on during examination and determining the extent arguments considered during examination); *Agrinomix v. Mitchell Ellis Prods.*, Case IPR2017-00525, slip op. at 11 (PTAB June 14, 2017) (Paper 8) (determining whether asserted prior art was before the Examiner

mindful that our discretion under § 325(d) involves a balance between several competing interests. “On the one hand, there are the interests in conserving the resources of the Office and granting patent owners repose on issues and prior art that have been considered previously.” *Fox Factory, Inc. v. SRAM, LLC*, Case IPR2016-01876, slip op. 7 (PTAB Apr. 3, 2017) (Paper 8). “On the other hand, there are the interests of giving petitioners the opportunity to be heard and correcting any errors by the Office in allowing a

during prosecution); *Inogen v. Separation Design Grp. IP Holdings*, Case IPR2017-00300, slip op. at 31–33 (PTAB May 19, 2017) (Paper 8) (considering whether the asserted art is cumulative of any reference that previously was before the Office during examination); *Hengdian Grp. DMEGC Magnetics Co., Ltd., v. Hitachi Metals, Ltd.*, Case IPR2017-01313, slip op. at 4–5 (PTAB Dec. 21, 2017) (Paper 9) (“Where, as here, a prior art reference presented in a petition was already considered substantively by the Examiner, the petitioner has the initial burden to identify any errors made by the Examiner with respect to that reference.”); *Dorco Co. v. The Gillette Co.*, Case IPR2017-00500, slip op. at 18–19 (PTAB June 21, 2017) (Paper 7) (considering whether Petitioner identifies errors by the Office or explains why the Office should revisit the patentability issues the Examiner considered, and also considering the overlap of arguments); *Neil Ziegmann, N.P.Z., Inc. v. Stephens*, Case IPR2015-01860, slip op. 9–10 (PTAB Sept. 6, 2017) (Paper 13) (“when a prior art reference presented in a petition was already considered substantively by the Examiner, the petitioner has the initial burden to identify [] errors made by the Examiner with respect to that prior art reference”); *Hyundai Mobis Co. et al. v. Autoliv ASP*, Case IPR2014-01005, slip op. at 44–45 (PTAB Jan. 14, 2015) (Paper 10) (stating that Petitioner’s challenge includes new arguments and new supporting evidence, such as expert testimony, shedding a different light on the prior art); *Prism Pharma v. Choongwae Pharma Corp.*, Case IPR2014-00315, slip op. at 12–13 (PTAB July 8, 2014) (Paper 14) (informative) (evaluating the overlap of the arguments in examination and the contentions presented by Petitioner).

patent—in the case of an *inter partes* review—over prior art patents and printed publications.” *Id.*

2. Discussion of Factors

In the Decision on Institution, we considered certain factors pertaining to the exercise of discretion under § 325(d), and denied institution on the grounds based on Jasinski. Dec. 7–13. By way of summary, the Decision provides that Jasinski, and arguments concerning its disclosure, were previously presented during examination, and that Petitioner proffered no compelling reason for reconsidering Jasinski, despite Petitioner’s efforts to cast Jasinski as including subject matter that the Examiner overlooked. *Id.* A discussion of the listed factors follows.

a. Factors One and Two: Similarities and Cumulativeness

The first two factors focus on how much of Petitioner’s asserted prior art the Office previously evaluated. The focus is on discerning the overlap and differences between the prior art asserted in the Petition and the prior art previously considered during examination. There may be circumstances in which, for example, the asserted prior art is not the same art previously considered, but its content is cumulative to what the Examiner previously considered. Here, as stated in our Decision on Institution, it is undisputed that Jasinski is the same prior art that was considered during examination and was the basis for rejection of examined claims of the ’403 patent. Dec. 9–10. In this case, therefore, there is no difference between the asserted

prior art in the Petition and the prior art Patent Owner alleges the Office evaluated during examination.⁷

b. Factor Three: Previous Evaluation

With respect to factor three, we look at the asserted grounds and the manner, if any, in which the prior art was applied previously. In the present case, claims 1 and 10 underwent different rejections. In the same Office Action, although claim 10 was rejected over Jasinski, claim 1 was not. See Section II.A., *supra*. Notwithstanding this difference, we determined that, in rejecting claim 10 over Jasinski, the Examiner also had evaluated Jasinski sufficiently to determine Jasinski's relevance to claim 1. More specifically, the Decision on Institution states that

even though the Examiner did not reject now-claim 1 over Jasinski, we are persuaded that the Examiner substantively considered Jasinski's disclosure of a simulcast system and was aware of Jasinski's timing diagram and the various transmissions of the addresses and messages. Thus, we do not agree with Petitioner's contention that the Examiner did not consider "the second interval messages" sent in "simulcast/pseudo-simulcast by multiple transmitters." See Pet. 35.

Dec. 11. Petitioner takes issue with this determination, arguing that "[o]f course, an IPR may use prior art that was cited during the original prosecution." Req. Reh'g 12. According to Petitioner, "the mere fact that Ground 1 is based on Jasinski is not enough to deny institution." *Id.* at 13.

⁷ In our Decision on Institution, we did not apply the cumulativeness factor because Patent Owner's argument focused on the fact that Jasinski was the same prior art previously presented to the Office.

With regard to claim 10, Petitioner also takes issue with the original panel's determination regarding consideration of Jasinski during examination. Specifically, Petitioner contends that the panel overlooked that a portion of Jasinski cited in the Petition was not cited with particularity anywhere in the Office Action. Req. Reh'g 8–10. For instance, Petitioner argues that there is no evidence that the Examiner considered column 12, lines 41–48 of Jasinski during prosecution or how that disclosure would render the claims obvious when considered as presented in the Petition. *Id.* at 9–10.

Petitioner's arguments miss the point and conflict with the plain reading of § 325(d). Although a petition for *inter partes* review may assert grounds of unpatentability based on prior art patents or printed publications cited during examination, the Board is not compelled to institute on *any ground* relying on previously presented prior art or arguments.⁸ For instance, § 325(d) provides that we may take into account whether, and “*reject the petition*” because, the same or substantially the same prior art was previously presented to the Office. Therefore, applying the discretionary authority regarding institution appropriately may result in a denial of all grounds based in whole or in-part on prior art that was previously evaluated during examination. Petitioner does not direct us to any statutory language or other binding legal authority that curtails the Director's authority to deny

⁸ Although we address here the applicability of § 325(d), not § 314(a), *Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016), is instructive: “the PTO is permitted, but never compelled, to institute an IPR proceeding.”

review only in the circumstances where an Examiner's rejection and the petition's ground of unpatentability are identical.⁹ Accordingly, it is within our statutory authority to exercise discretion and deny the Petition on all grounds based on Jasinski once we deem Jasinski to have been presented to the Office during examination.

With regard to this factor, we deemed important that: (1) the Examiner rejected at least one claim, claim 10, over Jasinski; and (2) the portions of the prior art the Examiner cited showed awareness of the reference's contents. *See* Dec. 10 (evaluating the rejection of claim 10 and the cited portions of Jasinski to determine that the Examiner was aware of Jasinski's disclosure of simulcast communications). Further, we determined that, even though the Examiner did not cite the specific embodiment on which Petitioner now relies with regard to claim 1, the Examiner substantively addressed Jasinski's simulcast system and timing diagrams. *Id.* at 11 (expressing our disagreement with Petitioner's contention that the Examiner did not consider certain portions of Jasinski alleged to render obvious claim 1 in the Petition at page 35).

None of Petitioner's arguments on rehearing persuade us that we misapprehended or overlooked the contention that certain portions of Jasinski were not cited in prosecution for either of the challenged claims. *See* Req. Reh'g 4–10, 12–14. We have stated above that our analysis in the Decision on Institution focused on whether the Examiner substantively

⁹ *See* Req. Reh'g 7–8 (arguing that decline of exercise of discretion under § 325(d) is warranted when the petition relies on a combination of previously presented prior art with additional reference(s) not involved in the prior proceeding).

addressed Jasinski, thus evincing awareness of its contents during the examination of the pending claims of the '403 patent. *See* Dec. 10–11. In essence, we have drawn an inference from the substantive discussion and rejections made during examination that the Examiner considered Jasinski fully and for all the limitations of the claims, regardless of the specificity with which the Examiner articulated the findings and conclusions drawn from Jasinski for any particular claim limitation.

This inference is consistent with how other panels have evaluated the Examiner's actions during examination. For example, in *Hyperbranch Medical Technologies v. Incept LLC*, Case IPR2016-01836, slip op. at 13 (PTAB Apr. 4, 2017) (Paper 14), although the Examiner did not cite a specific embodiment of the prior art reference, the panel concluded that the Examiner's discussion of the prior art in general was sufficient to infer that the Examiner found that the specific embodiment did not satisfy the disputed claim limitation. As another example, in *Agrinomix, LLC, v. Mitchell Ellis Products, Inc.*, Case IPR2017-00525, slip op. at 10–12 (PTAB June 14, 2017) (Paper 8), the panel concluded that although the Examiner may have relied upon the prior art reference only to address the limitation of a dependent claim, that does not obviate the fact that the prior art reference was before the Examiner and the Examiner relied on it to reject certain claims during examination.

The inference we have drawn is further supported by the Office's examination procedures, where an Examiner is charged with applying the best references to the pending claims and to cite complex prior art as particularly as possible. *See* 37 C.F.R. § 1.104(c)(2) (stating, for example, that “the Examiner must cite the best references at his or her command” and

that when “a reference is complex . . . the particular part relied on must be designated as nearly as practicable”);¹⁰ *see also* MPEP § 707.07(g) (stating that “the Examiner should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references”). In essence, an Examiner is tasked with applying the prior art he considers the best to all the pending claims in order to avoid multiplicity of rejections and to produce as streamlined an Office Action as possible. This Office procedure persuades us that when reviewing an Examiner’s rejection, it is proper to infer that all prior art discussed substantively in the rejection has been considered for its applicability to all the pending claims. Further, we may infer that although the Office Action cites specific portions of a reference in a rejection, the entirety of that reference has been evaluated.

Here, we reiterate, the Examiner dealt with Jasinski substantively in the Office Action that rejected both claims 1 and 10. In addressing Jasinski substantively and citing to portions of Jasinski, we determine that the Examiner was aware of the entire reference and that he or she evaluated Jasinski’s applicability to the pending claims, notwithstanding the citation to only certain portions of the reference. This determination was important in deciding whether to exercise our discretion and reject the petition on all grounds based on Jasinski.

¹⁰ Codified also in Manual of Patent Examining Procedure (“MPEP”) § 707. This provision appears in all MPEP versions since, at least, August 1983 (Version 5, §706, https://www.uspto.gov/web/offices/pac/mpep/old/E5R0_700.pdf).

c. Fourth Factor: Argument Overlap

This factor focuses on the overlap between the presented arguments. The Decision on Institution notes that the arguments presented in the Petition sufficiently overlap the arguments presented during examination with regard to the limitation of “dynamically reassigning,” recited in claim 10. Dec. 11–12. We noted that the applicant argued the “dynamically reassigning” limitation during prosecution, and the claim was allowed subsequently. *Id.* Petitioner argues that we misapprehended that Petitioner relies on Thro in combination with Jasinski, not Jasinski alone, to teach the limitation. Req. Reh’g 4–8. This argument is not persuasive. We did not misapprehend Petitioner’s ground. As stated in the Decision:

The instant Petition relies on Jasinski as teaching this [“dynamically reassigning”] limitation in combination with Thro. The argument presented is premised on Jasinski’s teaching of “accounting for message length” to implement Thro’s “prioritization algorithm.” But the disclosure of the longer message transmission in Jasinski was already considered as this is precisely what Jasinski sought to solve with its method of transmitting at higher speeds in zones, with one or more transmitters, where the transceiver is found.

Dec. 11–12 (internal citations and emphases in original omitted). That is, we found, and we reiterate here, that the Examiner evaluated Jasinski’s teachings for the entirety of the “dynamically reassigning” limitation, which includes the requirement that the assigning occurs “as a function of the messages to be communicated in the area.” *Id.* Petitioner has submitted Jasinski for the same limitation with the caveat that Jasinski provides a teaching of “a function of the message to be communicated in an area.” See Pet. 86 (“To the extent it is argued that further disclosure is required,

Jasinski teaches dynamically reassigning one or more base station transmitters as a function of the messages to be communicated in an area.”). Adding Thro and expert testimony to the ground concerning claim 10 does not overcome these facts.

We find that the limitation for which Petitioner relies on Jasinski was expressly addressed during prosecution, and therefore, the same or substantially the same argument was previously presented under § 325(d). Moreover, our discussion here builds on the Previous Evaluation (Third) factor, in which we have addressed that claim 10 was rejected over Jasinski, and, therefore, the same prior art was previously presented under § 325(d).

d. Fifth Factor: Examination Error

This factor concerns whether Petitioner sufficiently points out Examiner error that warrants revisiting either Jasinski’s applicability to claim 1 or Jasinski’s teaching of message length, in combination with Thro, for claim 10. In our Decision on Institution, we stated that “we have been presented with no other reasoning showing Examiner error that would warrant reconsidering Jasinski.” Dec. 11. As noted above, Petitioner contends that our determination regarding Petitioner’s failure to show error creates an irrebuttable presumption because it deprives Petitioner of any way to show Examiner error. Req. Reh’g 14. To be sure, this argument is presented for our determination concerning claim 1, where the Examiner did not reject the claim over Jasinski, and, therefore, the record is silent as to the Examiner’s rationale for not doing so.

We recognize that in a situation such as this case—where Petitioner seeks to rely on the Examiner’s silence as a compelling reason to rely on previously presented prior art—it may be difficult to show error explicitly.

As we stated above with regard to the Previous Evaluation (Third) factor, Office procedures require that Office Actions focus on reasons for rejection, rather than reasons for why a reference *does not* anticipate or render obvious the pending claims. Consistent with the Office's need to provide streamlined examination and to utilize Office resources effectively, a petitioner must articulate error in the Examiner's evaluation of the previously considered prior art. A showing of error in examination allows us to focus our resources on those matters that warrant reconsideration.

Showing an Examiner was silent regarding application of the prior art to a claim in an Office Action, where the same reference was applied to other claims in the same Office Action, is not a showing of error. First, as stated above, an Examiner is charged with applying the best prior art to all of the claims. In that vein, absent evidence to the contrary, it is reasonable to conclude that an Examiner who follows Office procedure, and with evident knowledge of Jasinski, would have applied it to claim 1, if it had been proper to do so.¹¹ We decline to assume the contrary, as Petitioner urges we do, that non-action by the Examiner is error merely because Petitioner presents the non-rejected claim mapped, in whole or in part, to the previously considered art. Instead of assuming that the Examiner failed to consider Jasinski, we have concluded that the omission of a Jasinski rejection as to claim 1, when Jasinski was applied to other claims, is an

¹¹ Indeed, the Examiner stated in the Statement of Reasons for Allowance that as to claim 1, "the prior art of record fails to show a simulcast system for transmitting from the first and second sets of transmitters a first block[] of information over a first time period and respectively transmitting the second and third blocks of information over a second time period from the first and second set of transmitters." Ex. 1002, 277.

implicit finding that the prior art was not commensurate with the scope of the claim. See IPR2016-01836, Paper 14, 13 (drawing inference that the Examiner did not consider fibrillar collagen as satisfying a claim limitation, even though the Examiner was silent regarding fibrillar collagen).

Second, a showing of explicit error, supported by the intrinsic record, balances the competing interests of Petitioner, Patent Owner, the Board, and the public. We note that Petitioner has an interest in ensuring that the patent-at-issue has undergone a deserving examination. But Patent Owner has an interest in relying on the Office Actions and procedures under which it ultimately receives the patent. The public has an interest in the agency's proper and efficient execution of its authority. Requiring a showing of explicit and intrinsic error in a petition for an AIA post-grant proceeding properly places the burden on the party who seeks to challenge the patentability of the issued claims over the same or substantially the same prior art or arguments presented previously to the Office during examination. Requiring a showing of error also ensures protection for Patent Owner, where only upon such a showing can the Board readily ascertain whether there are serious doubts about how the patent issued over the same or substantially the same prior art that the Office considered previously during examination. Further, requiring that the error is shown as specifically as practicable in the intrinsic record ensures that the Board is presented with facts available in the public record.

We also find applicable to our discussion of this factor that the threshold of institution in *inter partes* review is not the same as that for reexamination proceedings, where a showing of a substantial new question of unpatentability (SNQ) must be made. Petitioner's arguments that we

revisit Jasinski parallel those for showing a substantial new question of patentability. See MPEP § 2216 (“[A] substantial new question of patentability may be based on art previously considered by the Office if the reference is presented in a new light or a different way that escaped review during earlier examination”). But for AIA post-grant proceedings the threshold of institution is higher than that of showing an SNQ.¹² It is rational to conclude that if the reasonable likelihood threshold is stricter than an SNQ threshold, it would be insufficient for Petitioner to argue that we should revisit the unpatentability of claim 1 merely because the claim was not rejected over Jasinski. A compelling reason, such as a showing of explicit and intrinsic error, is needed in order to keep the protections for patent owners that Congress sought to impose by establishing the reasonable likelihood threshold for institution. Although we are deciding whether to exercise our discretion under section 325(d), not section 314(a), where the institution threshold is codified, we recognize that the core of our analysis under section 325(d) is also whether we should exercise our discretion and determine whether to institute *inter partes* review in light of the previously presented prior art and arguments.

¹² See, e.g., 112 Cong. Rec. S1375 (daily ed. March 8, 2011) (Senator Kyl Remarks) (“Among the most important protections for patent owners added by the bill are its elevated thresholds for instituting *inter partes* and post grant reviews. The present bill dispenses with the test of “substantial new question of patentability,” a standard that currently allows 95 percent of all requests to be granted. It instead imposes thresholds that require petitioners to present information that creates serious doubts about the patent’s validity.”)

e. Sixth Factor: Additional Evidence

As we stated in our Decision on Institution, providing a declaration alone is insufficient to overcome the circumstances presented here. Dec. 12. Neither party presents other persuasive circumstances, facts, or evidence concerning whether reconsideration of Jasinski for the challenged claims is warranted.

3. Evaluation of Factors

We have spelled out our reasoning for exercising our discretion here in more detail than we did in our Decision on Institution, but the facts and evidence have not changed. We are not persuaded that we misapprehended the way in which Petitioner proffered the grounds based on Jasinski, and we have been shown no legal authority or other persuasive rationale for why we should exercise our discretion differently or not at all. Our evaluation of the factors confirms our exercise of discretion because we have determined that the Examiner substantively considered the Jasinski reference for all the pending claims, and that Petitioner has not shown explicit error in the Examiner's evaluation of Jasinski such that reconsideration of Jasinski is warranted. The fact that Petitioner proffers a ground combining Jasinski with Thro and declaration testimony does not persuade us otherwise. Accordingly, we see no reason to modify our Decision on Institution.

III. ORDER

After due consideration, it is

ORDERED that Petitioner's Request for Rehearing is *denied*.

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Patent 5,590,403

PETITIONER:

Gabrielle E. Higgins
Kathryn N. Hong
ROPES & GRAY LLP
gabrielle.higgins@ropesgray.com
kathryn.hong@ropesgray.com

Nima Hefazi
IRELL & MANELLA, LLP
nhefazi@irell.com

Ronald Wielkopolski
Don F. Livornese
RUYAK CHERIAN LLP
ronw@ruyakcherian.com
donl@ruyakcherian.com

Patrick McPherson
Joseph A. Powers
Patrick Muldoon
DUANE MORRIS LLP
PDMcPherson@duanemorris.com
JAPowers@duanemorris.com
PDMcPherson@duanemorris.com

PATENT OWNER:

John R. Kasha
Kelly Kasha
KASHA LAW LLC
john.kasha@kashalaw.com
kelly.kasha@kashalaw.com