

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GUEST-TEK INTERACTIVE ENTERTAINMENT LTD.,
Petitioner,

v.

NOMADIX, INC.,
Patent Owner.

Case IPR2018-00376
Patent 8,266,266 B2

Before STEPHEN C. SIU, DANIEL J. GALLIGAN, and
MONICA S. ULLAGADDI, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

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

Guest-Tek Interactive Entertainment Ltd. ("Petitioner") requests reconsideration of the Board's decision, issued June 29, 2018 (Paper 9, "Dec." or "Decision"), denying institution of *inter partes* review of claims 1–28 of U.S. Patent No. 8,266,266 B2 ("the '266 patent," Ex. 1001). Paper

10 (“Req. Reh’g.). For the reasons discussed below, we deny the request for rehearing.

As an initial matter, prior to the issuance of the Decision on June 29, 2018, a draft of the Decision was posted prematurely and erroneously on June 19, 2018. When the error was discovered shortly thereafter, the draft decision was expunged.

When rehearing a decision on a petition, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus., Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” 37 C.F.R. § 42.71(d).

Petitioner specifically requests rehearing of the Board’s denial of institution regarding the asserted ground of obviousness over Slemmer¹ and Vu.² Req. Reh’g 1. In particular, Petitioner argues that “the Board issued a decision instituting *inter partes* review of the ’266 patent” on June 19, 2018, which, according to Petitioner, “was the correct one.” Req. Reh’g. 2–3. As noted above, the “decision” to which Petitioner refers was issued in error and was therefore subsequently expunged. That the “decision” posted on June 19, 2018 was prematurely posted in error is supported by Petitioner’s observation that the “decision” posted on June 19, 2018 “identified only a

¹ US 6,226,677 B1, May 1, 2001 (Ex. 1003, “Slemmer”).

² US 5,623,601, Apr. 22, 1997 (Ex. 1004, “Vu”)

single member of the panel” but that “trial institution decisions are made by the panel in concert, not by a single APJ for subsequent approval.” Req. Reh’g. 4–5.

Petitioner requests “clarification” as to “why the Original Decision instituting review [i.e., the “decision” erroneously posted on June 19, 2018] was expunged and replaced with the New Decision denying review [i.e., the Decision correctly posted on June 29, 2018].” Req. Reh’g. 3. We provide the following clarification. The “Original Decision” (i.e., the draft decision that was erroneously posted on June 19, 2018) was, as discussed above, posted erroneously. To correct this error, we determined that the best course of action would be to expunge the erroneously posted document. The “New Decision denying review” (i.e., the correctly posted Decision dated June 29, 2018) was then issued in due course on June 29, 2018.

Petitioner requests “clarification” as to “why the Board denied the Petition despite previously instituting review in *Hospitality Core Servs.* [i.e., IPR2016-00077] based on the same prior art and reasoning as in the Petition here.” Req. Reh’g. 3.

The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

35 U.S.C. § 314(a). Notably, we must base our determination of a “reasonable likelihood” that Petitioner would “prevail” on “the information presented in the petition,” specifically. In the present case, Petitioner has not provided a basis, legal or otherwise, in support of its position that we must determine a “reasonable likelihood” based on information presented in *some*

other petition, much less based on *some other* evidence of record in another proceeding. For example, in IPR2016-00077, the panel based its decision on a “Declaration by Mr. Keith Olsen.” That evidence is not of record in this proceeding.

Petitioner argues that “the Board apparently used an erroneous claim construction for the term ‘TCP connection hand shake completion data,’ which resulted in an incorrect determination.” Req. Reh’g. 5. In particular, Petitioner now proposes a broadest reasonable construction of the term “TCP connection hand shake completion data” to mean “two devices initiating a communication session by the first device sending information to a second device, and the second device then responding to the first device.” Req. Reh’g. 7. Based on this newly proposed construction of the term “TCP connection hand shake completion data,” Petitioner argues that Vu discloses this feature. Req. Reh’g. 6–8. Under 37 C.F.R. § 42.71(d), Petitioner must “identify all matters [Petitioner] believes the Board misapprehended or overlooked.” Petitioner did not present this proposed construction in the Petition. *See generally* Req. Reh’g.; *see generally* Pet. We could not have “misapprehended or overlooked” what was not presented.

Petitioner argues that we overlooked Petitioner’s arguments supporting Petitioner’s position that it would have been obvious to one of ordinary skill in the art to have combined the cited references. Req. Reh’g. 8–10. In particular, Petitioner reiterates previous arguments presented in the Petition such as “Vu is one of the first prior art references to teach the handshake” but that “other prior art references also teach it.” Req. Reh’g. 9. These arguments were previously addressed. Decision 7–8. Although Petitioner may disagree with our resolution of the arguments that Petitioner

presented in its Petition, such arguments were considered fully in our Decision.

Patent Owner argues that we overlooked Petitioner's argument that a panel in the "the *Hospitality Core* decision" stated that "one of ordinary skill, based on Vu, would have utilized a handshake in Slemmer's Gateway." Req. Reh'g. 9. We note that the panel in IPR2016-00077 (i.e., the "*Hospitality Core*" case) based that finding on evidence not of record in the present case. We based our Decision on the evidence of record before us in *this* case and not on evidence in the record in *some other* proceeding.

Petitioner argues that the evidence of record in IPR2016-00077 supposedly establishes that it would have been obvious to one of ordinary skill in the art to have combined the teachings of Slemmer and Vu but acknowledges that "Petitioner did not repeat those arguments . . . in its Petition here." Req. Reh'g. 10. As stated above, under 35 U.S.C. § 314(a), we must base our determination of a "reasonable likelihood" that Petitioner would "prevail" on "the information presented in the petition" and not based on arguments and evidence not of record but possibly present in *some other* record.

Petitioner's Exhibit 1013 (i.e., the erroneously posted decision of June 19, 2018) will be expunged.

CONCLUSION

For the foregoing reasons, the Board did not abuse its discretion in denying institution as to the asserted ground of obviousness over Slemmer and Vu. Accordingly, Petitioner's request for rehearing is *denied*, and Exhibit 1013 is expunged.

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