

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

UNIVERSAL ELECTRONICS, INC.,
Patent Owner.

IPR2019-01595
Patent 8,015,446 B2

Before PATRICK M. BOUCHER, MINN CHUNG, and
RUSSELL E. CASS, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

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

I. INTRODUCTION

Roku, Inc. (“Petitioner”) filed a Request for Rehearing (Paper 12, “Request” or “Req.”) of the Decision (Paper 11, “Dec.”), in which, based on the information presented, *inter alia*, in the Petition (Paper 2, “Pet.”), we denied institution of an *inter partes* review of claims 1 and 2 (the “challenged claims”) of U.S. Patent No. 8,015,446 B2 (Ex. 1001, “the ’446 patent”).¹ In its Request, Petitioner contends the Decision misapprehended or overlooked 37 C.F.R. § 42.108(c) as well as applicable Federal Circuit precedent in concluding that the challenged claims were entitled to their earliest claimed priority date. *See* Req. 1–2. The Request also asserts the Decision misapprehends the language of the challenged claims, the teachings of the references Darbee and Golender, the Petition’s motivation to combine, and applicable Federal Circuit precedent in finding that a person of ordinary skill in the art would not have been motivated to combine the teachings of Darbee and Golender. *See id.* at 8.

As explained below, we have considered the arguments presented by Petitioner in its Request for Rehearing, but discern no reason to modify the Decision. Consequently, Petitioner’s Request for Rehearing is *denied*.

II. STANDARD OF REVIEW

“The burden of showing a decision should be modified lies with the party challenging the decision,” and the challenging party “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed” in a

¹ Petitioner also filed a request for the Precedential Opinion Panel (“POP”) to review the Decision (Paper 13 (Notification of Receipt of POP Request)), which the POP denied (Paper 14 (Order)).

paper of record. 37 C.F.R. § 42.71(d). Because Petitioner seeks rehearing of our Decision denying institution of trial based on the Petition, it must show an abuse of discretion. *See* 37 C.F.R. § 42.71(c) (“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.”). 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). Thus, a request for rehearing is not an opportunity merely to disagree with the Board’s assessment of the arguments or weighing of the evidence, or to present new arguments or evidence that could have been presented in the Petition.

With these principles in mind, we address the arguments presented in Petitioner’s Request.

III. ANALYSIS

A. Arguments in the Request Regarding the Priority Date of the Challenged Claims

We first consider Petitioner’s argument that the Decision misapprehended or overlooked 37 C.F.R. § 42.108(c) and applicable Federal Circuit precedent in concluding that the challenged claims were entitled to their earliest claimed priority date. *See* Req. 1–7.

1. Legal Background

As discussed in the Decision, “a patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides support for the claims of the later application, as required by 35 U.S.C. § 112.” Dec. 25 (quoting *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008)). As also

explained in the Decision, the test for determining compliance with the written description requirement under 35 U.S.C. § 112 is whether the original disclosure of the earlier-filed application reasonably would have conveyed to a person of ordinary skill in the art that the inventor had possession of the claimed subject matter at the time of the earlier-filed application. *Id.* (citing *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc)). We further explained that although the exact terms appearing in the claim “need not be used *in haec verba*” in the specification of an application to provide adequate written description for the claimed subject matter, the specification of the earlier-filed application “must contain an equivalent description of the claimed subject matter.” *Id.* (citing *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997)).

As described in the Decision, the parties’ dispute over the priority date of the challenged claims of the ’446 patent centered on whether the relevant priority applications of the ’446 patent (*i.e.*, the ’020 provisional (Ex. 1004), the ’727 application (Ex. 1011), and the ’442 application (Ex. 1012)) provided adequate written description for the limitation of claim 1 (the “User Action Limitation”) reciting

storing within a memory of the controlling device data captured during operation of the controlling device, the data being representative of . . . an *action* occurring within the remote control application of the controlling device *resulting from the user interaction* with the user interface element of the controlling device.

Dec. 25–26 (emphasis added).

As outlined in the Decision, Petitioner in the Petition acknowledged that the disclosures in the priority applications regarding an event journal

that contains a log of user actions, including the “most recently viewed channels,” describe “storing . . . data representative of a user interaction with a user interface element . . . and an *action* occurring within the remote control application.” *Id.* at 26–27 (emphasis added) (citing Pet. 11 (citing Ex. 1004, 11, 22)). The Petition argued, however, that there is no disclosure in the priority applications that the described *action* “result[s] from the user interaction with the user interface element.” *Id.* at 27 (citing Pet. 11–13).

Patent Owner, on the other hand, argued that

a person of ordinary skill in the art would understand that the Petitioner-cited portions of the priority applications describe the subject matter of “an *action* occurring within the remote control application of the controlling device *resulting from the user interaction* with the user interface element of the controlling device.”

Id. at 27–28 (emphases added) (citing Prelim. Resp. 19).

As described in the Decision (*see id.* at 28–30), Patent Owner’s declarant, Mr. Bear, testified in his Declaration (Ex. 2001, “Bear Declaration”) that a person of ordinary skill in the art would have understood from the disclosures in the priority applications about journal data including the “most recently viewed channels” that the event journal contains data representing user selection of channels and the system action of tuning to the user selected channels. *See* Ex. 2001 ¶¶ 111–119 (citing Ex. 1004, 11, 22, 70, 85; Ex. 1011, 56–57, 11:9–15, 19:15–21, 67:3–11; Ex. 1012, 46–47, 9:1–8, 15:11–17, 55:21–56:2). Mr. Bear also cited Figure 4 and related descriptions in the ’020 provisional and testified that a person of ordinary skill in the art would have understood that “the event journal includes the mapping from ‘User Input’ to ‘Internal Commands’ performed by the system,” and thus, the ’020 provisional “discloses storing

data that is in response or resulting from user interaction.” Ex. 2001 ¶¶ 120–122; *see* Dec. 30–32 (discussing Patent Owner’s arguments and Mr. Bear’s testimony regarding Figure 4 and related descriptions in the ’020 provisional) (citing Prelim. Resp. 19–20; Ex. 2001 ¶¶ 120–122).² In addition, Mr. Bear discussed “a table showing the user action and *the associated system response*” described in the ’020 provisional and testified that the cited disclosures would have conveyed to a person of ordinary skill in the art the subject matter of “an action occurring within the remote control application of the controlling device resulting from the user interaction with the user interface element of the controlling device” recited in claim 1. Ex. 2001 ¶¶ 126–127 (citing Ex. 1004, 13; reproducing a table in the “Stimulus / Response Sequence” section of the ’020 provisional); *see* Dec. 33 (discussing Patent Owner’s arguments and Mr. Bear’s testimony regarding the “Stimulus / Response Sequence” table in the ’020 provisional) (citing Prelim. Resp. 24–25; Ex. 2001 ¶¶ 126–127; Ex. 1004, 13).

Considering the arguments and evidence presented by Petitioner and Patent Owner, the Decision determined that a person of ordinary skill in the art would have understood that the priority applications describe the subject matter of the User Action Limitation recited in claim 1, including the recited subject matter of “an action occurring within the remote control application of the controlling device resulting from the user interaction with the user interface element of the controlling device.” Dec. 34–35. Accordingly, based on the record presented, the Decision determined that the challenged

² As discussed in the Decision, Patent Owner argued that the ’727 application and the ’442 application each provide essentially the same disclosures. Dec. 30 n.14 (citing Prelim. Resp. 19–20 (citing Ex. 1011, 16:8–12, Fig. 18; Ex. 1012, 12:26–30, Fig. 18)).

claims are entitled to the benefit of the earlier filing date of the '020 provisional. *Id.* at 36–37.

2. *Petitioner's Arguments in the Request*

In its Request, Petitioner contends that “compliance with the ‘written description’ requirement of §112 is a ***question of fact***” (Req. 1 (emphasis by Petitioner) (citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991)) and that the Decision misapprehended or overlooked 37 C.F.R. § 42.108(c), which provided that when “deciding whether to institute an *inter partes* review,” “a genuine issue of material fact created by [a patent owner’s testimonial evidence] ***will be viewed in the light most favorable to the petitioner solely for purposes of deciding whether to institute an inter partes review***” (*id.* at 1–2 (quoting 37 C.F.R. § 42.108(c)³ (emphasis by Petitioner)) (citing *Yamaha Golf Car Co. v. Club Car, LLC*, IPR2017-02141, Paper 21 at 11–12 (PTAB June 26, 2018)). The Request asserts that “the Board’s Decision misapprehends the applicable framework for institution and credits Patent Owner’s testimonial evidence, ***and only Patent Owner’s testimonial evidence***, throughout [its] priority date analysis to Petitioner’s detriment.” *Id.* at 2 (emphasis in original). The Request contends that the Decision “completely overlook[ed]” the testimony from Petitioner’s declarant, Dr. Medvidovic, regarding the priority of the challenged claims. *Id.* at 4. The Request further asserts:

³ 37 C.F.R. § 42.108 has since been revised to remove the above-quoted language regarding the presumption in favor of the petitioner, effective January 8, 2021. See *PTAB Rules of Practice for Instituting on All Challenged Patent Claims and All Grounds and Eliminating the Presumption at Institution Favoring Petitioner as to Testimonial Evidence*, 85 Fed. Reg. 79120, 79120, 79122, 79129 (Dec. 9, 2020).

[O]n the disputed issue of material fact concerning whether the priority applications provided adequate written description support for claim 1, Patent Owner’s testimonial evidence created a “genuine issue of material fact,” and instead of viewing this issue “in the light most favorable to the petitioner,” the Board viewed Patent Owner’s testimonial evidence and performed its analysis in a light most favorable to ***Patent Owner***. The Board misapprehended or overlooked the applicable precedent and regulation, and on at least this basis, reconsideration of the Decision is warranted.

Id. at 5 (emphasis in original).

As discussed below, the record shows that the Decision did not misapprehend or overlook 37 C.F.R. § 42.108(c). The mere fact that Dr. Medvidovic provided testimony different from the testimony of Mr. Bear does not by itself raise a genuine issue of material fact. *See Mortgage Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325–26 (Fed. Cir. 2016) (“The mere existence in the record of dueling expert testimony does not necessarily raise a genuine issue of material fact.”). As the Request acknowledges, Dr. Medvidovic in his Declaration (Ex. 1010, “Medvidovic Declaration”) testified that the subject matter of the User Action Limitation is “neither ***expressly disclosed*** [in] nor ***necessarily follows*** from” the descriptions in the priority applications about event journal data. Req. 3 (emphases added) (citing Ex. 1010 ¶¶ 57–62). As discussed above, however, the test for determining compliance with the written description requirement under 35 U.S.C. § 112 is whether the original disclosure of the earlier-filed application reasonably would have conveyed to a *person of ordinary skill in the art* that the inventor had possession of the claimed subject matter at the time of the earlier-filed application. *Ariad Pharm.*, 598 F.3d at 1351. The record shows that Dr. Medvidovic did not provide any testimony in his Declaration as to what the disclosures in the priority

applications reasonably would have conveyed to a person of ordinary skill in the art. *See* Ex. 1010 ¶¶ 53–63. Nor did Dr. Medvidovic explain adequately in his Declaration why the disclosures in the priority applications would not reasonably have conveyed to a person of ordinary skill in the art the subject matter of the User Action Limitation. *See id.*

The Request asserts that although the Decision repeatedly cites and quotes Mr. Bear’s testimony on what a “person of ordinary skill in the art would understand” (Req. 5), “there is nary mention in the Board’s Decision of Dr. Medvidovic’s testimony” regarding the priority of the challenged claims, and, therefore, the Board’s Decision “completely overlooks Dr. Medvidovic’s testimony, perhaps misapprehending, and in any case sidestepping, the requirement that a genuine issue of material fact created by a conflict in testimonies ‘be viewed in the light most favorable to the petitioner solely for purposes of deciding whether to institute an inter partes review’” (*id.* at 4) (citing 37 C.F.R. § 42.108(c)).

We could not have cited any testimony from Dr. Medvidovic on the issue upon which the priority determination turns—what the priority applications reasonably would have conveyed to a person of ordinary skill in the art—because Dr. Medvidovic did not provide any testimony on that issue. And we did not overlook or misapprehend any testimony of Dr. Medvidovic regarding what the priority applications reasonably would have conveyed to a person of ordinary skill in the art because we could not have overlooked or misapprehended any testimony that was not presented in the Medvidovic Declaration. As discussed above, Dr. Medvidovic’s testimony based on what is expressly disclosed in or necessarily follows from the disclosures of the priority applications was insufficient because Dr. Medvidovic did not explain adequately why the disclosures in the

priority applications would not reasonably have conveyed to a person of ordinary skill in the art the subject matter of the User Action Limitation.

Thus, Dr. Medvidovic's testimony was insufficient to raise a genuine issue of material fact on the issue of what the priority applications reasonably would have conveyed to a person of ordinary skill in the art. Although Patent Owner's declarant, Mr. Bear, provided detailed testimony and explanations regarding how a person of ordinary skill in the art would have understood the priority applications to describe the subject matter recited in the User Action Limitation (*see* Ex. 2001 ¶¶ 111–122, 126–127), Dr. Medvidovic did not provide adequate testimony or explanations to the contrary on the issue (*see* Ex. 1010 ¶¶ 53–63).

In addition, although Mr. Bear also testified as to how Figure 4 and the “Stimulus / Response Sequence” table described in the '020 provisional would have conveyed to a person of ordinary skill the subject matter of “an action occurring within the remote control application of the controlling device resulting from the user interaction with the user interface element of the controlling device” recited in claim 1 (*see* Ex. 2001 ¶¶ 126–127), Dr. Medvidovic did not provide any testimony on these disclosures (*see* Ex. 1010 ¶¶ 53–63). Thus, Dr. Medvidovic's testimony did not raise and could not have raised a genuine issue of material fact on whether the disclosures additionally discussed by Mr. Bear would have conveyed to a person of ordinary skill the subject matter of the User Action Limitation.

The Request also contends that our Decision overlooked Dr. Medvidovic's background and qualifications, which are “directly relevant to subject matter of his testimony.” Req. 2, 4 n.2 (citing Ex. 1010 ¶¶ 7–25). We were not, however, required to accept Dr. Medvidovic's testimony merely because Petitioner offered it. *See Skky, Inc. v. MindGeek, s.a.r.l.*,

859 F.3d 1014, 1022 (Fed. Cir. 2017) (the Board was not required to credit expert evidence simply because [a party] offered it) (citing *In re Ethicon, Inc.*, 844 F.3d 1344, 1352 (Fed. Cir. 2017); 37 C.F.R. § 42.65(a)). Dr. Medvidovic’s qualifications, impressive as they may be, do not by themselves make Dr. Medvidovic’s testimony persuasive or sufficient to raise a genuine issue of material fact. As discussed above, based on the record presented, we found Dr. Medvidovic’s testimony to be insufficient to raise a genuine issue of material fact because Dr. Medvidovic did not sufficiently address the issue of what the priority applications reasonably would have conveyed to a person of ordinary skill in the art, and because he did not adequately address or discuss the relevant disclosures in the priority applications, including Figure 4 and the “Stimulus / Response Sequence” table described in the ’020 provisional.

Next, the Request notes that the Decision adopted Petitioner’s definition of a person of ordinary skill in the art (POSITA) as a person having “a bachelor’s degree in electrical engineering or computer engineering, and two to three years of work experience in software programming” (Req. 5 (citing Dec. 8–9)) and asserts that “the record does not establish that Mr. Bear is capable of opining from the perspective of a POSITA as defined in this proceeding” because Mr. Bear does not have a degree in electrical engineering or computer engineering. *Id.* at 5–6 (citing Ex. 2001 ¶¶ 6–31). The Request thus contends that “the Decision’s wholesale adoption of Mr. Bear’s testimony . . . cannot meet the ‘in the light most favorable to the petitioner’ standard set by §42.108(c).” *Id.* at 6.

Under Petitioner’s definition of the level of ordinary skill in the art, however, “less education can be remedied with additional work experience (e.g., 5–6 years).” Pet. 7 (citing Ex. 1010 ¶¶ 64–67). As stated in the Bear

Declaration, Mr. Bear's work experience includes at least 9 years of computer software programming using a variety of coding languages, such as BASIC, Pascal, C, C++, and 68000 Assembly Language. *See* Ex. 2001 ¶¶ 10–12. Thus, Mr. Bear is qualified to testify from the perspective of a person of ordinary skill in the art under Petitioner's definition of a person of ordinary skill in the art.

As discussed in the Decision, although we did not find the parties' proposals for the level of ordinary skill in the art to be materially different, to the extent the testimony from the parties' declarants on the level of ordinary skill in the art raised a genuine issue of material fact, we adopted and applied Petitioner's definition for purposes of the Decision, being mindful of the rule that "a genuine issue of material fact created by such testimonial evidence will be viewed in the light most favorable to the petitioner solely for purposes of deciding whether to institute an *inter partes* review." Dec. 9 (citing 37 C.F.R. § 42.108(c)). Thus, the record shows that, under Petitioner's definition of the level of ordinary skill in the art adopted in consideration of § 42.108(c), the Decision appropriately credited Mr. Bear's testimony on what the priority applications reasonably would have conveyed to a person of ordinary skill in the art.

In sum, we conclude, contrary to Petitioner's arguments in the Request, there was no genuine issue of material fact raised by Dr. Medvidovic's testimony on the priority of the challenged claims. We did not overlook or misapprehend any testimony of Dr. Medvidovic regarding what the priority applications reasonably would have conveyed to a person of ordinary skill in the art. Rather, we considered Dr. Medvidovic's testimony presented in the Medvidovic Declaration but found it insufficient to raise a genuine issue of material fact on the issue upon which the priority

determination turns in this case—whether the disclosures in the priority applications would have conveyed to a person of ordinary skill the subject matter of the User Action Limitation.

B. Arguments in the Request Regarding the Motivation to Combine Darbee and Golender

We next turn to Petitioner’s assertion in the Request that the Decision misapprehended the language of the challenged claims, the teachings of the references Darbee and Golender, the Petition’s motivation to combine, and applicable Federal Circuit precedent in finding that a person of ordinary skill in the art would not have been motivated to combine the teachings of Darbee and Golender. *See* Req. 8–15.

1. Background

As discussed in the Decision, the Petition cited contemporaneous prior art, Gopalan (Ex. 1007), in support of Petitioner’s argument on the motivation to combine Darbee and Golender. Dec. 43 (citing Pet. 24). According to the Petition, Gopalan “recognizes that ‘embedded systems’ such as those that ‘deal with real-time issues’ and execute on devices such as ‘cellular phones’ or ‘personal-digital assistant (PDA) devices’ ‘generally require careful debugging to ensure that they work as intended.’” Pet. 24 (quoting Ex. 1007, 1:10–46). The Petition argued, therefore, a person of ordinary skill in the art would have recognized “an explicit suggestion in the art for debugging software applications such as Darbee’s remote control application, and would have reason to seek and incorporate teachings of references that discussed debugging.” *Id.* at 24–25 (citing Ex. 1010 ¶¶ 100–101).

We were not persuaded by Petitioner’s argument and evidence that a person of ordinary skill in the art would have been motivated to combine the teachings of Darbee and Golender. As discussed in the Decision, contrary to Petitioner’s assertion:

Gopalan appears to teach away from the proposed combination of Darbee and Golender because, immediately following the passage cited by Petitioner, Gopalan cautions that “[h]owever, debugging embedded systems can be difficult” because, among other reasons, the software tools developed for debugging embedded systems are “*very specialized in purpose, and usually cannot be extended to collect and analyze data other than that for which they were initially developed.*”

Dec. 44 (emphasis in original) (citing Ex. 1007, 1:31–40). As further explained in the Decision:

Given the cautionary statements in Gopalan discussed above that the debugging tools for embedded systems “usually cannot be extended . . . other than that for which they were initially developed,” Gopalan appears to discourage the proposed combination. Specifically, Gopalan suggests that Golender’s debugging tools for a general purpose computer would not be useful for embedded systems (which Petitioner appears to equate to Darbee’s remote control) due to the specialized requirements for debugging tools for such embedded systems. Thus, combining Golender’s teachings of run-time debugging and code execution tracing tools running on a general purpose computer with Darbee’s teachings of the software application running on the remote control device for a consumer electronic device is “unlikely to be productive” of the result sought by Petitioner. ***Neither Petitioner nor Dr. Medvidovic addresses the cautionary statements in Gopalan*** discussed above or explains adequately why a person of ordinary skill in the art would have been motivated to combine Darbee and Golender in the fashion proposed by Petitioner notwithstanding Gopalan’s statements that ***discourage the proposed combination.***

Id. at 44–45 (emphases added) (citing Pet. 24–25; Ex. 1010 ¶¶ 100–101).

Regarding Petitioner's explanation as to how a person of ordinary skill in the art would have combined the disclosures of Darbee and Golender, the Decision found:

Petitioner does not explain adequately how a skilled artisan would have made the proposed combination of Darbee and Golender, combining Golender's teachings of run-time debugging and code execution tracing tools running on a general purpose computer under the Windows NT/2000 and Windows 95/98 operating systems using breakpoints or functional entry points with Darbee's teachings of a software application running on a remote control for a consumer electronic device.

Id. at 45 (citing *Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017) (“[T]he Board nowhere clearly explained, or cited evidence showing, *how the combination of the two references was supposed to work*. At least in this case, such a clear, evidence-supported account of the *contemplated workings of the combination* is a *prerequisite* to adequately explaining and supporting a conclusion that a relevant skilled artisan would have been motivated to make the combination and reasonably expect success in doing so.” (emphases added by the Decision))). As explained in the Decision:

The amount of explanation needed to meet the governing legal standards—to enable judicial review and to avoid judicial displacement of agency authority—necessarily depends on context. A brief explanation may do all that is needed if, for example, the technology is simple and familiar and the prior art is clear in its language and easily understood. On the other hand, complexity or obscurity of the technology or prior-art descriptions may well make more detailed explanations necessary.

Id. at 46 (quoting *Pers. Web Techs.*, 848 F.3d at 994). The Decision found that “this case falls into the latter category.” *Id.* The Decision explained that

Given the level of ordinary skill proposed by Petitioner, the complexity of the technology of Golender's debugging and code execution tracing tools running on a general purpose computer, and the specialized nature of the embedded system software running the specialized hardware of Darbee's remote controller for a consumer electronic device, it was incumbent on Petitioner to explain how Golender's debugging and code execution tracing technology would have been adapted for Darbee's remote controller and combined with Darbee's teachings on the remote controller software. Because Petitioner has failed to do so, we determine that Petitioner *has not established sufficiently* that a person of ordinary skill in the art would have been motivated to combine the teachings of Darbee and Golender to achieve the claimed invention.

Id. (emphasis added).

2. Petitioner's Arguments in the Request

In its Request, Petitioner asserts "the Decision misapprehends the claim language in finding that this case falls into the category of complex or obscure technology." Req. 8. According to the Request, claim 1 recites "facilitating debugging," and merely requires "the intended use that data 'is available for use in debugging.'" *Id.* (citing Ex. 1001, 38:43–58). The Request contends that making data available for use in debugging "does not even require the act of debugging itself," and, thus, "making data 'available for use in debugging' would not require Golender's 'debugging and code execution tracing tools running on a general purpose computer.'" *Id.* In light of the "simplicity . . . of the teachings to be incorporated," the Request argues, "the Petitioner's analysis fulfills the requirement to show a motivation to combine." *Id.* at 9–10.

The Request, however, does not identify where in the Petition such arguments based on claim language were presented. We could not have misapprehended or overlooked arguments or evidence that were not

presented or developed in the Petition. At best, Petitioner's arguments in its Request attempt to remedy the deficiencies in the Petition our Decision identified, by supplementing the arguments in the Petition. A request for rehearing is not a supplemental petition. Nor is it an opportunity to present new arguments or evidence that could have been presented and developed in the first instance in the Petition.

Even if we were to consider Petitioner's newly presented argument in the Request that the claim language "facilitating debugging" and "is available for use in debugging" does not require debugging, this argument is not persuasive because Petitioner's rationale for combining Darbee and Golender in the Petition focuses on the need to modify Darbee's remote control unit to *include debugging*. See Pet. 24 ("A POSITA would have recognized that software applications such as the remote control application on Darbee's remote control unit *require debugging*." (emphasis added)), 24–25 ("a POSITA would have recognized an *explicit suggestion in the art for debugging* software applications such as Darbee's remote control application, and would have reason to seek and incorporate teachings of references that *discussed debugging*" (emphases added)).

To the extent the Request argues that the technology at issue is simple and disagrees with our finding in the Decision that, given the complexity of technology disclosed in Golender and the specialized nature of the embedded system software and hardware described in Darbee, it was incumbent on Petitioner to explain in the Petition "how Golender's debugging and code execution tracing technology would have been adapted for Darbee's remote controller and combined with Darbee's teachings on the remote controller software" (Dec. 46), mere disagreement with the Decision

is not a proper basis for rehearing when Petitioner’s arguments and evidence were considered and addressed in the Decision.

In the Request, Petitioner further contends “the Decision overlooks the complete reasoning provided by Petitioner that supports finding of a motivation to combine.” Req. 11. More particularly, Petitioner asserts “[t]he Decision focuses solely on Petitioner’s argument that contemporaneous prior art recognizes the need for debugging applications,” whereas “Petitioner *twice* noted that Golender *itself* provided evidence in support of its teachings.” *Id.* (emphasis in original).

In a related argument, the Request asserts that in the analysis of limitation [1.2.2], Petitioner noted that Golender “discloses advantages to the use of debugging application based on uploaded data; namely, the software developer can ‘analyze how the client program is operating at the remote site, without the need to visit the remote site.’” Req. 12 (citing Pet. 28; Ex. 1006, 4:28–32). The Request contends that the Decision “entirely overlooked this portion of Petitioner’s reasoning that provides further motivation to combine the teachings of Darbee and Golender.” *Id.* In the cited portion of the Petition, however, Petitioner referred to the Petition’s analysis of limitation [1.1.2], which relied on Gopalan as providing “an explicit suggestion in the art for debugging software applications like Darbee’s remote control application.” *See* Pet. 28.

We did not overlook the portions of Petitioner’s rationale that relied upon the disclosures of Golender. Rather, we determined that this rationale was undercut by Gopalan’s disclosure that debugging tools for embedded system usually cannot be extended other than that for which they were initially developed. *See* Dec. 44–45.

In its Request, Petitioner additionally asserts that “the Decision misapprehends the law of obviousness and . . . overlooks the remainder of Gopalan.” Req. 12. The Request contends that the Decision “focused only on the Background of Gopalan instead of considering, and thus overlooking, the reference in its entirety as legally required.” *Id.* at 13 (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983)).⁴

The cited *W.L. Gore* case involved an issue of obviousness over a combination of prior art references. *See W.L. Gore*, 721 F.2d at 1546–47, 1550. Here, however, the Petition did not include Gopalan in any asserted combination of prior art references. *See* Pet. 4. Rather, the Petition relied on Gopalan only for its alleged “explicit suggestion” of the motivation to combine Darbee and Golender in the asserted ground of obviousness over the combination of Darbee and Golender. *See id.* at 24–25. The Decision discussed the portions of Gopalan in the reference’s Background section (*see* Dec. 43–44 (citing Ex. 1007, 1:10–46)) because those were the portions cited in the Petition as allegedly providing “an explicit suggestion” for combining Darbee with the “teachings of references that discussed debugging,” such as Golender (*see* Pet. 24–25 (citing Ex. 1007, 1:10–46)). Contrary to the Request’s argument, there was no legal error in the Decision in simply considering the arguments and evidence as presented in the Petition.

The Request further contends that “[h]ad the entirety of Gopalan been considered, the Board would not have found that Gopalan teaches away and, instead, would have found a reasonable likelihood of prevailing.” Req. 13. Aside from the portions of Gopalan identified above, however, the Petition

⁴ The Request’s citation to 721 F.2d 1520 appears to be an error.

did not cite any other portions of Gopalan, much less “the reference in its entirety,” as providing or suggesting the reasons to combine Darbee and Golender in the manner proposed by Petitioner in the Petition. *See* Pet. 17–30; Req. 13. We could not have misapprehended or overlooked arguments or evidence that were not presented or developed in the Petition.

Nor does the Request identify any other portion of Gopalan, much less “the entirety of Gopalan,” as providing or suggesting the motivation to combine, other than citing the Abstract of Gopalan as disclosing “[d]ata capture and analysis for debugging embedded systems.” *See* Req. 13 (citing Ex. 1007, Abstract). But this disclosure in Gopalan’s Abstract does not take away from the fact that Gopalan also cautions that “debugging embedded systems can be difficult” and that software tools developed for debugging embedded systems are “*very specialized in purpose, and usually cannot be extended to collect and analyze data other than that for which they were initially developed,*” as discussed in the Decision. Dec. 44 (emphasis added by the Decision) (citing Ex. 1007, 1:31–40).

To the extent the Request argues that the Decision misapprehended the law of obviousness and the requirements for finding a teaching away (*see* Req. 12–13), we disagree with Petitioner’s argument. The relevant standard for teaching away, as articulated by the Federal Circuit is reproduced below:

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, *would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.* A reference does not teach away, however, if it merely expresses a general preference for an alternative invention but does not criticize, discredit, or otherwise discourage investigation into the invention claimed.

Galderma Laboratories, L.P. v. Tolmar, Inc., 737 F.3d 731, 738 (Fed. Cir. 2013) (emphasis added). As determined in the Decision, Gopalan expressly discourages using general-purpose debugging tools for embedded systems due to the specialized requirements for debugging tools for such embedded systems. *See* Dec. 44–45. Thus, the Decision did not overlook applicable Federal Circuit precedent or Gopalan in finding that neither Petitioner nor Dr. Medvidovic addressed the cautionary statements in Gopalan discussed above or explained adequately why a person of ordinary skill in the art would have been motivated to combine Darbee and Golender in the fashion proposed by Petitioner notwithstanding Gopalan’s statements that discourage the proposed combination. *See id.* at 45 (citing Pet. 24–25; Ex. 1010 ¶¶ 100–101).

The Request further contends that “[t]o the extent Gopalan teaches away from or cautions against ‘debugging tools for embedded systems’ because they ‘usually cannot be extended . . . other than that for which they were initially developed,’ such a finding would **motivate**, not discourage, the use of Golender’s ‘debugging tools for a general purpose computer.’” Req. 13–14 (citations omitted). By this argument, the Request simply disagrees with our determination in the Decision that the portions of Gopalan cited in the Petition discourage the proposed combination of Darbee and Golender. Mere disagreement with the Decision is not a proper basis for rehearing when Petitioner’s arguments and evidence were considered and addressed in the Decision.

The Request also asserts that the Decision did not comply with 37 C.F.R. § 42.108(c) by overlooking Dr. Medvidovic’s testimony that the concept of “debugging” was extremely familiar to a POSITA, as Dr. Medvidovic testified that “the term was known as early as the **1950s**.”

Req. 9 (citing Ex. 1010 ¶¶ 47, 48). But in the asserted ground based on the combination of Darbee and Golender, the Petition did not rely on what was well-known to a person of ordinary skill in the art to teach the “debugging the remote control application” limitation recited in claim 1. *See* Pet. 16–29. Rather, as discussed in the Decision, the Petition relied on Golender to teach the limitations relating to debugging and uploading data to a computer for use in debugging the remote control application of the controlling device. Dec. 43 (citing Pet. 17–30). Indeed, Dr. Medvidovic’s testimony discussed in the Request (*see* Ex. 1010 ¶¶ 47, 48) was not cited in the Petition. *See generally* Pet. Again, we could not have misapprehended or overlooked arguments or evidence that were not presented or developed in the Petition.

Lastly, the Request contends that the Decision “misapprehended the legal standards for obviousness” by “applying a bodily incorporation analysis to Petitioner’s proposed combination of teachings.” Req. 14–15. The Request misunderstands the Decision. The Decision did not apply a bodily incorporation analysis to Petitioner’s proposed combination or otherwise require Petitioner to explain “how Golender’s entire system would be imported into Darbee’s system.” *See id.* at 15.

Instead, the Decision determined that in this case “a clear, evidence-supported account of the *contemplated workings of the combination* is a *prerequisite* to adequately explaining and supporting a conclusion that a relevant skilled artisan would have been motivated to make the combination and reasonably expect success in doing so.” Dec. 45 (quoting *Pers. Web Techs.*, 848 F.3d at 994) (emphases added by the Decision). In addition, the Decision determined that the Petition did not establish sufficiently the rationale to combine Darbee and Golender because the Petition did not adequately explain how a person of ordinary skill in the art would have

combined “Golender’s teachings of run-time debugging and code execution tracing tools running on a general purpose computer using the Windows NT/2000 and Windows 95/98 operating systems using breakpoints or functional entry points with Darbee’s teachings of a software application running on a remote control for a consumer electronic device.” *Id.* at 45–46.

To the extent the Request disagrees with the Decision’s analysis of the motivation to combine Darbee with Golender, mere disagreement with the Decision is not a proper basis for rehearing when Petitioner’s arguments and evidence were considered and addressed in the Decision.

IV. CONCLUSION

For the foregoing reasons, Petitioner has not demonstrated that we abused our discretion or that we misapprehended or overlooked any matter in our Decision denying institution of *inter partes* review of the challenged claims of the ’446 patent. Petitioner, therefore, has not carried its burden of demonstrating that the Decision denying institution should be modified. *See* 37 C.F.R. § 42.71(d).

V. ORDER

In consideration of the foregoing, it is hereby ORDERED that Petitioner’s Request for Rehearing is DENIED.

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