

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WOMBAT SECURITY TECHNOLOGIES,
Petitioner,

v.

PHISHME, INC.,
Patent Owner.

Case PGR2017-00009
Patent 9,398,038 B2

Before JONI Y. CHANG, JENNIFER S. BISK, and
BRIAN P. MURPHY, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

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

SUMMARY

Petitioner, Wombat Security Technologies, Inc., requests rehearing of the Board’s decision (Paper 7) (“Institution Decision”), entered June 8, 2017, denying institution of *inter partes* review of U.S. Patent 9,398,038 B2 (Ex. 1001) (“the ’038 patent”). Paper 8 (“Reh’g Req.”). For the reasons that follow, Petitioner’s request is *denied*.

BACKGROUND

In the Institution Decision, we found that Petitioner had not sufficiently shown that the ’038 patent was eligible for post-grant review. Inst. Dec. 8–13. Specifically, we found deficient Petitioner’s contention that the challenged claims were not entitled to the benefit of the filing date of Application No. 13/785,252 (“the ’252 application”) to which the ’038 patent claims priority as a continuation-in-part. Inst. Dec. 8–13. This finding was based on the following deficiencies of the Petition: (1) the Petition did not discuss the relevant disclosure of the application to which the ’038 patent claims priority—Application No. 13/785,282 (“the ’252 application”)—as originally filed, citing instead to the ’940 patent, which issued from the ’252 application; (2) the Petition did not address the Examiner’s statements in the Notice of Allowability that “[t]he present application is being examined under the pre-AIA first to invent provisions”; and (3) Petitioner did not satisfy its burden to show that a person of ordinary skill in the art would not have understood the inventor to have possession of “providing feedback to the individual confirming that the identified email was a simulated phishing attack” (“the feedback limitation”). *Id.* For the third deficiency, we found the feedback limitation supported by at least paragraphs 5 and 18 of the ’252 application, which discuss training

individuals who receive simulated phishing attacks such that users are better able to recognize and thwart a real phishing attack. *Id.* at 11–12.

According to Petitioner, none of these deficiencies “alone or together, constitute a sufficient reason to deny institution of the post-grant review.” Reh’g Req. 4.

As explained below, we are not persuaded of error in at least the third identified deficiency—the finding that Petitioner did not satisfy its burden to show that a person of ordinary skill in the art would not have understood the inventor to have possession of the feedback limitation. As such, we *deny* Petitioner’s Request for Rehearing. We do not address, in this Decision, the two remaining deficiencies identified in the Institution Decision.

DISCUSSION

The applicable standard for granting a request for rehearing is abuse of discretion. 37 C.F.R. § 42.71(c). The requirements of a request for rehearing are set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

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.

Petitioner argues that our finding that Petitioner had not sufficiently shown the ’038 patent to be eligible for post-grant review was “based upon an

erroneous interpretation of the law and factual findings not supported by substantial evidence.” Reh’g Req. 1.

Petitioner argues that by identifying the feedback limitation as not being recited expressly in the ’252 application it “satisf[ied] its burden to establish that it was more likely than not that the ’038 patent was not entitled to the filing date of the [’252 application].” Reh’g Req. 3. In *Blue Calypso, LLC v. Groupon, Inc.*, however, the Federal Circuit explicitly found that identifying a limitation as not being recited expressly in the specification at issue was not enough to support a finding of lack of written description. 815 F.3d 1331, 1345 (Fed. Cir. 2016). The Federal Circuit explained that it was “troubled by the fact that the Board did not cite any evidence other than the fact that the terms were not present in the specification to support its finding,” concluding this placed “undue weight on the absence of the [exact] terms appearing in the specification.” *Id.* at 1345–46. Petitioner’s burden, therefore, is not established simply by pointing out that the ’252 application does not explicitly state the feedback limitation.

Petitioner further argues that we applied the wrong legal standard in making this determination. Reh’g Req. 7. According to Petitioner, because the Institution Decision agreed that the ’252 application does not disclose, *in haec verba*, the feedback limitation, the appropriate legal standard requires that the feedback limitation “must *necessarily be present*” in the ’252 application “such that one skilled in the art would recognize such a disclosure.” *Id.* at 7–8 (quoting *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159 (Fed. Cir. 1998) (emphasis added by Petitioner)). According to Petitioner, we erred by not applying the “*Tronzo* standard,” which would require the

'252 application to “‘necessarily’ disclose (as *Tronzo* requires) the claimed confirmatory feedback.” *Id.* at 9–10.

We are not persuaded that we applied the wrong legal standard in the Institution Decision. The Federal Circuit has noted that its cases “have used varied language to express the test for determining whether a claim limitation added by amendment is inherent in the originally-filed specification.” *ICN Photonics, Ltd. v. Cynosure, Inc.*, 73 Fed. Appx. 425, 429 (2003). The Federal Circuit refers to *Tronzo* as providing one expression of that test. *Id.* However, the Court also points to cases that express the test as, (1) “one skilled in the art, reading the original disclosure, must *immediately discern* the limitation at issue in the claims,” and (2) “the disclosure need only *reasonably convey* to persons skilled in the art that the inventor had possession of the subject matter in question.” *Id.* (citing *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (emphasis added); *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570 (Fed. Cir. 1996) (emphasis added)). Later, the entire Federal Circuit addressed the issue, holding the “[t]est for sufficiency [of written description of a patent specification] is whether the disclosure of the application relied upon *reasonably conveys* to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharms, Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). This is the standard we applied in the Institution Decision. See Inst. Dec. 11–13.

Petitioner further contends that “[e]ven if it had applied the correct legal standard, the Board’s factual findings are not supported by substantial evidence.” Reh’g Req. 11. Petitioner explains that Patent Owner did not

provide any evidence to support a finding that the '038 patent provides adequate written description support for the feedback limitation. *Id.* at 11–12. On the other hand, according to Petitioner, its expert provided the only testimony on this issue. *Id.* at 12 (citing Ex. 1002 ¶¶ 70, 73). The Petition, however, does not rely on, nor refer to, expert testimony in the section relating to PGR eligibility. *See* Pet. 10–11. And Petitioner does not explain in its Request for Rehearing, where, in its Petition, it relied on this particular testimony.

A request for rehearing is not an opportunity to present new evidence or argument. *See* 37 C.F.R. § 42.71(d). Petitioner cannot expect the Board to read through the entire record, searching for relevant evidence that might support Petitioner's arguments. *Cf., DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir 1999) (“[B]rief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.”). The Petition simply fails to give sufficient notice to Patent Owner and the Board of the arguments and supporting evidence Petitioner sought to rely upon with respect to PGR eligibility.

Upon review, the only portion of the Petition that appears to refer to this specific testimony is the section titled “Ground 3: The Original Specification Does Not Disclose a Plug-in that Provides Confirmatory Feedback to the Individual.” Pet. 28–30. Petitioner appears to acknowledge this deficiency, stating “Petitioner also supplied expert testimony from Prof. Avi Rubin *on the merits of its invalidity challenges.*” Reh'g Req. 3 (emphasis added). Although Petitioner now explains that “[a] portion of Prof. Rubin's testimony is directed to the newly claimed confirmatory feedback and, in particular, the manner that the confirmatory feedback must

be provided” (*id.*), the Petition did not make any connection between this, or any other, testimony to the issue of PGR eligibility.

Even assuming Petitioner provides sufficient notice of its reliance on Professor Rubin’s testimony for the issue of PGR eligibility, we are not persuaded that it supports Petitioner’s position. This testimony focuses on whether the forms of feedback disclosed by the ’038 patent—email and SMS messages—would have been provided by an email client plug-in. Ex. 1002 ¶¶ 70–73. The Petition’s discussion of eligibility does not make this argument. *See* Pet. 11. More importantly, in this testimony Professor Rubin opines on whether a person of ordinary skill would use an email client plug-in to send an email or SMS message to the client. Ex. 1002 ¶ 70:

It is illogical and inefficient for an email client plug-in to send an email or SMS message to the client since the client-side plug-in is already at and running on the client computing device. Instead, it is more logical that an email client plug-in would provide the feedback by displaying a pop-up window or an alert message on the user’s computer screen.

It is unclear how this testimony supports a finding that a person of ordinary skill in the art would not have understood the inventor of the ’252 application to have possession of the feedback limitation. In fact, this testimony appears to support the opposite, that a person of ordinary skill in the art would have been familiar with the mechanics of providing user notification. We, therefore, do not agree with the contention that the only testimony on this issue supports Petitioner’s position on PGR eligibility.

Petitioner also argues in its Request for Rehearing that the ’252 application

plainly does not disclose any of the specifics of: (i) providing feedback when the individual identifies a real (non-simulated) phishing attack (as required in claims 4, 14 and 24) (Petition at 11); (ii) that the email client *plug-in* provides the confirmatory feedback (Petition at 28–30); or (iii) that the confirmatory feedback is provided in response to the comparison step (Petition at 19–29).

Reh’g Req. 10 (emphasis in original). These are new arguments that were not presented in the Petition. Although Petitioner refers to pages in the Petition where these arguments were allegedly made, we are not persuaded that the Petition clearly set forth these arguments. In fact, the entirety of Petitioner’s argument about the effective filing date of the challenged claims is the following:

Although the ’038 Patent claims priority to the both the ’252 and ’538 Applications, its claims recite subject matter that is not disclosed in either of these priority applications. Specifically, the ’038 Patent adds that the email recipient can receive feedback when he/she correctly identifies a phishing email, whether it is simulated or real. Ex. 1001, col. 1:65 - col. 2:3; col. 4:7-14; col. 4:40-46; col. 7:49-64. This material is not included in the ’252 or ’538 Applications (Exs. 1004-1005) but is included in every claim of the ’038 Patent. Each independent claim (claims 1, 11 and 21) of the ’038 Patent recites that confirmatory feedback is provided when an individual identifies a known simulated phishing email. Accordingly, all the independent claims have subject matter that was first disclosed in the CIP application that eventually issued as the ’038 Patent —the confirmatory feedback for identifying known simulated phishing emails. Therefore, the earliest possible filing date for all claims of the ’038 Patent is the date that the CIP application was filed, i.e., June 14, 2013. Because the effective filing date is after March 16, 2013, the ’038 Patent is eligible for PGR. See Pub. L. No. 112-29 (Leahy-Smith America Invents Act) § 3(n)(1).

Pet. 11. All the other pages in the Petition pointed to by Petitioner involve arguments supporting Petitioner's proposed grounds. Pet. 19–30. The Petition does not identify these arguments as relevant to the question of PGR eligibility, an issue on which Petitioner has the burden. We are not persuaded that either Patent Owner or the Board is obligated to scour the Petition looking for arguments that may relate to the issue of PGR eligibility, but that are not identified as such. Thus, these arguments do not advance proper bases for granting a Request for Rehearing.

In sum, Petitioner has the burden to show that the '038 patent is eligible for post-grant review. *See* 37 C.F.R. § 42.20(c) (“The moving party has the burden of proof to establish that it is entitled to the requested relief”); 35 U.S.C. § 326(e) (“In a post-grant review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”); *see also Research Corp. Techs., Inc. v. Microsoft Corp.*, 627 F.3d 859, 870–71 (Fed. Cir. 2010) (holding that the patentee carries the burden to show entitlement to a priority date when the patentee relies on that priority date to overcome an anticipation or obviousness argument). We are not persuaded that the Petition carried this burden.

CONCLUSION

For the foregoing reasons, Petitioner's Request for Rehearing is *denied*.

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