

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MOBILE TECH, INC.,  
Petitioner,

v.

INVUE SECURITY PRODUCTS INC.,  
Patent Owner.

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Case PGR2018-00004  
Patent 9,659,472 B2

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Before JUSTIN T. ARBES, STACEY G. WHITE, and  
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

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

## I. INTRODUCTION

Mobile Tech, Inc. (“Petitioner”) requests rehearing of our Denial of Petition for Post Grant Review (Paper 15, “Dec.”). Paper 16 (“Req. Reh’g”). Petitioner seeks rehearing of our determination not to institute post-grant review. *Id.* at 1. In denying institution, we found that Petitioner failed to establish that U.S. Patent No. 9,659,472 B2 (Ex. 1001, “the ’472 patent”) is eligible for post-grant review. Dec. 16. For the reasons that follow, Petitioner’s request for rehearing is *denied*.

## II. BACKGROUND

Petitioner challenged claims 1–45 under 35 U.S.C. § 112 and 35 U.S.C. § 103 on the following grounds (Paper 1, 4–5 (“Pet.”)):

| Reference(s)                                   | Basis    | Claims Challenged                 |
|------------------------------------------------|----------|-----------------------------------|
| N/A                                            | § 112(a) | 1–45                              |
| N/A                                            | § 112(b) | 1–45                              |
| Rothbaum <sup>1</sup> and Denison <sup>2</sup> | § 103    | 1–10, 12–15, 17–32, 34–43, and 45 |
| Rothbaum, Denison, and Ott <sup>3</sup>        | § 103    | 16, 33, and 44                    |
| Rothbaum, Denison, and Deguchi <sup>4</sup>    | § 103    | 1–10, 12–15, 17–32, 34–38, and 41 |
| Rothbaum, Denison, Deguchi, and Ott            | § 103    | 16 and 33                         |

Post-grant review is only available for patents that issue from applications that at one point contained at least one claim with an effective

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<sup>1</sup> U.S. Patent 5,543,782, issued Aug. 6, 1996 (Ex. 1003, “Rothbaum”).

<sup>2</sup> U.S. Patent Pub. 2004/0201449 A1, pub. Oct. 14, 2004 (Ex. 1002, “Denison”).

<sup>3</sup> U.S. Patent No. 6,380,855, issued Apr. 30, 2002 (Ex. 1005, “Ott”).

<sup>4</sup> U.S. Patent Pub. 2004/0003150 A1, pub. Jan. 1, 2004 (Ex. 1004, “Deguchi”).

date of March 16, 2013, or later. See Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), §§ 3(n)(1), 6(f)(2)(A). Even though the ’472 patent issued from an application having a filing date of January 3, 2017 (Ex. 1001, at [22]), Patent Owner asserted that the challenged claims are entitled to an earlier effective filing date due to a chain of priority from applications dating back to at least June 27, 2011. Paper 9, 3–4.

Petitioner contended that the claims were not entitled to the earlier filing date because, according to Petitioner, the applications in the chain of priority do not provide § 112 support for the following two features: (1) a programming station that is incapable of generating more than a single security code, as required by claim 25, and (2) a security code that is usable in only a single retail store, as required by claims 1–45. Pet. 8–13. As explained in the Decision, Petitioner failed to establish that claims 1–45 are not entitled to a filing date of at least June 27, 2011, because Petitioner failed to establish that any of the challenged claims lacks § 112 support. Dec. 12, 15–16. As a result, we found that Petitioner failed to establish the ’472 patent’s eligibility for post grant review, and we denied institution. *Id.* at 16–17.

In its rehearing request, Petitioner raises arguments addressing our findings regarding § 112 support for the security code that is usable in only a single retail store. See Req. Reh’g 1.

### III. STANDARD OF REVIEW

“The burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). When requesting rehearing of a decision, the challenging party must identify specifically all

matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in the record. *Id.* When considering a request for rehearing of a decision on whether to institute trial, the Board reviews its decision for an abuse of discretion. 37 C.F.R. § 42.71(c). “An abuse of discretion occurs where the decision is based on an erroneous interpretation of the law, on factual findings that are not supported by substantial evidence, or represents an unreasonable judgment in weighing relevant factors.” *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005) (citing *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004)). We address Petitioner’s arguments with these principles in mind.

#### IV. ANALYSIS

As noted above, we found that Petitioner failed to establish that the ’472 patent is eligible for post-grant review. Dec. 16. Here, eligibility for post-grant review depends on the effective filing date of the challenged claims. When determining the effective filing date, a claim is entitled to the benefit of an earlier filing date when an earlier application discloses the claimed invention “in the manner provided by § 112(a) (other than the requirement to disclose the best mode).” *See id.* at 6 (citing *US Endodontics, LLC v. Gold Standard Instruments, LLC*, Case PGR2015-00019, slip. op. at 7 (PTAB Dec. 28, 2016) (Paper 54)). The ’472 patent was the latest in a chain of continuation applications that dates back to U.S. Patent Application No. 13/169,968<sup>5</sup> (“968 Application”), which was filed on June 27, 2011. Ex. 1001, at [63]. We previously determined that the 968

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<sup>5</sup> There are other applications in this chain, but none of those applications are relevant to the issues presented here and thus, we do not address those applications.

Application and the '472 patent have substantially identical specifications and figures. See Dec. 7 (finding that the 968 Application and the patent application from which the '472 patent issued are substantially identical). We thus determined that we were able to “analyze the '472 patent’s eligibility for post grant review through a discussion of Petitioner’s arguments as to written description support in the '472 patent.” *Id.* at 8. We then found that Petitioner failed to establish that the challenged claims lack written description support or are not enabled. See *id.* at 12, 15–16.

Petitioner asserts that we erred in finding proper written description support and an enabling disclosure for the limitation that a “single security code” is “usable in only a single retail store,” by assuming that each programming station has a security code different from any other security code. Req. Reh’g2. Petitioner contends that “the '472 Patent discloses multiple programming stations having the same code,” which would run contrary to our purported assumption. *Id.* Petitioner provides several arguments to support its contention that multiple programming stations have the same code, and we address each of these below.

First, Petitioner asserts that Figure 12A discloses that “if a non-blank key is inserted into a second, non-programmed programming station, the key’s [Security Disarm Code (SDC)] is copied into that programming station.” *Id.* at 3 (citing Ex. 1001, Fig. 12A). Petitioner argues that this teaching supports the conclusion that “a key programmed with an SDC from a programming station at a first store can program that same SDC into a second programming station at a second store.” *Id.* According to Petitioner, this shows that “the ‘single security code’ is . . . usable in multiple stores,” which would run contrary to what the challenged claims recite. See *id.*

Figure 12A of the '472 patent is reproduced below.

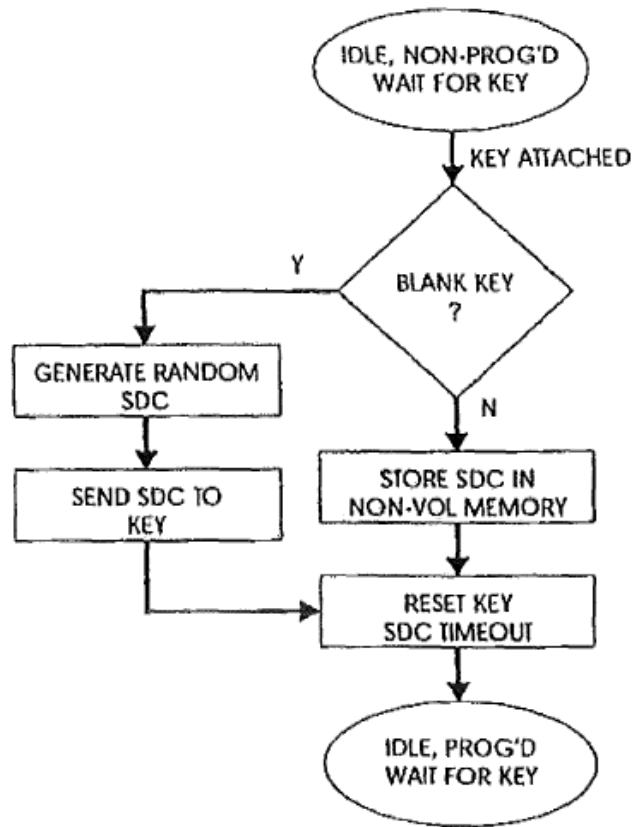


FIG - 12A

Figure 12A is “a flow chart depicting the operation of the logic control circuit of the programming station.” Ex. 1001, 5:38–40. The only explicit description of Figure 12A in the '472 patent is that “Figs. 12, 12A and 12B show in flow chart form additional details of the manner and method of operation of the logic control circuit 18 of programming station 3.” *Id.* at 12:3–6. Petitioner has not persuaded us that one of ordinary skill in the art would have understood the '472 patent to disclose that after a programmable

key is inserted into a programming station, the key's SDC is copied into that programming station, such that a key programmed at one retail store's programming station could be used to program its SDC into a second programming station at a different retail store. See Req. Reh'g 3 (alleging that "the '472 Patent *explicitly* allows multiple programming stations to all be programmed with the same security code" and that "[a]s disclosed in Figure 12A, if a non-blank key is inserted into a second, non-programmed programming station, the key's SDC is copied into that programming station").

The '472 patent expressly recites:

Actuation of activation switch 85 causes logic control circuit 18 of programming station 3 to randomly generate a unique security code (i.e. SDC) that is transmitted via communication circuit 20 to communication circuit 79 of programmable key 5, which in turn *stores the randomly generated SDC in security code (SDC) memory 81 of the key . . . .*

[T]he SDC initially *provided by the programming station 3* is randomly generated and is *unique to that programming station* and *always remains with that programming station* for subsequent use. Thus, the SDC initially generated always stays with the programming station 3 and is subsequently *programmed into one or more programmable keys 5*.

Ex. 1001, 9:23–43 (emphases added); see also *id.* at 10:6–12 ("[T]he particular programming station 3 of the retail store [is] used to program the key with the SDC."). The '472 patent also discloses that the programming station "reprogram[s] or refresh[es] the SDC into the key" after the programmable key times out, which occurs after a predetermined period elapses from the time that the programmable key was last programmed or refreshed. See *e.g., id.* at 12:63–13:8. Specifically, the programming station performs a "handshake" with the key "to determine whether the key has not

previously been programmed with a SDC (i.e. a ‘new’ key), or is an authorized key that is being presented to the programming station a subsequent time to refresh the SDC,” and once a proper “handshake” is completed, the programming station “permits the SDC generated by the logic control circuit and/or stored in the memory to be transmitted . . . [to] the programmable electronic key.” *Id.* at 16:4–19. Thus, the programming station is responsible for generating the SDC and transmitting it to the programmable key. More to the point, the ’472 patent discloses that “the programming station will *deactivate* a SDC stored *in the SDC memory of a key* if an incorrect SDC is encountered when the programming station is attempting to reprogram or refresh the key.” *Id.* at 13:13–17 (emphases added). This contradicts Petitioner’s proposition that a key programmed with one SDC from a first programming station can then program that same SDC into a second programming station. The ’472 patent expressly teaches how to deal with a situation in which a second programming station encounters an incorrect SDC in the memory of a key: it deactivates the SDC stored in the key.

In view of these teachings, we find that a person of ordinary skill in the art would understand the ’472 patent to disclose a programming station storing the SDC in the memory of a programmable key. We are not persuaded that Figure 12A discloses that “if a non-blank key is inserted into a second, non-programmed programming station, the key’s SDC is copied into that programming station,” as Petitioner alleges. *See* Req. Reh’g 3. Petitioner’s reading misconceives the invention’s principle of operation and is inconsistent with the ’472 patent’s language quoted above. According to the ’472 patent, the programming station programs the SDC into the

programmable key, not the other way around. See Ex. 1001, 9:36–43. We, therefore, disagree with Petitioner’s assertion that Figure 12A supports a finding that the ’472 patent explicitly allows multiple programming stations to all be programmed with the same security code.

Second, Petitioner argues that nothing prevents a manager who is in charge of multiple stores within a single mall from using the same code at different stores. Req. Reh’g 4. “[O]ne can easily take a non-timed out key and use it to program the code into another programming station (or security devices in another store),” according to Petitioner. *Id.*

Third, Petitioner argues that “[t]he ’472 Patent [claims] recite[] a security code ‘usable in a single retail store,’ not one that is ‘used’ or ‘intended to be used’ in a single store.” *Id.* at 5. Petitioner argues that “[w]hile the specification describes one intended use of the system, the claims-at-issue are not so limited,” and “[w]hether a system infringes or a reference anticipates the ’472 Patent cannot be based upon how the system is used or described as being used.” *Id.* According to Petitioner, “the ‘single security code’ described in the ’472 Patent . . . is capable of being used (*i.e.*, usable) in multiple retail stores and locations.” *Id.*

The ’472 patent expressly recites that “[t]he SDC is unique to a particular retail store, thereby preventing a key from being used at a different retail store than the one from which the key is stolen.” Ex. 1001, 2:35–37. The ’472 patent also expressly recites that “since the SDC in the programmable key 5 is unique to the particular programming station 3 of the retail store that was used to program the key with the SDC, that key cannot be taken to another retail store having the same type of alarm module 7.” *Id.* at 10:6–10. A person having ordinary skill in the art thus would have

understood the '472 patent as teaching that each store would have its own programming station, which in turn generates a unique SDC for use with the store's specific programmable keys and security devices.

In denying institution, we determined that the '472 patent disclosed safeguards that sufficiently show that, at the time of filing, the patentee possessed a security code that is "usable in only a single retail store." Dec. 14–16. Petitioner, in its rehearing request, does not sufficiently show why that determination was based on an erroneous interpretation of the law, on factual findings that are not supported by substantial evidence, or represents an unreasonable judgment in weighing relevant factors. Petitioner does not show that we misapprehended or overlooked the evidence in finding proper written description support and enablement for the claims reciting the "usable in a single retail store" limitation. As such, we are not persuaded that our Denial of Petition for Post Grant Review was an abuse of discretion.

## V. CONCLUSION

For the foregoing reasons, we conclude that Petitioner has not shown that we abused our discretion in denying institution of post-grant review. *See* 37 C.F.R. § 42.71(c).

## VI. ORDER

Accordingly, it is:

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

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