

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2019-00480
Patent 8,606,856 B2

Before MIRIAM L. QUINN, CHARLES L. BOUDREAU, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

QUINN, Administrative Patent Judge.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 4.71(d)

I. INTRODUCTION

On July 8, 2019, we issued a Decision Denying Institution. Paper 8 (“Dec. on Inst.”). The panel concluded that Petitioner had not shown a reasonable likelihood of prevailing in the asserted obviousness grounds because Petitioner’s arguments concerning Boykin¹ were not persuasive and that a person of ordinary skill in the art would not have had reason to combine Boykin’s teachings with the other asserted references. Dec. on Inst. 14–21. Petitioner has filed a Request for Rehearing. Paper 9 (“Req. Reh’g”). Petitioner argues several points, but in particular, Petitioner argues that our Decision misapprehended Boykin in concluding that the Petition failed to show an adequate reason to combine. *Id.* at 9. According to Petitioner, Boykin supports the contention Petitioner presented in the Petition that Boykin triggers the incentive of awarding users with points or credits, which a person of ordinary skill in the art would find beneficial. *Id.* Petitioner then points to Dr. Vijay Madiseti’s testimony of the alleged benefit. *Id.* (citing Ex. 1004 ¶ 116). Petitioner faults our Decision for weighing Patent Owner’s arguments, which Petitioner criticizes as constituting attorney argument, and concludes that our Decision’s reasoning misapprehends that Boykin would provide a benefit despite our determination that a person of ordinary skill in the art would not derive the alleged benefit given the teachings of the other asserted references.

¹ U.S. Patent Application Publication No. 2001/0042048 A1, filed in the record as Exhibit 1007.

We are not persuaded by Petitioner's arguments because they do not point out that we misapprehended Petitioner's contentions or its evidence. First, we did not adopt Patent Owner's arguments wholesale and noted only that the arguments presented highlighted the flaw in Petitioner's case that there was no persuasive reason a person of ordinary skill in the art would have made the asserted combination. Dec. on Inst. 19. Second, we did not misapprehend the Madisetti testimony on the matter of reasons to combine. The Madisetti testimony repeats verbatim the Petition, and we considered all the arguments and evidence presented in the Petition. *Rohm & Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092 (Fed. Cir. 1997) ("Nothing in the [federal] rules [of evidence] or in our jurisprudence requires the fact finder to credit the unsupported assertions of an expert witness."). Now, if Petitioner's arguments on rehearing are instead directed to whether we should credit Dr. Madisetti because there is no opposing expert testimony, the argument does not show either legal or factual error. We did not find the Petition persuasive, which also means that we did not find Dr. Madisetti's testimony persuasive. Just because an expert regurgitates attorney argument does not make the argument either persuasive or worthy of blind acceptance when counter testimony does not exist. Third, Petitioner has the burden to show that the reasons to combine are reasonable and this includes explaining sufficiently and factually supporting stated contentions in light of evidence or facts to the contrary. Neither the Petition nor Dr. Madisetti explains how Boykin's technique, such as the free distribution of media without a key purchase, fits in with the contention that a person of ordinary skill in the art would have combined Boykin's teachings with key-encrypted file

distribution techniques. *DSS Tech. Mgmt., Inc. v. Apple Inc.*, 885 F.3d 1367, 1376 (Fed. Cir. 2018) (finding that the expert testimony focused on similarities but failed to account for the differences of the references). Petitioner's Request for Rehearing does not show that we misapprehended the matter raised, but, rather, expresses disagreement with our view of the prior art and the weight we accorded the evidence Petitioner presented to support its contentions.

Petitioner presents other arguments on rehearing alleging that we misapprehended or overlooked our discussion of Boykin on other issues. Req. Reh'g 2–8. In particular, those other arguments concern our determination that the Petition was deficient because it presented Boykin's teachings piecemeal without considering the full disclosure of Boykin. *See* Dec. on Inst. 18–19 (stating that “we are not persuaded that Petitioner's assertions regarding Boykin are proper because ‘[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.’” (citing *Bausch & Lomb, Inc. v. Barnes-Hind / Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986))). We do not discuss those arguments on rehearing further because we determine that Petitioner has not persuaded us of error in our determination concerning the reasons to combine, which is sufficient alone to deny the Petition.

Therefore, Petitioner's Request for Rehearing is denied.

IPR2019-00480
Patent 8,606,856 B2

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