

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOMOFUN, LLC,
Petitioner,

v.

DOGGYPHONE LLC,
Patent Owner.

IPR2021-00260
Patent 9,723,813 B2

Before PATRICK R. SCANLON, SCOTT A. DANIELS, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing of Decision

Denying Institution of *Inter Partes* Review

37 C.F.R. § 42.71(d)

I. INTRODUCTION

Tomofun, LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 7–9 of U.S. Patent No. 9,723,813 B2 (Ex. 1001, “the ’813 patent”). Doggyphone LLC (“Patent Owner”) filed a Preliminary Response (Paper 8, “Prelim. Resp.”).

On May 24, 2021, we issued a Decision Denying Institution of *Inter Partes* Review. Paper 9 (“Decision” or “Dec.”). Petitioner requests rehearing of our Decision. Paper 10 (“Rehearing Request” or “Reh. Req.”). For the reasons set forth below, Petitioner’s Request for Rehearing is *denied*.

II. ANALYSIS

A. Legal Standards

The applicable requirements for a request for rehearing are set forth in 37 C.F.R. § 42.71(d), which provides:

A party dissatisfied with a decision may file a single request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. 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.

We review our Decision under an abuse of discretion standard. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). “Substantial evidence is ‘such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.’” *OSI Pharm., LLC v. Apotex*

Inc., 939 F.3d 1375, 1381 (Fed. Cir. 2019) (quoting *Consol. Edison Co. v. N.L.R.B.*, 305 U.S. 197, 229 (1938)). “The substantial evidence standard asks ‘whether a reasonable fact finder could have arrived at the agency’s decision.’” *OSI Pharm.*, 939 F.3d at 1381–82 (quoting *Gartside*, 203 F.3d at 1312).

B. Background

Independent claim 7 of the ’813 patent recites, in pertinent part, a delivery module that “in response to the received treat delivery command,” “plays via the audio device an audio signal that notifies the pet of availability of a treat” (“the audio signal limitation”). Ex. 1001, 12:19–25.

The Petition challenges claims 7–9 on the following grounds:

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	7	102(b)	Alasaarela ¹
2	8	103(a)	Alasaarela
3	7–9	102(b)	Beccaria ²
4	7–9	103(a)	Carelli, ³ Beccaria
5	7–9	103(a)	Bloksberg, ⁴ Beccaria

Pet. 4. Petitioner asserts that Alasaarela discloses the audio signal limitation for Grounds 1 and 2. *Id.* at 23–24, 31. Petitioner asserts that Beccaria discloses the audio signal limitation for Ground 3, and Carelli discloses the audio signal limitation for Ground 4. *Id.* at 36–37, 48. For Ground 5, Petitioner asserts that Bloksberg discloses the audio signal limitation. *Id.* at 60.

¹ FI 122052 B, published July 5, 2011 (certified English translation) (Ex. 1006).

² WO 2009/087451 A1, published July 16, 2009 (Ex. 1007).

³ US 8,588,967 B2, issued Nov. 19, 2013 (Ex. 1009).

⁴ US 2008/0282988 A1, published Nov. 20, 2008 (Ex. 1010).

In the Decision, we determined that the Petition failed to establish sufficiently that any of Alasaarela, Beccaria, Carelli, and Bloksberg discloses the audio signal limitation. Dec. 12–13, 17–18, 21–22, 25–27.

C. Petitioner’s Arguments on Rehearing

Petitioner argues that, in the Decision, “the Board misapprehended aspects of the Challenged Claims and misapprehended or overlooked several of Petitioner’s arguments.” Reh. Req. 1. We analyze each argument in turn.

1. Bloksberg

In the Decision, we indicated that we were not persuaded on the record before us that Bloksberg discloses the audio signal limitation. Dec. 26. Petitioner argues that we overlooked the Office’s previous analysis of Bloksberg in making this determination. Reh. Req. 1. Specifically, Petitioner argues that “as identified in the Petition, the Office has already determined that Bloksberg teaches playing an audio signal in response to a treat delivery command.” *Id.* (citing Pet. 9). Petitioner also argues that we overlooked the Board’s policy to defer to previous Office analyses. *Id.* at 1–2 (citing *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 9 (PTAB Feb. 13, 2020) (precedential)).

The Petition states that “[t]he Examiner cited Bloksberg[] for each and every element of claim 27 except for the recitation of ‘cause the audio device to stop playing the audio signal when the pet accesses the food tray to obtain the treat.’” Pet. 9 (citing Ex. 1003, 319).⁵ This statement, however, does not state *expressly* that the Examiner found Bloksberg to disclose the

⁵ Page 319 of Exhibit 1003, which Petitioner cites, provides the Examiner’s findings with respect to then-pending claim 1, rather than then-pending claim 27. The Examiner appears to have made similar findings with respect to claim 27. *See* Ex. 1003, 321–22.

audio signal limitation of claim 7 of the '813 patent. Rather, one must deduce that pending claim 27 eventually issued as claim 7 and, that “each and every element of claim 27” except the limitation identified included a limitation in claim 27 that corresponded to the audio signal limitation of claim 7.

More importantly, the statement does not identify the Examiner’s finding as a basis for asserting that Bloksberg discloses the audio signal limitation. Nor does any other portion of the Petition. Instead, the Petition points to Bloksberg’s disclosures in ¶ 27 (using function control 218 to schedule meals, treats, pre-recorded talks, and music programs) and claim 17 (performing activities, such as broadcasting a sound signal, in response to a user command) as teaching the audio signal limitation. Pet. 60. This position is not consistent with, or is at least different than, the Examiner’s finding that speaker 308 in Figure 3 of Bloksberg discloses the claim 1 limitation “caus[ing] the audio device to play an audio signal that notifies the pet of the presence of a treat in a food tray.” Ex. 1003, 319; *see also id.* at 322 (citing ¶¶ 31–33 of Blocksberg as disclosing a similar limitation in claim 27).

As such, the Petition does not indicate with sufficient particularity that Petitioner relies on the Examiner’s finding as a basis for asserting that Bloksberg discloses the audio signal limitation and, thus, does not satisfy Petitioner’s burden on this point. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (“In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” (citing 35 U.S.C. § 312(a)(3)); *see also Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of the utmost importance that petitioners in the IPR proceedings

adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” (quoting 35 U.S.C. § 312(a)(3))). Because the Petition did not indicate clearly that it was relying on the Examiner’s finding, we could not have misapprehended or overlooked such a position. In addition, Patent Owner was not afforded a fair opportunity to dispute any reliance on the Examiner’s finding or the reasoning underlying the finding.

Furthermore, the lack of a persuasive showing that Bloksberg discloses the audio signal limitation was not the only reason for our determination that the Petition fails to establish a reasonable likelihood that claim 7 would have been obvious over Bloksberg and Beccaria. We also determined that Petitioner did not show sufficiently that Bloksberg discloses the claim 7 limitation of the delivery module “receiv[ing] input from the pet” “in response to the received treat delivery command.” Dec. 27–28. Petitioner does not present any arguments regarding this determination in its Rehearing Request. Therefore, even if Petitioner’s arguments regarding the audio signal limitation were persuasive, that position alone would not be a sufficient basis to modify the Decision with respect to Ground 5.

2. Alasaarela

Regarding Grounds 1 and 2, which both rely on Alasaarela, Petitioner argues that “[t]he Board’s decision stems from a mischaracterization of what is required by the claim and how the disclosure of Alasaarela operates.” Reh. Req. 5.

First, with respect to our statement in footnote 8 on page 12 of the Decision, Petitioner argues that claim 7 does not require a temporal relationship between playing the audio signal and the availability of the treat, and we overlooked that the audio signal may be played before a treat is

delivered. *Id.* The statement in question is: “Although Petitioner contends that Alasaarela discloses the music indicates that the owner *provided or will provide* food, we note that Alasaarela actually discloses only that the owner *will provide* food, indicating a future, as opposed to a current, availability of food.” Dec. 12 n.8 (citing Ex. 1006, 9:25–28). As such, the footnote merely conveys that we were not persuaded by Petitioner’s argument that Alasaarela’s music indicates that the owner had already provided food. The footnote was not a basis for our determination that Alasaarela did not disclose the audio signal limitation. Instead, we were not persuaded that Alasaarela discloses playing an audio signal *in response to a treat delivery command* because we determined that “Alasaarela discloses playing music or the owner’s voice over a loudspeaker but is silent as to how these audio signals are actuated.” *Id.* at 13 (citing Ex. 1006, 9:23–32). This determination was not dependent on the relative timing between the music being played and the availability of the food.

Second, Petitioner argues that our “analysis discounts Petitioner’s arguments and explanations as to how each of the devices in Alasaarela responds to a treat delivery command.” Reh. Req. 5. According to Petitioner, the Petition and Petitioner’s expert, Dr. Olivier, “explained that [Alasaarela’s] computer 17 receives commands via internet 19 and then sends those commands over wireless communication network 16 to the computer programming portions of the devices in the pet care environment 10, . . . thereby causing the end devices to perform their intended function.” *Id.* at 6 (citing Pet. 23; Ex. 1004 ¶ 106). Petitioner also argues that one of ordinary skill in the art would have understood “that the computer 17 also must instruct the loudspeaker to play pet owner’s voice in connection with treat delivery.” *Id.* at 6–7 (citing Pet. 23–24; Ex. 1004 ¶¶ 108–109).

We disagree. The Petition states that a person having ordinary skill in the art would have understood “that when computer 17 receives commands from internet 19, it delivers the commands via wireless communication network 16 *to either food dispenser 12a or treat dispenser 12c* to dispense food.” Pet. 23 (citing Ex. 1006, Fig. 1; Ex. 1004 ¶¶ 105, 107) (emphasis added). This passage refers to only the food dispensers as receiving commands from computer 17 and, contrary to Petitioner’s current assertion, does not describe any other devices as receiving commands from computer 17. Also, in discussing playing the audio signal, the Petition makes no mention of the audio signal being played in response to a treat delivery command. Pet. 23–24. Dr. Olivier’s testimony also does not state that Alasaarela’s loudspeaker is played in response to a specific command. Ex. 1004 ¶¶ 105, 107–109.

Furthermore, we did not discount Petitioner’s arguments and explanations, as Petitioner now asserts. Instead, we addressed Petitioner’s arguments and determined that “neither the Petition nor Dr. Olivier explains sufficiently why this treat delivery command would cause music or the owner’s voice to be played over the loudspeaker.” Dec. 13 (citing Pet. 23–24; Ex. 1004 ¶¶ 108–109).

3. *Beccaria*

Petitioner states that we denied institution of Ground 3 because we were not persuaded that Beccaria discloses the audio signal limitation. Reh. Req. 7 (citing Dec. 17). Petitioner then contends that “the Petition asserts in Ground 3 that the claims are obvious based on Beccaria, not that Beccaria anticipates the claims,” and “the question is not whether or not Beccaria explicitly discloses that the audio signals are played in response to a singular

treat delivery command,” but “whether or not a [person having ordinary skill in the art] would find that sequence obvious.” *Id.*

We disagree with Petitioner’s characterization of Ground 3 as being based on obviousness. Rather, the Petition clearly asserts for Ground 3 that “Claims 7-9 are anticipated under 35 U.S.C. § 102 by Beccaria[.]” Pet. 4; *see also id.* at 32 (“Ground 3 – Claims 7–9 Are Unpatentable As Anticipated By Beccaria[.]”). Petitioner’s Ground 3 analysis of claim 7 relies on Beccaria disclosing each limitation, including the audio signal limitation. *Id.* at 32–40. Petitioner’s Rehearing Request does not direct us to any portion of the Petition for Ground 3 that asserts any claim limitation would have been obvious over Beccaria, alone or in combination with another reference.

Accordingly, we are not persuaded that we misapprehended Petitioner’s argument with respect to Beccaria.

4. *Carelli*

In the Decision, we indicated that we were not persuaded that Carelli discloses playing an audio signal in response to the “treat delivery command” identified by Petitioner (i.e., the signal transmitted from Carelli’s remote control device. Dec. 21. Specifically, we determined that

Carelli discloses that pressing treat button 32 causes a signal to be sent by control circuit electronics portion 42 to initiate dispensing of a treat. . . . Carelli, however, does not disclose[] that this signal corresponding to the treat delivery command causes audio portion 93 or speaker 95 to play audio that can be heard by the pet. Instead, Carelli discloses that selecting *audio button 33* initiates either the playing of a recorded message or live interaction between the owner and the pet.

Id. at 21–22 (citing Ex. 1009, 14:29–33; 15:57–67). Petitioner argues that the Petition demonstrates that Carelli teaches (1) a treat delivery command that causes a treat to be dispensed, and (2) playing a recorded message with

treat delivery. Reh. Req. 11 (citing Pet. 48). Thus, according to Petitioner, the Petition asserts that one of ordinary skill in the art would have found the claimed recitations obvious. *Id.*

We disagree that we misapprehended or overlooked Petitioner’s argument. Instead, we considered the argument but found it not persuasive, determining that “we are not persuaded that Carelli discloses playing audio signals in response to the treat delivery command, that is, in response to pressing treat button 32.” Dec. 22. In other words, even in view of Carelli’s disclosure that a recorded message can be played as the pet treat is dispensed (Ex. 1009, 10:53–64), the recorded message is played in response to the owner selecting audio button 33 (*id.* at 15:57–67), and not in response to the signal triggered by selecting treat button 32 (*id.* at 14:29–33). The fact that audio button 33 can be selected at the same time that treat button 32 is selected does not mean that the recorded message is played in response to the signal generated by treat button 32.

5. Conclusion

For the above reasons, we determine Petitioner has not carried its burden of showing that we misapprehended or overlooked any matter or that the Decision denying institution of *inter partes* review was an abuse of discretion.

III. ORDER

In consideration of the foregoing, it is hereby:

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

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