

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

RALLY AG LLC.,
Patent Owner.

IPR2024-01446
Patent 11,361,107 B2

Before GREGG I. ANDERSON, ARTHUR M. PESLAK, and
ANDREW L. NALVEN, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an inter partes review of claims 1–19 (“the challenged claims”) of US Patent No. 11,361,107 B2 (Ex. 1001, “the ’107 patent”). We denied inter partes review. Paper 9 (“Decision” or “Dec.”). Petitioner requests rehearing of the Decision. Paper 10 (“Request” or “Req.”).

II. BACKGROUND

The ’107 patent solves the problem of protecting consumer private information by providing tools that enable an end user or consumer’s device to communicate via email with others such as “relying-parties,” i.e., merchants, without revealing information to the merchant. Ex. 1001, Abs.; *see also* Dec. 4–6 (describing the ’107 patent).

Claim 13 is at issue and is reproduced below:

[13(P)]¹ A non-transitory computer readable medium for a ID cloaking system having instructions stored thereon that are executable by processor electronics to:

[13(a)] receive an email addressed to a cloaked end user address, wherein the email is sent from a relying party email address, and wherein the domain of the cloaked end user address and the domain associated to the cloaked end user address associated to the cloaked ID system are the same domain;

[13(b)] identify an end user specified address associated to the cloaked end user address by an end user profile;

¹ Paragraph labeling in brackets is based on Petitioner’s format identifying the claim elements. *See* Pet. 13–35 (showing for claim 13). We adopted the same format for purposes of the Decision. Dec. 6 n.3.

[13(c)] determine whether the end user profile contains a previous association between the relying party address and a cloaked relying party email address, wherein the relying party address has a different domain than the cloaked relying party email address;

[13(d)] where the end user profile *does not contain a* previous association between the relying party address and the cloaked relying party email address, then generate a new cloaked relying party email address and associate the new cloaked relying party email address to the end user profile, the cloaked end user address, wherein the new cloaked relying party email address is generated with a domain different than the relying party address; and

[13(e)] send the email to the identified end user specified address, wherein the email is configured with a reply-to email address comprising the new cloaked relying party email address.

Ex. 1001, 31:8–32:4 (emphasis added on disputed limitation 13(e)).

Petitioner’s showing regarding limitation 13(e) relied on the reference to Lee (Ex. 1004) and the Terveen Declaration (Ex. 1003). Pet. 31–35 (citing Ex. 1004 (US Pat. No. 8,458,264 B1); Ex. 1003 ¶¶ 83, 85). Our Decision determined Petitioner failed to sufficiently show limitation 13(e). Dec. 18–25.

III. STANDARD OF REVIEW

A party requesting rehearing of a Board decision has the burden to show that the decision should be modified. Pursuant to 37 C.F.R. § 42.71(d), a rehearing request must identify, specifically, 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. When rehearing a decision on a petition, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c).

An abuse of discretion may arise if: (1) a decision is based on an erroneous interpretation of law, (2) a factual finding is not supported by substantial evidence, or (3) an unreasonable judgment is made in weighing relevant factors. *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). Petitioner does not allege an abuse of discretion but does allege that the panel misapprehended or misunderstood limitation 13(e). Req. 12–15.

IV. ANALYSIS

Petitioner’s Argument

Petitioner first describes the relevant technology in the context of “standard terminology” and the ’107 patent’s terminology. Req. 2–7. Petitioner then argues that Patent Owner conflated the terminology. *Id.* at 12. Because of purported confusion, Petitioner asserts the Decision misapprehended the requirements of limitation 13(e) and Petitioner’s theory of invalidity. *Id.* at 2–3, 12.

1. Terminology Differences

Petitioner argues “the ’107 Patent confusingly uses the phrase “reply-to” to describe something different than the Standard’s ‘Reply-to’ field.” Req. 4. Petitioner explains that the ’107 patent’s “reply-to” address has nothing to do with the Standard ‘Reply-to’ field but is instead language the patentee chose to refer to the address portion of a Standard ‘From’ field—a field that functionally directs responsive communications when the user replies to the email.” *Id.*

In the Request, Petitioner argues that “Lee fails to rely on a Standard ‘Reply-to field,’” which is also how the “reply-to” address is described and claimed in the ’107 patent. Req. 12 n.4. Petitioner now

argues the alleged difference in terminology means the “reply-to email address” as “identical” to the “Standardized terminology.” Req. 7. Petitioner argues alternatively that “even if limitation 13(e) were interpreted to require a Standard ‘Reply-to’ field address (it should not be), the Petition established that it would have been obvious to use the Standard ‘Reply-to’ field because, in the context of limitation 13(e), it is functionally identical to the ‘From’ field Lee uses.” *Id.* at 8. Lee thus teaches the “reply-to” address claimed. *Id.*

2. Obviousness of “reply-to” field of Limitation 13(e)

Petitioner acknowledges that the issue upon which the Petition, as well as this Request, turns is obviousness. *See* Req. 12–13 (quoting Dec. 21). Other than a claim construction argument based on terminology differences between Lee and the ’107 patent, Petitioner does not argue how the Decision misapprehended the obviousness showing.

3. Rehearing Discussion

We found, and Petitioner agreed, that Lee “does not disclose a ‘reply-to’ field.” Dec. 21 (citing Pet. 33). As discussed above, Petitioner argues the Petition should be understood to mean a “Standard ‘Reply-to’ field” not the claimed “reply-to address.” Req. 12 n. 4. Contrary to Petitioner’s assertion, the Petition states “Lee does not expressly discuss distinct ‘from’ and ‘reply-to’ fields.” Pet. 33. Petitioner did not construe the “reply-to email address” portion of limitation 13(e) nor did it assert that the “reply-to” address claimed was “identical” to “Standardized terminology” of a “Reply-to field.” *See* Req. 7. The Decision proceeded on the plain and ordinary

meaning of “reply-to email address.” Dec. 21. Paradoxically, Petitioner also argues the term should be construed as “identical” to a “Reply-to field.” Req. 7.

Petitioner also argues Patent Owner’s arguments conflate terminologies and are inconsistent. Req. 8–12. Petitioner criticizes the Decision for demanding “verbatim support for the claimed ‘reply-to’ address.” *Id.* at 12–13 (citing Dec. 21). As a result of the alleged confusion over terminology, Petitioner argues we misapprehended limitation 13(e). Req. 12–15. These arguments are all directed to the meaning of the “reply-to” field.

None of the above arguments were part of the Petition or Petitioner’s Preliminary Reply. New arguments are not made in a request for rehearing. Neither is a Request for Rehearing the time or place to propose new constructions. We could not have misapprehended or overlooked an argument presented for the first time in the Request. Neither is disagreement with the Decision a basis for rehearing.

Accordingly, we do not find that any terminology differences raised in the Request are support for any misapprehension of limitation 13(e) or Petitioner’s theory of invalidity. As we stated in the Decision, the issue remains: has Petitioner “shown another basis for us to conclude that limitation 13(e) would have been obvious to a person of ordinary skill in the art?” Dec. 21.

The Decision articulated Petitioner’s showing on obviousness. Dec. 21–25. We specifically pointed to the conclusory expert testimony as insufficient to find limitation 13(e). *Id.* at 23–24. The

Request also does not raise any error with respect to our obviousness analysis. Again, disagreement alone is not a basis for rehearing.

V. CONCLUSION

Upon review, we see no error in our findings of fact or conclusions of law, nor any unreasonable judgment in our rejection of Petitioner's arguments that Lee teaches or suggests limitation 13(e). For the reasons stated, Petitioner has not demonstrated we misapprehended Petitioner's theory of invalidity nor has Petitioner shown any abuse of discretion.

V. ORDER

Accordingly, it is

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

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