

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE, INC.
Petitioner

v.

UNWIRED PLANET, LLC
Patent Owner

Case CBM2014-00005
Patent 7,024,205

Before MICHAEL W. KIM, JENNIFER S. BISK, BARBARA A. PARVIS, and
GEORGE R. HOSKINS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

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

I. SUMMARY

Unwired Planet, LLC (“Patent Owner”), requests rehearing of the Board’s decision (Paper 10), entered April 8, 2014, authorizing a covered business method patent review of claims 1-6 of U.S. Patent No. 7,024,205 (Ex. 1001, “the ’205 patent”). Paper 12 (“Rehearing Req.”). For the reasons that follow, Patent Owner’s request for rehearing is *denied*.

II. DISCUSSION

The applicable standard for granting a request for rehearing is abuse of discretion. The requirements 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 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.

A trial was instituted on the sole ground that claims 1-6 are unpatentable, under 35 U.S.C. § 112, first paragraph, as lacking written description support for two inter-related limitations concerning “prioritization information.” Patent Owner asserts error in that the Board overlooked an acknowledgement of Petitioner, misapprehended certain teachings of the ’205 patent specification, and overlooked disclosure that provides adequate support for the disputed limitations. Rehearing Req. 1, 6.

Regarding one of Patent Owner’s assertions, Patent Owner contends more particularly that Petitioner acknowledged that the ’205 patent specification describes an embodiment including “prioritization information.” Rehearing

Req. 3. Patent Owner further asserts that because of this acknowledgement, Patent Owner did not perceive any dispute that needed to be addressed in the preliminary response and, thus, need not show in this request where its support was previously identified, as required by 37 C.F.R. § 42.71(d). *Id.* at 15. We disagree.

At this stage in the proceeding, Petitioner contends that the '205 patent specification, as originally filed, does not describe two inter-related limitations recited in independent claim 1. Pet. 40-46. In particular, Petitioner contends, for example, that the specification “never describes” each of these limitations. Pet. 40, 42. Petitioner does identify an example that Patent Owner “must be relying on” (Pet. 43; *see also* Ex. 1002 ¶ 37). However, that statement is a characterization of an argument that Petitioner expected to be raised by Patent Owner in response to the Petition, and is not an acknowledgment of what the '205 patent specification in fact discloses. We, therefore, are not persuaded that we overlooked an acknowledgement requiring reconsideration of our decision or necessitating an evaluation of Patent Owner arguments not presented previously.¹

Patent Owner also asserts that the Board mixed references to subscriber *profiles* with references to subscriber *preferences*, and thus misapprehended the difference between creating and ordering a menu. Rehearing Req. 1, 6. Patent Owner further asserts that these misapprehensions led to an erroneous conclusion that the phrase “preferred service providers that are defined by the network administrator” does not provide adequate disclosure of at least one of the disputed limitations, so as to satisfy the written description requirement. *Id.* at 6, 11-14.

¹ Furthermore, we note that Patent Owner’s request includes inaccuracies regarding the Board’s decision that we do not specifically address here including, for example, an assertion that “[t]he Board did not adopt Petitioner’s specific rational” (Rehearing Req. 3).

Patent Owner's assertions and analyses have either been addressed in our decision (Paper 10) or are presented for the first time in a request for rehearing. A request for rehearing 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. *See* 37 C.F.R. § 42.71(d). Furthermore, we note that the Board has not made a final determination, under 35 U.S.C. § 328(a), and Patent Owner has the option to raise these matter via a response to the petition.

For the foregoing reasons, Patent Owner's request for rehearing is *denied*.

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