

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GROUPON, INC.
Petitioner

v.

BLUE CALYPSO, LLC
Patent Owner

Case CBM2013-00035
Patent 7,664,516 B2

Before JONI Y. CHANG, MICHAEL W. KIM, and BARBARA A. BENOIT,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On May 25, 2016, a telephone conference call was held between respective counsel for the parties, and Judges Chang and Benoit. Patent Owner initiated the call to request the Office not to publish a certificate to cancel claims 8–12, 14, and 23 of U.S. Patent 7,664,516 B2 (“the ’516 patent”), alleging that the Final Written

Decision (Paper 45) entered on December 17, 2014, includes an error—namely, claims 8–12, 14, and 23, which depend from claim 1 and not claim 2, should not have been included in the anticipation ground of unpatentability. For the reasons discussed below, Patent Owner’s request is *denied*.

During the conference call, we briefly noted the procedural history of the instant proceeding before us:

- On June 25, 2013, Petitioner filed a Petition for a covered business method patent review, challenging the patentability of claims 1–27 and 29 of the ’516 patent. Paper 2.
- Patent Owner filed a preliminary response on September 30, 2013. Paper 7.
- Upon consideration of the Petition and Patent Owner’s Preliminary Response, the Board instituted a covered business method patent review on December 19, 2013, as to claims 1–27 and 29 of the ’516 patent. Paper 11. Specifically, the Board instituted the instant trial on four grounds of unpatentability, including claims 2–15, 20–23, and 29 as anticipated by Paul under § 102(b).¹
- Under 37 C.F.R. § 42.71(c), a party may request rehearing on a Board’s decision to institute a covered business method patent review. The record before us shows that neither party filed a request for rehearing as to the Board’s Decision on Institution.
- Subsequent to institution, Patent Owner filed a Response (Paper 18, “PO Resp.”) and Petitioner filed a Reply (Paper 25). In its Response, Patent Owner

¹ Paul et al., U.S. Patent Application Publication No. 2002/0169835, published on November 14, 2002 (Ex. 1007, “Paul”).

acknowledged that “[t]he Board instituted trial as to claims 2–15, 20–23, and 29 as being anticipated by Paul.” PO Resp. 58. Patent Owner, however, did not present any arguments as to claims 8–12, 14, and 23 for this ground. *See generally* PO Resp.

- On December 17, 2014, the Board entered a Final Written Decision, holding, among other things, that Petitioner had demonstrated by a preponderance of the evidence that claims 2–15, 20–23, and 29 were unpatentable under § 102(b) as anticipated by Paul. Paper 45, 40. Under 37 C.F.R. § 42.71(d), a party dissatisfied with a Board’s final written decision may file a request for rehearing without prior authorization from the Board. In the instant trial, neither party filed a request for rehearing as to the Board’s Final Written Decision.
- On January 16, 2015, Patent Owner filed a notice, as required by 37 C.F.R. § 90.2, notifying the Board that it appealed to the United States Court of Appeals for the Federal Circuit from the Board’s Final Written Decision. Paper 46. On January 28, 2015, and February 4, 2015, Petitioner filed two notices, as required by 37 C.F.R. § 90.2, notifying the Board that it appealed to the United States Court of Appeals for the Federal Circuit from the Board’s Final Written Decision. Papers 47, 48.
- The Federal Circuit entered a Decision on March 1, 2016, with respect to five covered business method patent reviews, including the instant review. *Blue Calypso LLC v. Groupon, Inc.*, 815 F.3d 1331 (Fed. Cir. 2016) (Ex. 3001). Specifically, the Federal Circuit, among other things, affirmed the Board’s conclusion that Paul anticipates the challenged claims of the Blue Calypso

Patents, including claims 2–15, 20–23, and 29 of the '516 patent. *Id.* In its Decision, the Federal Circuit noted that “Blue Calypso also does not argue any distinction between the numerous claims that the Board found unpatentable in view of Paul.” *Id.* at 1342 n.5.

Based on our review of the record, Patent Owner had numerous opportunities, from the time the Decision on Institution was entered, to raise the issue of whether claims 8–12, 14, and 23 are unpatentable in view of Paul.

During the conference call, the parties indicated that Patent Owner requested a rehearing from the Federal Circuit Decision, but was denied. And Patent Owner did not raise the issue regarding the alleged error in the Board’s Final Written Decision before the Federal Circuit. Essentially, Patent Owner—for the first time—requested the Board to correct the alleged error in the Final Written Decision. Patent Owner, however, cited no authority for such a correction of a Board’s final decision after our reviewing court has decided an appeal from the Board’s final decision.

Consequently, we decline to make any modification to the Final Written Decision entered on December 17, 2014. Pursuant to 35 U.S.C. § 328, the Office will issue and publish a certificate canceling claims 2–15, 20–23, and 29 of the '516 patent, which was finally determined to be unpatentable under § 102(b) as anticipated by Paul, in accordance with the Final Written Decision and the Federal Circuit *Blue Calypso* Decision.

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Order

It is

ORDERED that Patent Owner's request that the Office not to publish a certificate to cancel claims 8–12, 14, and 23 of the '516 patent is *denied*.

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