

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SQUARE, INC.,  
Petitioner,

v.

4361423 CANADA INC.,  
Patent Owner.

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IPR2019-01651  
Patent 9,443,239 B2

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Before JAMESON LEE, ROBERT J. WEINSCHENK, and  
KEVIN C. TROCK, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

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

## I. INTRODUCTION

On May 22, 2020, Petitioner Square Inc. filed a Request for Rehearing (Paper 11, “Reh’g Req.”) of the Board’s Decision Granting Institution of *Inter Partes* Review (Paper 9, “Decision” or “Dec.”) of claims 1–6 of U.S. Patent No. 9,443,239 B2 (“the ’239 patent”).

The Request is *denied*.

## II. DISCUSSION

The Petition asserted the following three grounds of unpatentability:

| Claim(s) Challenged | 35 U.S.C. § | Basis             |
|---------------------|-------------|-------------------|
| 1–6                 | 103         | Valliani, Vrotsos |
| 1–6                 | 103         | Bear, Vrotsos     |
| 1–6                 | 103         | Vrotsos           |

Pet. 14, 44, 71.

We instituted review of claims 1–6 on each of the three grounds of unpatentability asserted by Petitioner. Dec. 38. We additionally stated that Petitioner has not shown a reasonable likelihood that it would prevail in establishing unpatentability of claims 1 and 4 as obvious over Bear and Vrotsos. *Id.* at 29–30.

Petitioner disagrees with our additional statement about it not having shown a reasonable likelihood that it would prevail in establishing unpatentability of claims 1 and 4 as obvious over Bear and Vrotsos. Reh’g Req. 1. In that regard, according to Petitioner, “substantial evidence, including arguments and evidence contrary to the Board’s finding, was misapprehended or overlooked.” *Id.*

At this stage of the proceeding, whether our statement was correct is of no moment, because we instituted review of all challenged claims on all asserted grounds of unpatentability. Dec. 38. As explained in the Decision,

there need only be a reasonable likelihood of prevailing with respect to one challenged claim to support institution of review of all challenged claims.

Dec. 2.

Obviousness of claims 1 and 4 over Bear and Vrotsos is an issue for trial. Our pre-institution statement about Petitioner's likelihood of prevailing on that issue serves merely to direct the attention of the parties to that issue. On that basis, the parties may choose what to address in their substantive papers during trial. As for reasonable likelihood of Petitioner prevailing, it is a non-issue once trial commences, which it has.

Even assuming Petitioner is correct that we erred in our statement regarding Petitioner not having shown a reasonable likelihood of prevailing in establishing obviousness of claims 1 and 4 over Bear and Vrotsos, e.g., that we overlooked and misapprehended some matters in reaching that conclusion, nothing would change with respect to the ongoing trial. The issue of obviousness of claims 1 and 4 over Bear and Vrotsos still is part of the trial in this case, and no conclusion has been made regarding that ground.

For the foregoing reasons, given the posture of this proceeding, the matter raised by Petitioner is a non-issue because it is inconsequential. Petitioner may address the Petition deficiencies we identified in the Decision in a substantive paper during trial. No meaningful purpose would be served by consideration of the substantive arguments in this Request for Rehearing, because we instituted review of all challenged claims on all asserted grounds for those claims.

### III. ORDER

For the reasons given, it is

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

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