

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MOTOROLA MOBILITY, LLC,  
Petitioner,

v.

INTELLECTUAL VENTURES I, LLC,  
Patent Owner.

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Case CBM2014-00084  
Patent 6,658,464 B2

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Before JAMESON LEE, PHILLIP J. KAUFFMAN,  
and JO-ANNE M. KOKOSKI, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING  
*37 C.F.R. § 42.71*

## I. INTRODUCTION

Petitioner, Motorola Mobility, LLC, filed a revised Petition requesting a Covered Business Methods Review of claims 1, 8, 16, and 17 of U.S. Patent No. 6,658,464 B2 (iss. Dec. 2, 2003) (Ex. 1001, “the ’464 patent”). Paper 7 (“Pet.”). Patent Owner, Intellectual Ventures I, LLC, filed a Preliminary Response. Paper 16. The Board denied institution of a Covered Business Methods Review because Petitioner failed to adequately demonstrate that the ’464 patent is a covered business method patent. (Paper 18, “Decision”). Petitioner filed a Request for Rehearing asking that the Board reconsider its decision not to institute. Paper 20 (“Req. Reh’g”) at 1. For the reasons that follow, the Request is *denied*.

## II. STANDARD OF REVIEW

When reconsidering a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000). The party requesting rehearing has the burden of showing the decision should be modified, and must identify the matters believed to be misapprehended or overlooked by the Board and the place in the record where it previously addressed each matter it submits for review. 37 C.F.R. § 42.71(d).

### III. ANALYSIS

Petitioner proffers four contentions in support of the assertion that our Decision contains an abuse of discretion. First, Petitioner contends the Board considered only pages 8-10 of the Petition, and overlooked the sections of the Petition demonstrating that the subject matter recited in the challenged claims of the '464 patent, "is neither novel nor non-obvious." Req. Reh'g 2-3 (citing the Petition at pages 37-73 as an example of an overlooked section). Second, Petitioner contends that the Board misapprehended or overlooked argument and evidence related to the "selecting" and "storage" steps of the claims, and even absent that argument and evidence, reciting a known technology does not render a method a "Technological Invention" even if the method itself is not novel. Req. Reh'g. 3-4. Third, Petitioner contends that they are not required to show that the claims do not solve a technical problem. Req. Reh'g. 4-6. Fourth, Petitioner contends that the Board misapprehended or overlooked that a software product is an apparatus. Req. Reh'g. 6-8.

Petitioner's first three contentions are premised on the interpretation that Petitioner need only demonstrate one of the two prongs of the technological invention inquiry is not met in order to demonstrate that a patent is not a technological invention under 37 C.F.R. § 42.301(b). Req. Reh'g. 4-6. Specifically, Petitioner contends it is sufficient to demonstrate either, (1) that the claimed subject matter as a whole does not recite a technological feature that is novel and unobvious over the prior art, or (2) that the claimed subject matter does not solve a technical problem using a technical solution. *Id.* (asserting our Decision incorrectly suggests Petitioner must prove both prongs are not met). Petitioner goes on to contend that under 37 C.F.R. 42.301(b), "[a] claim that is not novel and unobvious is not directed

to a technological invention.” *Id.* at 3 (citing 37 C.F.R. 42.301(b)), 4. In sum, Petitioner contends that under the first prong of the test, proving that the challenged claims are unpatentable (not novel and unobvious) demonstrates that the ’464 patent is not a technological invention. This contention implicitly concedes that Petitioner has not shown that the ’464 patent does not solve a technical problem using a technical solution (second prong).

Petitioner’s argument interprets incorrectly both our decision and the first prong of the technological invention inquiry. First, our decision did not require Petitioner to demonstrate both prongs of the technological invention inquiry were not met. Rather, because we determined that Petitioner did not demonstrate sufficiently that the claimed subject matter as a whole does not recite a technological feature that is novel and unobvious over the prior art (the first prong), we then of necessity addressed whether Petitioner had demonstrated that the claimed subject matter does not solve a technical problem using a technical solution (the second prong). Dec. 3-8; *see also* 37 C.F.R. § 42.301 (stating that “the following [prongs one and two] will be considered”).

Second, we disagree with Petitioner’s interpretation that the first prong of the technological invention inquiry under 37 C.F.R. § 42.301(b) only requires that the claim is novel and unobvious. *See* Req. Reh’g. 4-6. Such interpretation effectively removes the technological invention exception to covered business methods patents. The proper inquiry under 42.301(b) is whether the claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art, not whether the challenged claims are novel and unobvious over the prior art. The only portion of the Petition addressing whether a claim as a whole recites a technological

feature was addressed in our Decision.<sup>1</sup> *See* Dec. 3-8 (citing Pet. 8-10). The portion of the Petition that Petitioner contends the Board overlooked or misapprehended addresses only whether the challenged claims are novel and unobvious over the prior art, and does not address whether the claimed subject matter as a whole recites a technological feature. *See* Req. Reh’g 1-5 (citing Pet. 37-73). For these reasons, Petitioner’s first three contentions do not demonstrate an abuse of discretion in our decision.

Petitioner’s fourth contention, namely, that the Board misapprehended or overlooked that a software product is an apparatus, is also unpersuasive. Req. Reh’g. 6-8 (quoting the Decision at 6). The portion of our Decision that Petitioner refers to points out that the Petition asserted a computer and network were well known, while in contrast claim 1 is directed to a software product “for use at a user station.” Dec. 5. Indeed, a computer and a network are not positively recited in claim 1; rather, the claimed subject matter is a software product capable of use with a computer (“user station”) and a network (“communications network”).<sup>2</sup> The claimed software product comprises computer executable instructions that when executed by the processor carry out certain enumerated instructions. *See* Ex. 1001, 60: 39-55. The point of the Decision is that Petitioner focuses on whether a computer and network were well-known, and Petitioner fails to focus on the claimed subject matter as is required. *See* Dec. 6-7 (elaborating on the Petition’s failure to address the claimed subject matter); *see also* Dec. 3 (stating that whether a patent is a covered business method patent under 37 C.F.R. § 42.301(a) focuses on the

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<sup>1</sup> Pages 8-10 of the Petition are Section IV.B., entitled, *One or More Claims of the ’464 Patent is Not Directed to a “Technological Invention.”*

<sup>2</sup> Parenthetical quotes to the nomenclature of claim 1. Ex. 1001, 60:39, 46-47.

claimed method or apparatus).

Consequently, Petitioner has not identified any matter overlooked or misapprehended by our Decision that demonstrates an abuse of discretion.

#### IV. CONCLUSION

For the foregoing reasons, Petitioner has not demonstrated that the Board abused its discretion in denying a Covered Business Method Review of claims 1, 8, 16, and 17 of the '464 patent. Accordingly, Petitioner's Request for Rehearing is *denied*.

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