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Paper 13
Date: April 3, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

IPA TECHNOLOGIES INC.,
Patent Owner.

IPR2019-00838, IPR2019-00839, IPR2019-00840
Patent 7,036,128 B1[1]

Before KEN B. BARRETT, TREVOR M. JEFFERSON, and BART A. GERSTENBLITH, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing of the Decision Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

[1] This Decision addresses the same issues in each of above-captioned cases. We exercise our discretion to issue one decision to be filed in each case. The parties are not authorized to use this style heading.

I. INTRODUCTION

In each of the above-captioned cases, Microsoft Corporation ("Petitioner") filed a Request for Rehearing (Paper 10, "Rehearing Request" or "Req. Reh'g")[2] of the Decision Denying Institution of *Inter Partes* Review (Paper 9, "Decision" or "Inst. Dec."). Petitioner requests that each denial of institution be reconsidered and reversed. Req. Reh'g 2. Microsoft also requests that the Precedential Opinion Panel ("POP") review the Decisions (Paper 11 (Notification of Receipt of POP Request)), which the POP denied (Paper 12 (Order)).

For the reasons provided below, Petitioner's Rehearing Request is *denied*.

II. ANALYSIS

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). "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." *Id.* When rehearing a decision on a petition, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c).

[2] Petitioner's Rehearing Request is substantively similar in each case and is entered in each record as Paper 10. Citations refer to IPR2019-00838 unless otherwise indicated.

A. Whether FIPA97[3] was Involved During Examination

Despite substantial overlap between the prior art before the Examiner and the prior art relied upon in Petitioner's challenges to the '128 patent, Petitioner did not address 35 U.S.C. § 325(d) in the Petition (Paper 1). Instead, Petitioner made two critical representations—(1) that the Examiner of the '128 patent "did not have FIPA97 before him, or any other FIPA reference for that matter" (Pet. 1) and (2) that despite there being seven "Parts" to FIPA97, "FIPA97 was made publicly available as a single document" and was "developed and published as a single, integrated work." Pet. 20 (citing Ex. 1055 (FIPA97 Table of Contents for Parts 1–7)); Ex. 1026, 5 (Foundation for Intelligent Physical Agents, "Resolution of Munich meeting").

In the *Petition* (Paper 1), Petitioner never contended that FIPA97 was published or available as separate and distinct parts, such that access to one part might not mean access to each other part. Rather, Petitioner's sole statement regarding separate parts was that it filed FIPA97 as seven separate exhibits "due to its size and numbering schedule." *Id.* at 20. Accordingly, on the record presented, we agreed with Petitioner's representation and we found that FIPA97 (Exs. 1006–1012) constitutes a single document, which we then found was involved during examination of the '128 patent application. Inst. Dec. 15.

In its Rehearing Request, Petitioner now contends that "[t]here is no evidence in the record that would indicate that any parts of *FIPA97*, other

[3] Foundation for Intelligent Physical Agents, *FIPA 97 Specification*, published Oct. 10, 1997 (Exs. 1006–1012, "FIPA97").

than Part 5, were before the examiner of the 128 Patent." Req. Reh'g 7 (citing Req. Reh'g 6). Petitioner asserts that "Part 5 is the only part of *FIPA97* cited on the face of the 128 Patent or referenced in the prosecution history, which, of course 'contains the ***complete record*** of all the proceedings before the Patent and Trademark Office.'" *Id.* at 7–8 (citing *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (emphasis added by Petitioner)).

Petitioner contends that despite these facts we concluded that the entirety of FIPA97 was before the Examiner because FIPA97 was made publicly available as a single document and Part 5 was before the Examiner. Req. Reh'g 8. Petitioner asserts that in making this finding, we overlooked "substantial evidence in the record that *FIPA97* **was also** released as individual parts." *Id.* (citing Pet. 20; Ex. 1054). Petitioner contends that there is "no evidence in this record the Examiner of the 128 Patent ever considered Parts 1–4 and 6–7 of *FIPA97*." *Id.* at 9.

In contrast to the arguments presented in the Rehearing Request, Petitioner did not argue, *in the Petition*, that FIPA97 was released as individual parts. Petitioner's Rehearing Request (page 8) cites to the Petition at page 20 and Exhibit 1054. Page 20 of the Petition, however, contains Petitioner's argument that FIPA97 was made publicly available as a single document, as discussed above. It does not include any argument or suggestion that FIPA97 was released as individual parts. Additionally, Exhibit 1054 is not cited on page 20 of the Petition in the discussion of FIPA97 nor does it appear that Exhibit 1054 was cited anywhere in the Petition. Thus, because Petitioner did not argue, *in the Petition*, that FIPA97

was released as individual parts, we could not have overlooked that argument.

Petitioner's contention of error in our determination that FIPA97 was involved during examination of the '128 patent application is premised upon finding that FIPA97 existed as individual parts. Because Petitioner fails to demonstrate that we overlooked an argument that was not made, we are not persuaded of error.

B. Application of the Becton *Factors*

Petitioner contends that we abused our discretion "by arriving at an unreasonable judgment in . . . weighing . . . the relevant *Becton* factors." Req. Reh'g 10. Petitioner contends that we should have weighed *Becton* factors 1–3, 5, and 6 differently. *Id.* at 10–15.

First, Petitioner contends that factors 1 and 2 should have weighed in factor of institution because only Part 5 of FIPA97 was before the Examiner. *See id.* at 10–11. This argument is essentially the same as that which we discuss and reject above.

Second, Petitioner asserts that we should have reached a different finding regarding *Becton* factor 3 because FIPA97 was not the basis for a rejection. *Id.* at 11–13. Our Decision first addressed Petitioner's primary reference—Kiss—which formed the basis of a rejection during examination of the '128 patent application's parent application. Inst. Dec. 16–17. We also found that the Examiner's citation of FIPA97 reflected that the Examiner evaluated FIPA97. *Id.* at 17. We acknowledged that FIPA97 did not form the basis of a rejection, but found that the Examiner's evaluation weighed in favor of exercising our discretion to deny institution on the

record presented. *Id.* Notably, we did not find that this factor weighed *substantially* in either direction. Further, even if we were to reconsider this finding, and instead find that this factor weighed slightly in favor of not exercising our discretion to deny institution, on balance, we nonetheless would reach the same determination.

Third, Petitioner contends that we failed to weigh factors 5 and 6 sufficiently because (a) "Petitioner did specifically point to instances where the examiner erred by failing to properly consider the agent communication language . . . of *FIPA97*" (Req. Reh'g 14) and (b) we did not properly credit Petitioner's reliance upon the remaining references as additional evidence warranting reconsideration of the prior art or arguments (*id.* at 14–15). Neither of these arguments is persuasive to show that we erred in weighing *Becton* factors 5 and 6. Petitioner did not discuss the Examiner's consideration of FIPA97; rather, Petitioner contended FIPA97 was not before the Examiner. Pet. 1. Additionally, *in the Petition*, Petitioner did not argue or explain how its reliance upon additional references or Dr. Lieberman's declaration should weigh in favor of not exercising our discretion under § 325(d) to deny institution.

III. CONCLUSION

It is worth repeating that Petitioner failed to discuss § 325(d) *in its Petition*, and, even after Patent Owner addressed § 325(d) and the *Becton* factors in its Preliminary Response (Paper 6), Petitioner did not seek leave to file a preliminary reply pursuant to 37 C.F.R. § 42.108(c) or otherwise contact the Board seeking an opportunity to address Patent Owner's arguments. A rehearing request is not a vehicle in which to raise arguments

for the first time. Here, Petitioner failed to raise any of the arguments addressed above *in the Petition*, and thus has not shown that the matter "was previously addressed" in the Petition as required by 37 C.F.R. §§ 42.71(c) and (d).

Accordingly, having considered Petitioner's Rehearing Request, Petitioner has not persuaded us, for the reasons discussed, that our Decision should be reconsidered and reversed.

IV. ORDER

For the foregoing reasons, it is

ORDERED that Petitioner's Rehearing Request (Paper 10) is *denied*.

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