

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

RENSSELAER POLYTECHNIC INSTITUTE and
DYNAMIC ADVANCES, LLC
Patent Owner

Case IPR2014-00077
Patent 7,177,798 B2

Before JOSIAH C. COCKS, BRYAN F. MOORE, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

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

INTRODUCTION

Apple Inc. (“Petitioner”) requests rehearing of the Board’s Decision (Paper 12) (“Decision”) not to institute an *inter partes* review of U.S. Patent 7,177,798 (Ex. 1001) (“the ’798 patent”). Paper 13 (“Rehearing Req.”). Petitioner does not seek rehearing of the Board’s decision not to institute trial on the challenges based on the Shwartz, Bouchou, and Dar references. The rehearing request is limited to the Board’s decision not to institute trial on challenges based on the Janas, Warthen, and Waltz references, i.e. grounds 2, 5, 6, and 7. Rehearing Req. 1. For the reasons that follow, Petitioner’s request for rehearing is denied.

DISCUSSION

The applicable standard for a request for rehearing is 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, opposition, or a reply.

Petitioner argues that the Decision misapprehends the explanations, in the Resubmitted Petition (Paper 4) and in the declaration testimony of Dr. James Allen (Ex. 1005), regarding the way in which the Janas and Warthen references describe the limitation “case information,” i.e. how the storage of information about prior uses of the natural language processing systems is described in each reference. Rehearing Req. 2-4. The arguments are unpersuasive.

In our Decision, we noted that “Petitioner bears the burden of proof of showing [case information is disclosed] for each independent claim.” Decision 17. In its rehearing request, as to the issue of whether Janas and Warthen disclose “case information,” Petitioner cites to argument in the Resubmitted Petition regarding challenges to dependent claim 17. Rehearing Req. 4-7, 8, 10-12. These arguments were specifically directed to the limitation of claim 17, but were not directed to limitations of claim 9, from which claim 17 depends ultimately. *See* Pet. 53 (claim chart for ground 5 – anticipation by Warthen), 54-56 (ground 7 – obviousness over Janas and Waltz), 56-57 (ground 8- obviousness over Warthen and Waltz). Because these arguments in the Resubmitted Petition were not directed to independent claims 1 and 9, we decline to consider these arguments with respect to claims 1 and 9 as is now advocated by Petitioner. In that regard, we did not misapprehend or overlook Petitioner’s arguments regarding claim 17 because they were not presented previously as being relevant to claims 1 and 9. A request for rehearing is not an opportunity to supplement the initial petition. *See Avaya Inc. v. Network-1 Security Solutions, Inc.*, IPR2013-00071, Paper No. 32 at 5 (PTAB, July. 2, 2013) (“It is not for the Board to attempt to piece together a petitioner’s position based on other, unrelated arguments in a petition.”); *cf.*, *DeSilva v. DiLeonardi*, 181 F.3d 865, 866-67 (7th Cir 1999) (“A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.”).

Petitioner does cite, in its rehearing request, argument and evidence from pages 45 and 46 of the Resubmitted Petition (citing to Ex. 1011, col. 1, ll. 33-51, col. 2, ll. 3-11; col. 2, l. 55 – col. 3, l. 17, col. 3, ll. 46-50),¹ directed to claims 1 and 9 regarding the Warthen reference. Rehearing Req. 8. In these citations, Warthen discloses a semantic net snapshot and a question answer mapping table, but does not suggest that either of these contain prior uses of the natural language processing method. Additionally, as we noted in the Decision, Petitioner did not explain, in the Resubmitted Petition itself, how these citations relate to storing prior instances of using the natural language processing method of Warthen in the reference dictionary. *See* Dec. 15; *see also*, 37 C.F.R. § 42.104(b)(4) (a petition must identify “[h]ow the construed claim is unpatentable under the statutory grounds,” and “specify where each element of the claim is found in the prior art patents or printed publications relied upon”). Finally, Petitioner’s rehearing request does not advise the Board how it misapprehended these particular arguments and evidence and the relevance of these particular arguments and evidence to storing prior instances of using the natural language processing method of Warthen in the reference dictionary.

In its rehearing request, Petitioner also asserts that the Board overlooked declaration testimony of Dr. Allen generally describing portions of the Janas reference. Rehearing Req. 8. This declaration testimony is described in the Resubmitted Petition as a “summary” of

¹ Petitioner also cites to declaration testimony which we discuss below.

the Janas reference and was not relied on specifically in the Petition with regard to claims 1 and 9. “The Board may exclude or give no weight to the evidence where a party has failed to state its relevance” 37 C.F.R. § 42.104(b)(5). We decline to consider information presented in a supporting declaration, but not discussed in a petition, because, among other reasons, doing so would encourage the use of declarations to circumvent the page limits that apply to petitions. Along those lines, our rules prohibit arguments made in a supporting document from being incorporated by reference into a petition. *See* 37 C.F.R. § 42.6(a)(3). Moreover, the fact that the argument was not presented in the Petition, itself, means that we could not have overlooked it.

Having fully considered Petitioner's arguments, Petitioner's sought-after relief is *denied*.

ORDER

Accordingly, it is

ORDERED that Petitioner's Request for Rehearing is DENIED.

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For PETITIONER:

Hector Ribera
Jennifer Bush
FENWICK & WEST LLP
hribera@fenwick.com
jbush@fenwick.com

For PATENT OWNER:

Tarek Fahmi
FAHMI, SELLERS, EMBERT & DAVITZ
tarek.fahmi@fseip.com

Donald E. Tiller
SKIERMONT PUCKETT LLP
dynamic_team@skiermontpuckett.com