

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

FLECTERE LLC,
Patent Owner.

Case IPR2019-00479
Patent 6,415,284 B1

Before DAVID C. McKONE, JASON W. MELVIN, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

BELISLE, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Unified Patents Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 1–21 of U.S. Patent No. 6,415,284 B1 (Ex. 1001, “the ’284 patent”). Flectere LLC (“Patent Owner”) is identified as the owner of the ’284 patent (Paper 5), and waived filing of a Preliminary Response (Paper 6). On July 2, 2019, the Board entered a Decision on Institution (Paper 9, “Decision” or “Dec.”) in this proceeding, determining that Petitioner had not demonstrated a reasonable likelihood of prevailing in showing the unpatentability of at least one challenged claim of the ’284 patent. Dec. 2, 26. Petitioner timely filed a Request for Rehearing of the Decision. Paper 10 (“Request”).

For the reasons discussed below, Petitioner has not demonstrated that the Board abused its discretion in denying institution, and the Request is denied.

II. STANDARD OF REVIEW

When considering a request for rehearing of a decision on a petition, the Board reviews a decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may be determined 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 Arnold Partnership v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004). 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). “The burden of showing a decision should be
modified lies with the party challenging the decision.” *Id.*

III. ANALYSIS

A. Ground 4: Alleged Misapprehension/Overlooking of Evidence and Argument Regarding Sheffield

Petitioner argues “[t]he Petition explicitly provides evidence that
Sheffield alone discloses Element 1.3,” as well as the remaining limitations
in claim 1, and “the Decision does not acknowledge this express disclosure
in *Sheffield* or address Petitioner’s position.” Request 3.

First, Petitioner’s argument here is belied by Ground 4 itself.
If *Sheffield* alone were to disclose every limitation of claim 1 expressly, then
Ground 4 would be an anticipation ground. But it is not—the Petition stated
“Petitioner requests review on the following grounds: . . . [Ground 4:]
Sheffield in view of Whitmyer renders claims . . . *obvious under 35 U.S.C.*
§ 103(a).” Pet. 4 (emphasis added). Moreover, in Ground 4, Petitioner
argued as to each of Elements 1.P, 1.1, and 1.2 that “*Sheffield discloses [it]*
or at least renders [it] obvious” (Pet. 67–69 (emphasis added)), but as to
Element 1.3, Petitioner instead argued “*Sheffield in view of Whitmyer*
renders obvious element 1.3” (Pet. 70 (emphasis added))—this is not an
argument that *Sheffield* “alone discloses Element 1.3.”

Second, in the Petition, Petitioner neither argued nor explained how
Sheffield alone expressly discloses “sending the data-entry form” itself with

verification logic “through a computer network,” which is a limitation in Element 1.3. *Compare* Pet. 71, with Request 3. The Petition states:

Sheffield also discloses “***sending the verification logic through a computer network [...] to a remote computer.***” For example, Sheffield discloses that form definitions and validation rules for a given DataWindow form 24 are stored in the database 26, but executed by a client 102. Moreover, Sheffield discloses that clients 102 execute the “validation rules” (“***verification logic***”) which are stored in database 26. A POSITA would have understood that in order to execute the “validation rules” stored in database 26, those rules must be sent to each client 102, which is located “***remote[ly]***” from database 26.

To the extent that Sheffield does not expressly disclose “***sending the data-entry form***” itself “***through a computer network,***” however, doing so would have been obvious to a POSITA.

Pet. 71 (citations omitted). The Request now contends:

The Petition explains that Sheffield “discloses that form definitions and validation rules for a given DataWindow form 24 are stored in the database 26.” Because these validation rules are “executed by a client 102” and each client 102 is located “remote[ly]” from database 26, the Petition explains that a skilled artisan “would have understood that those rules must be sent to each client 102 [via the network].” However, the Decision does not acknowledge this express disclosure in *Sheffield* or address Petitioner’s position.

Request 3 (citations omitted). Contrary to Petitioner’s argument, the Board did acknowledge this disclosure in the Decision at pages 20–21 (“Petitioner also argues that Sheffield teaches sending the verification logic through a computer network to a remote computer.”). Also contrary to Petitioner’s argument, the “express disclosure” in Sheffield discussed above is argued in

the Petition to disclose “sending the verification logic through a computer network [...] to a remote computer,” and is not argued to disclose “sending the data-entry form” itself with verification logic “through a computer network,” as required by Element 1.3. *See* Pet. 67–76. Although the Petition stated, “[t]o the extent that Sheffield does not expressly disclose ‘**sending the data-entry form**’” (Pet. 71), Petitioner did not argue in the Petition that Sheffield *does* expressly disclose such features (hence, Ground 4 being based on obviousness).

Accordingly, the Board could not have misapprehended or overlooked argument or evidence that Petitioner did not present.

B. Ground 4: Alleged Misapprehension/Overlooking of Evidence and Argument Regarding Rationale for Combining Sheffield and Whitmyer

Petitioner argues the Board overlooked various reasons (and supporting intrinsic and extrinsic evidence) for why the skilled artisan would have combined Sheffield and Whitmyer. Request 4–12. More specifically, Petitioner asserts the Board overlooked three obviousness rationales purportedly argued in two short paragraphs in Petition pages 74–75 (*see* Request 4–5), despite the Decision citing, quoting, and discussing those two paragraphs (*see* Dec. 20–25). Indeed, Petitioner argues in eight pages in the Request what it allegedly already argued in these two paragraphs in the Petition. *See* Request 4–11. Initially, we note that just because the Board was not persuaded by Petitioner’s arguments and evidence for purposes of institution does not mean that we overlooked or misapprehended Petitioner’s

arguments and evidence, and importantly, a request for rehearing is not an opportunity to supplement a petition.

Before turning to the three obviousness rationales that the Board allegedly overlooked, we reproduce below the entirety of the two subject paragraphs in Petition pages 74–75 in which Petitioner purportedly provided these rationales:

A POSITA would have recognized that Sheffield contains a strong suggestion that the entirety of each form (*i.e.*, the form and its “**verification logic**”) could be transmitted through the network to the remote computer. This is because Sheffield discloses that the definitions for each DataWindow form 24 are stored on the server in the same database as the validation rules. This, in turn, would have led a POSITA to believe that incorporating the functionality of Whitmyer into Sheffield’s system could have been accomplished with a reasonable expectation of success.

Given the similarities in structure and operation between Sheffield and Whitmyer, a POSITA with knowledge of Sheffield would have been motivated by Whitmyer to improve Sheffield’s system by using incorporating Whitmyer’s ability to send entire forms via a network. Whitmyer discloses not only that it is advantageous to send electronic forms via a computer network, but also how to implement it in a system. Implementing this functionality in Sheffield would provide the same benefits. For example, including Whitmyer’s ability to send both forms and logic over a computer network to a remote client into Sheffield would allow Sheffield’s remote client terminals to receive new and/or updated electronic forms without the need to install new software on the client-side computer. Doing so would not require modification to the existing client-server system of Sheffield—and thus adding the functionality disclosed in Whitmyer would have been obvious to try.

Pet. 74–75 (citations omitted).

First, Petitioner contends it argued in the above Petition paragraphs that the invention of claim 1 would have been obvious because it combined prior art elements according to known methods to yield predictable results. *See* Request 5–8. We disagree. In the Petition, as the above paragraphs reveal, Petitioner did not argue with particularity, for example, that the alleged combination of familiar elements does no more than yield “predictable results.” We are not persuaded that Petitioner’s generic use of the phrase “strong suggestion” invoked this argument. Petitioner also argues that its expert presented evidence of predictable results. Request 7 (citing Ex. 1002 ¶¶ 163–164). Nevertheless, Petitioner did not make this argument in the Petition and, instead, cited large portions of their expert’s declaration without specificity. Pet. 71 (citing, *inter alia*, Ex. 1002 ¶¶ 156–166). *See also* 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated by reference from one document into another document.”).

Second, Petitioner contends it argued in the above Petition paragraphs that the invention of claim 1 would have been obvious because it applied a known technique (Whitmyer) to a known device ready for improvement (Sheffield) to yield predictable results. *See* Request 8–10. We disagree. In the Petition, as the above paragraphs reveal, Petitioner did not argue with particularity, for example, that application of the alleged known technique does no more than yield “predictable results.” Petitioner again appears to be arguing that we failed to consider arguments made in the

expert report (Ex. 1002 ¶¶ 162–164) that Petitioner did not make or cite to with particularity in the Petition.

Third, Petitioner contends it argued in the above Petition paragraphs that the invention of claim 1 would have been obvious to try. See Request 10–11. We disagree. In the Petition, the above paragraphs conclude with the words “obvious to try.” Petitioner, however, did not argue with particularity, for example, that at the time of the invention there was a design need or market pressure to solve a problem, or that there were only a finite number of identified, predictable solutions thereto.

Accordingly, the Board has not misunderstood the evidence or arguments before us or incorrectly applied the law to the record evidence argued in the Petition.

C. Ground 1: Alleged Misapprehension/Overlooking of Evidence and Argument Regarding Anticipation by Tondevold

Petitioner argues the Board “misapprehends the disclosure of *Tondevold*,” and that “the Petition relies on the disclosure in *Tondevold* that an *un-completed* form with form definitions (*i.e.*, the claimed ‘verification logic’) is sent from the host to a node (*i.e.*, the claimed ‘remote computer’) in order to be completed at the node.” Request 12–13. Petitioner also argues that Tondevold discloses that “the form and form definitions must be sent to the node in the first place.” Request 14.

First, the Board did not misapprehend Petitioner’s argument that Tondevold allegedly discloses sending a data-entry form with verification logic through a computer network to a remote computer. To the contrary, the Board determined “Petitioner does not direct us with particularity to any

disclosure in Tondevold of [such a feature].” Dec. 13–14 (“[W]e do not find in the portions of Tondevold cited by Petitioner a description of host computer 40 disseminating new or updated forms to nodes 42.”). Even in the Request, Petitioner does not state with particularity which specific disclosure in Tondevold explicitly discloses sending a data-entry form with verification logic through a computer network to a remote computer. See Request 12–14. To the extent that Petitioner relies on Tondevold’s disclosure of “*allowing forms to be created and sent to and from a number of locations*” (Request 13; Ex. 1003, 6:41–44 (emphasis altered)), such reliance is misplaced. Indeed, Petitioner proffers that sentence fragment out of context—in context and in the same paragraph, the “forms” being sent “to and from” locations are not actually data-entry forms with verification logic, but merely files of raw data corresponding to the blank fields in forms. See Ex. 1003, 6:37–61 (“[O]nly the data file of raw data corresponding to the blank fields in a form . . . must be sent between any node 42 and the host computer 40 to pass a form.”).

Second, Ground 1 in the Petition relies on anticipation by Tondevold. To serve as an anticipatory reference, “the reference must disclose each and every element of the claimed invention, whether it does so explicitly or inherently.” *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009). “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given

set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations and internal quotations omitted). In the Petition, Petitioner did not argue that Tondevold inherently discloses sending a data-entry form with verification logic through a computer network to a remote computer. *See* Pet. 36–40. In the Request, Petitioner now argues that in Tondevold “the form and form definitions *must be sent* to the node in the first place” (Request 14 (emphasis added)), but even here Petitioner stops short of arguing that Tondevold necessarily discloses sending a data-entry form with verification logic through a computer network to a remote computer. Indeed, Tondevold could send data-entry forms with verification logic from the host to remote computers by more than one means, such as, for example, by distributing portable storage devices for manual upload or through a computer network. As stated in the Decision, the Board did not find in the portions of Tondevold cited in the Petition (or Request) an explicit description of how Tondevold’s host computer 40 disseminates new or updated forms to nodes 42 (Dec. 14), and Petitioner has neither argued nor shown such a feature to be inherent in Tondevold.

Accordingly, the Board has not misunderstood the evidence or arguments before us or incorrectly applied the law to the record evidence argued in the Petition.

D. Ground 2: Alleged Misapprehension/Overlooking of Evidence and Argument Regarding Rationale for Obviousness Over Tondevold

Petitioner requests rehearing as to Ground 2 (obviousness over Tondevold), in addition to Ground 1 (anticipation by Tondevold), but makes no separate argument as to Ground 2. *See* Request. Thus, for the same

reasons set forth above as to Ground 1, the Board has not misunderstood the evidence or arguments before us or incorrectly applied the law to the record evidence argued in the Petition as to Ground 2.

IV. CONCLUSION

We are not persuaded by Petitioner of an abuse of discretion in denying institution of an *inter partes* review of the '284 patent based on the record before us, because Petitioner did not show that the Board misapprehended or overlooked any arguments or evidence presented in the Petition.

V. ORDER

For the reasons given, it is:

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

Case IPR2019-00479

Patent 6,415,284 B1

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