

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC. AND AMAZON WEB SERVICES, LLC,
Petitioner,

v.

PERSONALIZED MEDIA COMMUNICATIONS, LLC,
Petitioner.

Case IPR2014-01533
Patent 7,805,749

Before KARL D. EASTHOM, TRENTON A. WARD, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

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

I. INTRODUCTION

Amazon.Com, Inc. and Amazon Web Services, LLC (“Petitioner”) filed a request for rehearing (Paper 11, “Rehear. Req.”) of the Board’s Decision to Institute (Paper 7, “Decision”). In the Decision, the Board declined to institute on Petitioner’s challenges asserting that (i) claims 2, 3, 9–13, 18, 24, 49, 52, and 53 of U.S. Patent No. 7,805,749 (Ex. 1001, “the ’749 patent”) are anticipated by Jeffers, and (ii) claims 2, 3, 9–13, 18, 24, 49, 52, and 53 of the ’749 patent would have been obvious in view of Campbell. Decision, 17–20. The Board determined Petitioner failed to demonstrate that Jeffers and Campbell were prior art to the challenged patent claims. *Id.* at 17–20. Thus, the Board declined to institute an *inter partes* review based on the challenges asserting that Jeffers or Campbell rendered the claims unpatentable. The Board, however, determined that Petitioner had demonstrated a reasonable likelihood of showing the challenged claims would have been obvious in view of Powell and Guillou. *Id.* at 20. Therefore, the Board instituted an *inter partes* review based solely on the third challenge presented by Petitioner. *Id.* at 30.

Petitioner seeks rehearing of the Decision, contending that Campbell constitutes prior art to the ’749 patent and requesting that the Board institute a trial on the grounds that claims 2, 3, 9–13, 18, 24, 49, 52, and 53 of the ’749 patent would have been obvious in view of Campbell. Rehear. Req. 1–2.

For the reasons provided below, we *deny* Petitioner’s request for rehearing.

II. DISCUSSION

A. *Standard of Review*

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.” 37 C.F.R.

§ 42.71(d). The party challenging a decision bears the burden of showing the decision should be modified. *Id.* When rehearing a decision on a petition, a panel will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c).

B. Petitioner's Position

Petitioner argues that Campbell is entitled to a priority date of March 31, 1980 by virtue of its priority claim to an earlier-filed U.S. application. Rehear. Req. 3 (citing Petition (Paper 1), 15–16). The Petition states

Campbell (Ex. 1006) was filed as a PCT application on March 31, 1981, published as WO81/02961 on October 15, 1981, and ***claims priority to a U.S. application filed on March 31, 1980 (Ex. 1007)***. Accordingly, Campbell constitutes prior art regardless of whether the claims are entitled to a 1987 or 1981 priority date.

Id. According to Petitioner, Campbell issued on August 20, 1985 and claims priority to two earlier-filed U.S. applications: (1) a parent application filed on November 27, 1981; and (2) a grandparent application filed on March 31, 1980 (“the 1980 grandparent application”). Rehear. Req. 3 (citing Ex. 1006, 1).

Petitioner notes that the November 27, 1981 parent application was a continuation-in-part of the 1980 grandparent application, and that Campbell was also filed as a PCT application and published as WO81/02961 (“WO ’961”). *Id.* Petitioner explains that any subject matter disclosed in Campbell’s continuation-in-part application is entitled to the § 102(e) date of the priority application (i.e., the 1980 grandparent application). Rehear. Req. 4 (citing *In re Lund*, 376 F.2d 982, 988 (C.C.P.A. 1967)). Petitioner contends that in its Petition it stated “Campbell (Ex. 1006) . . . claims priority to a U.S. application filed on March 31, 1980,” and therefore, Campbell constitutes prior art. *Id.* at 5 (citing Petition, 15–16.)

Petitioner then argues that Patent Owner misled the Board regarding the appropriate applicable law by providing an irrelevant argument that “Petitioners had not established an earlier priority date for Campbell because Petitioners did not rely on, or attach as an exhibit, the WO ’961 publication.” Rehear. Req. 5 (citing Paper 6, 35). According to Petitioner, WO ’961 is not necessary to establish the priority claim, because Campbell derives its § 102(e) priority date from its priority claim to the earlier-filed U.S. application. *Id.* at 6 (citing Petition, 15–16; Ex. 1006, 1). Petitioner contends that the Board’s reliance on Patent Owner’s argument regarding WO ’961 led the Board to make a decision based on an erroneous interpretation of the law. *Id.*

Petitioner also now argues that the portions of Campbell relevant to the Petition (Paper 1) were disclosed in the 1980 grandparent application. *Id.* at 9. According to Petitioner, “all of the figures and written description in the 1980 grandparent application (Ex. 1007) were carried forward and disclosed *nearly verbatim* in Figures 1–13 and columns 1–18 of Campbell (Ex. 1006),” and these were the portions of Campbell on which Petitioners primarily relied. *Id.* at 10. Petitioner reasons that the November 27, 1981 continuation-in-part application added relatively little, namely Figures 2a, 2b, and 14–17, as well as the accompanying description in the specification (approximately four columns). *Id.* (citing Ex. 1006, 18:50–22:25). Petitioner concludes that the additional disclosures in the CIP application (i.e., the November 27, 1981 parent application) are not necessary for a determination that Campbell is prior art and invalidates the claims of the ’749 patent. *Id.*

Petitioner further argues that it understood from the prosecution history that the Patent Owner agreed that the relevant portions of Campbell are entitled to a

§ 102(e) date of March 31, 1980. *Id.* at 12. Petitioners argues it had no reason to believe that the status of Campbell as § 102(e) prior art was in dispute, and therefore, did not provide a detailed, line-by-line comparison of Campbell and the 1980 grandparent application. *Id.* According to Petitioner, this issue has long been resolved, and Patent Owner’s arguments regarding Campbell’s priority date are unfounded. *Id.* at 12–13. Therefore, Petitioner believes the Board overlooked evidence submitted with the Petitioner, which established that the relevant portions of Campbell are entitled to a priority date under § 102(e) of March 31, 1980. *Id.* at 14.

C. Analysis

A claim in a patent application is entitled to the benefit of the filing date of an earlier filed, related application if it meets the requirements of 35 U.S.C. § 120. *Hollmer v. Harari*, 681 F.3d 1351, 1355 (Fed. Cir. 2012); 35 U.S.C. § 120. Such requirements include, *inter alia*, that: (1) the written description of the earlier filed application provides support for the claim as of its earlier filing date, as required under 35 U.S.C. § 112; and (2) the later application “contains or is amended to contain a specific reference to the earlier filed application.” 35 U.S.C. § 120; *In re NTP, Inc.*, 654 F.3d 1268, 1277 (Fed. Cir. 2011); *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008). In relation to (1), as stated by the Federal Circuit, “if any application in the priority chain fails to make the requisite disclosure of subject matter [under § 112], the later-filed application is not entitled to the benefit of the filing date of applications preceding the break in the priority chain.” *Hollmer*, 681 F.3d at 1355; *see also Augustine Med., Inc. v. Gaymar Indus., Inc.*, 181 F.3d 1291, 1302–03 (Fed.Cir.1999) (“Different claims of [a CIP] application may therefore receive different effective filing dates. . . . Subject

matter that arises for the first time in [a] CIP application does not receive the benefit of the filing date of the parent application.”).

In an *inter partes* review, the burden is on the petitioner to show the sufficiency of a petition and to demonstrate a reasonable likelihood that it would prevail on a ground of unpatentability. 35 U.S.C. § 314(a); *see* 37 CFR §§ 42.22(a)(2), 42.104(b)(5). With respect to entitlement to any earlier effective priority date, a party must identify, specifically, the disclosure in ancestral applications “that do not share the same disclosure,” and which allegedly show § 112 support for the relied upon priority date. *See, e.g., Polaris Wireless, Inc. v. TruePosition, Inc.*, Case IPR2013-00323, slip. op. at 29 (PTAB Nov. 15, 2013) (Paper 9). Thus, the burden is on Petitioner to demonstrate that there is no break in a patent’s priority chain and the patent is entitled to a specific priority date. Although Petitioner argues that it had no reason to expect Patent Owner to dispute Campbell’s entitlement to a March 31, 1980 priority date,¹ Petitioner admits it did not develop the evidence that the 1980 grandparent application supported the portions of the November 27, 1981 continuation-in-part application that are relied upon by Petitioner. Rehear. Req. 12. Petitioner should not expect the Board to search the record and cull together the evidence necessary to support Petitioner’s arguments. *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 archeologist with the record.”).

¹ Contrary to Petitioner’s argument (Rehear. Req. 12), during prosecution of the application that issued as the ’749 patent, Patent Owner did contest Campbell’s entitlement to a March 31, 1980 priority date and protested the Examiner’s application of Campbell as prior art. *See* Ex. 1003, 688–689. Therefore, the prosecution history provides no refuge for failing to address the issue squarely in the Petition.

Furthermore, a request for rehearing is not an opportunity to expand on evidence and arguments not presented, or to mend gaps in the evidence relied on in the Petition, nor is a request for rehearing a supplemental petition. The Petition, itself, must identify “specific portions of the evidence that support the challenge.” 37 C.F.R. § 42.104(b)(5). “The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.” *Id.* Petitioner has the responsibility to identify and explain in the petition specific evidence that supports its arguments. Put simply, we could not have overlooked or misapprehended arguments or evidence that was not developed sufficiently in the Petition. Furthermore, we will not consider arguments that were not developed in the Petition.

Petitioner has not shown that the Board overlooked a matter addressed in the petition and, therefore, has not carried its burden of demonstrating an abuse of discretion in the Board’s decision.

IV. ORDER

It is hereby ORDERED that Petitioner’s request for rehearing is *denied*.

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