

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

UNILOC 2017, LLC,
Patent Owner.

IPR2019-01584
Patent 6,519,005 B2

Before JAMESON LEE, KEVIN F. TURNER, and
THOMAS L. GIANNETTI, *Administrative Patent Judges*.

Opinion for the Board filed by Administrative Patent Judge TURNER

Opinion Concurring filed by Administrative Patent Judge GIANNETTI

TURNER, *Administrative Patent Judge*.

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

I. INTRODUCTION

On April 23, 2020, Petitioner Google LLC filed a Request for Rehearing (Paper 8, “Reh’g Req.”) under 37 C.F.R. § 42.71(d) of the Board’s Decision Denying Institution of *Inter Partes* Review (Paper 7, “Decision” or “Dec.”) of claims 1–3, 5, 6, 8, 39, and 41 of U.S. Patent No. 6,519,005 B2 (“the ’005 Patent”) per Petitioner’s Petition (Paper 1, “Pet.”). The Request is *denied*.

II. STANDARD OF REVIEW

When rehearing a decision on institution, we do not review the merits of the decision *de novo*, but instead review 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). The party requesting rehearing has the burden to show that the decision should be modified. 37 C.F.R. § 42.71(d). Additionally, the 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 in a motion, an opposition, or a reply.” *Id.*

III. ANALYSIS

The main contention raised by the Rehearing Request is that we overlooked “the relevant factors for consideration of discretionary denial under binding precedent.” Reh’g Req. 1. Petitioner asserts that “the panel majority failed to fully evaluate and address binding precedent regarding discretionary denials involving multiple petitions under section 314(a),” and if properly addressed, “[we] would have concluded that the relevant factors

weigh in favor of institution.” *Id.* at 2. In addition, Petitioner asserts that our analysis is “at odds with the AIA statutory scheme and Congressional intent behind it.” *Id.* at 3.

Petitioner’s first assertion is that we overlooked certain precedential Board decisions, namely *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper No. 19 (Sep. 6, 2017) (designated precedential in relevant part) and *Valve Corp. v. Elec.Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019) (precedential). Reh’g Req. 3. This is a curious assertion, given that *General Plastic* was specifically discussed (Dec. 12–13), and that the dissent raised *Valve Corp.* only with respect to whether a “significant relationship” exists between different petitioners. *See* Dec. 18. We are not persuaded that we overlooked either precedential decision, although we acknowledge the dissent’s view that “recent Board jurisprudence on discretionary denials is not supportive of the panel majority’s denial here.” In fact, the dissent’s assertion illustrates that the full panel considered *Valve Corp.*, although it was not considered to be in favor of Petitioner, which we discuss below.

Additionally, Petitioner asserts that “[n]othing in the Consolidated Trial Practice Guide (‘CTPG’) (which the majority cites to for the proposition that the General Plastic factors are non-exclusive), Dec. at 12, permits the Board to ignore binding precedent involving similar facts or issues.” Reh’g Req. 3–4. Petitioner also asserts that “[t]he panel majority appears to presume that the CTPG gives the Board a broad license to apply discretion however it sees fit in a given situation.” *Id.* at 4. We disagree that we ignored binding precedent in favor of some “license” supplied by the CTPG; rather, the majority cited to the CTPG for the simple proposition that the *General Plastic* factors are non-exclusive. Given that the majority

opinion considered and discussed those same *General Plastic* factors (Dec. 12–13), we cannot agree that we ignored any precedential decisions of the Board.

Petitioner continues that “reasoned balancing of the General Plastic factors favors institution.” Reh’g Req. 5 (citing Pet. 72–76). Petitioner asserts that the first factor “weighs heavily in favor of institution given the lack of any relationship between petitioners in connection with the challenged claims,” and the second factor “is inapplicable, given Google did not file any previous petition.” *Id.* at 6. Petitioner further asserts that the third factor “also weighs heavily in favor of institution,” because Petitioner could not have used the prior proceedings to “road map” its grounds because of the early stages of those proceedings. Petitioner argues that it explained the “inapplicability of the fourth and fifth *General Plastic* factors” because it did not file the earlier petitions and there was no coordination with the initial petitioners. *Id.* at 7–8. Petitioner notes “[t]he majority fails to cite to any precedential authority allowing it to consider a timeframe based on when petitioner was ‘sued’ for infringement.” *Id.* at 8. Petitioner also asserts that “the majority does not provide a reasoned basis” for the sixth factor weighing against institution, and that the seventh was argued by Petitioner to favor institution. *Id.* at 9. Lastly, Petitioner alleges that “the majority decision simply does not properly balance the General Plastics factors.” *Id.*

As an initial point, we acknowledge that the institution decision does not explicitly call out the *General Plastic* factors individually, but rather discusses the factors more generally. *See* Dec. 12–16. As acknowledged in the majority opinion, “this is the first petition filed against the ’005 Patent by Petitioner” (Dec. 13), such that we agreed that the first factor weighed in favor of institution. With respect to the second factor, Petitioner suggests

that inquiries relating to the similarity between prior art cited across multiple petitions are only relevant if Petitioner was a party to the prior proceedings, or had a relationship with the prior petitioners. Reh’g Req. 7. But a review of the cited precedential decision does not reflect Petitioner’s suggestion. *See General Plastic*, Paper No. 19 at 15–19 (“Our intent in formulating the factors was to take undue inequities and prejudices to Patent Owner into account.”). *General Plastic* does not proscribe panels of the Board from considering whether a subsequent petitioner knew of the prior art cited in the subsequent petition at the time of filing of the first petition, per the second factor. Similarly, we are not barred, under *General Plastic*, from considering the length of time that elapsed between when a petitioner learned of the art and when the petition, based on that art, was filed, or whether petitioner provides an adequate explanation for the time elapsed between the filings of multiple petitions, per the fourth and fifth factors.

Additionally, we are not persuaded that the factors enumerated in *General Plastic*, as viewed through the lens of *Valve Corp.*, must all be limited by any possible relationship between the multiple petitioners. Although the discussion of the first factor in *Valve Corp.* makes clear that “any relationship between those petitioners when weighing the *General Plastic* factors” must be considered, the remaining factors take into account the knowledge of the second petitioner irrespective of a specific relationship. *See Valve Corp.*, Paper 11 at 9–15. As such, the relationship between the different petitioners certainly has some bearing on what the second petitioner knew, when they knew it, and when they acted upon it, but the consideration of the second through seventh factors does not require a showing of a specific relationship between the petitioners to consider those factors.

As detailed in the majority opinion, all of those factors were considered. *See* Dec. 13–15. The majority determined that:

although the grounds of unpatentability provided in the instant Petition are not identical to the grounds provided in the petitions of the Unified and Sling TV IPRs, we are not persuaded that they are distinctive; nor are we persuaded that the instant grounds are not cumulative with respect to the grounds provided in the petitions of the Unified and Sling TV IPRs.

Dec. 15. We further considered the resources of the Board, as well as the time constraints of issuing a final determination, per the sixth and seventh factors, to find that “[o]verall, a third trial under these circumstances it is not an efficient use of the Board’s resources.” *Id.*

As such, we appreciate that Petitioner does not agree with the weight and consideration that we gave to the *General Plastic* factors in the institution decision, but we do not agree that we failed to properly apply the binding precedential decisions, namely *General Plastic* and *Valve Corp.*, regarding its follow-on Petition.

Petitioner also argues that the majority opinion nullifies the statutory one-year bar and improperly binds Petitioner to the positions of another petitioner. *Reh’g* Req. 10–15. Petitioner continues that Patent Owner served Petitioner and prior petitioner Sling TV less than a week apart, and that “Sling TV’s choice to self-expedite should not count against Google’s right to fashion a challenge of its own at a later time.” *Id.* at 10–11. Petitioner further argues that requiring it to file prior to its co-defendants removes the one-year safe harbor for accused infringers to challenge validity, per 35 U.S.C. § 315(b). *Id.* at 11. Petitioner also argues that the panel majority’s reasoning requires that a petitioner must be the first petitioner to file to have its petition properly considered, and that such

“jurisprudence certainly cannot be consistent with Congressional intent behind the AIA and § 315(b) in particular.” *Id.* at 12.

We note that all of the Petitioner’s arguments raised could also be raised by a serial petitioner that files multiple petitions within the statutory one-year period guaranteed by 35 U.S.C. § 315(b). Such arguments have been made by serial petitioners that discovered “new” art that shed light on the patentability of claims already under review. That is why the decisions discussed above, namely *General Plastic* and *Valve Corp.*, take into account what subsequent petitioners knew and how and when they arrived at that knowledge, recognizing the goals of the AIA, but also “recognize[ing] the potential for abuse of the review process by repeated attacks on patents.” *General Plastic*, Paper No. 19 at 16–17. Just as those decisions are not objectively viewed as eliminating the one-year bar under § 315(b), we are not persuaded that limiting overlapping petitions by multiple petitioners “nullifies the statutory one-year bar.”

Petitioner also argues that “[t]he error in the majority’s analysis cannot be salvaged by its assertion that Google’s prior art is similar to that at issue in the Unified and Sling TV IPRs.” Reh’g Req. 13. We note, however, our consideration of the similarities between the prior art and the challenges asserts in the various petitions was made in our determination as to whether “an additional examination of the challenged claims is warranted.” Dec. 15. We are not persuaded of error for the majority of the panel to consider whether it is an efficient use of the Board’s resources to reconsider essentially the same arguments and evidence that are already before the Board.

Petitioner also asserts that the majority opinion asserted that Petitioner should have sought joinder to the earlier petitions. Reh’g Req. 10. To be clear, the majority was not asserting that joinder was the sole option of

Petitioner, but merely that joinder would have “mitigate[d] efficiency concerns relating to a third challenge to this patent.” Dec. 13. By seeking such an avenue, Petitioner would not have risked having no “fair chance to challenge the asserted patent,” as Petitioner asserts. Reh’g Req. 14.

Petitioner does not persuade us that we overlooked or misapprehended any matter, or sufficiently show that not instituting an *inter partes* review of claims 1–3, 5, 6, 8, 39, and 41 of the ’005 Patent was an abuse of discretion.

IV. ORDER

For the reasons given, it is:

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

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GIANNETTI, *Administrative Patent Judge*, concurring in the result only.

I respectfully concur in the result only.

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