

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

2BCOM, LLC,
Patent Owner.

IPR2020-00996
Patent 7,127,210 B2

Before MICHELLE N. WORMMEESTER, JOHN A. HUDALLA, and
SHARON FENICK, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

DECISION

Granting Petitioner's Request for Rehearing of Final Written Decision
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Unified Patents, LLC (“Petitioner”) filed a Request for Rehearing (Paper 59, “Request” or “Req. Reh’g”) of our Final Written Decision (Paper 58, “Final Written Decision” or “Dec.”) in which we determined that Petitioner did not demonstrate that claims 12–17 and 19–21 of U.S. Patent No. 7,127,210 B2 (Ex. 1001, “the ’210 patent”) are unpatentable. Petitioner additionally requested that the Precedential Opinion Panel (POP) review the Final Written Decision. *See* Ex. 3003; Paper 60. The POP denied the request. Paper 62. Thus, jurisdiction over this proceeding has returned to this panel. *Id.*

For the reasons that follow, Petitioner’s Request for Rehearing is *granted*. We vacate our Final Written Decision, including its dismissal as moot of Petitioner’s Motion to Strike and Patent Owner’s Motion to Exclude. Contemporaneously, we enter as Paper 65 in this proceeding our revised Final Written Decision.

II. REHEARING REQUEST

A. *Legal Principles*

On request for rehearing, “[t]he burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). “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, reply, or a sur-reply.” *Id.*

B. Background

Exhibit 1006 includes a paper by René Nüsser and Rodolfo Mann Pelz (pages 15–22) and certain pages from the front matter of the proceedings of the IEEE Vehicular Technology Conference Fall 2000 (pages 1–14). In the Petition, Petitioner argues unpatentability of the challenged claims of the '210 patent based on two grounds, in each case based on a combination of prior art including Exhibit 1006 (“Nüsser”).¹ Pet. 4–5, 31, 38–87.

In our Final Written Decision, we determined that Petitioner failed to prove by a preponderance of the evidence that Nüsser qualifies as prior art to the '210 patent. Dec. 8. Specifically, we determined that Petitioner had not met its burden to show that Nüsser was a printed publication disseminated or otherwise made available to the extent that interested persons of ordinary skill in the art, exercising reasonable diligence, could have located it as of the critical date of the invention. *Id.* at 17–18; *see id.* at 19–25; *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008). In our analysis, we discussed shortcomings with Petitioner’s showing regarding the date of availability of the digital book version of Nüsser, including issues with the evidence provided by Petitioner’s declarant

¹ In the Request for Rehearing, Petitioner argues that the prior art status of Nüsser should not affect the outcome of this proceeding with respect to claims 12, 14, 16, and 19–21 because “Petitioner did not rely on *Nüsser* to teach any limitations of those claims” but only used Nüsser “as a supporting reference to show a motivation or example of how [one of ordinary skill in the art] would have implemented” the other prior art cited. Req. Reh’g 1–6. While this argument is mooted by our decision here, we note that this is a new argument, and therefore we could not have misapprehended or overlooked it.

Dr. Sylvia Hall-Ellis. Dec. 19–23 (citing, *inter alia*, Ex. 1010 ¶¶ 37, 38, 45–50 (Dr. Hall-Ellis’s first declaration); Ex. 2024 (Dr. Hall-Ellis’s deposition), 24:15–24, 40:6–13, 52:18–56:16)). We found, with respect to the dates on various pages of Nüsser, that “the[se] indicia alone do not substantiate publication by the dates listed [in the indicia, n]or do they overcome significant gaps and inconsistencies in Petitioner’s proofs regarding the date by which Nüsser was made publicly accessible.” *Id.* at 22 (citing Ex. 1006, 1, 2, 10, 15).

We separately considered Petitioner’s showing with respect to a print version of the conference proceedings, finding that the arguments “raise new issues regarding actual dissemination of or the availability of a print version of the proceedings for the conference,” and we determined that the new evidence was improper as relating to a “new direction with a new approach” by Petitioner with respect to the public accessibility of Nüsser. *Id.* at 23–25.

We concluded that Petitioner did not meet its burden to show that Nüsser was disseminated or otherwise made available to the extent that persons of ordinary skill in the art, exercising reasonable diligence, could have located it before the critical date of the invention. *Id.* at 25. Since all the instituted grounds of unpatentability relied on Nüsser, we determined that Petitioner failed to demonstrate that any of the challenged claims are unpatentable based on the instituted grounds. *Id.*

C. Petitioner’s Arguments in the Request for Rehearing

Petitioner argues that we failed to address the evidence presented as a whole, including evidence properly submitted after institution in response to arguments and evidence raised in the Patent Owner Response. Req. Reh’g 7–13. Petitioner argues that the declaration of IEEE’s representative,

Gordon MacPherson (Ex. 1036), and the copyright registration confirm the September 2000 date on the face of Nüsser and demonstrate that Nüsser was publicly accessible before the priority date of the '210 patent. *Id.* Petitioner additionally argues that the Board misapprehended Petitioner's evidence by splitting it into specific theories of availability "based not just on method of access, but also on format (print/digital) and method of cataloging." *Id.* at 13–15.

Petitioner argues that as part of a more holistic evaluation of the evidence, the MacPherson declaration demonstrates that Nüsser was publicly available as of September 2000. Req. Reh'g 7–11, 13–15. Petitioner submits that Mr. MacPherson's declaration referred to the same version of Nüsser that was in the record as Exhibit 1006, and was applicable to Nüsser's general public availability, not only to actual dissemination of a print version of the conference proceedings. *Id.* at 7–11. Petitioner argues, therefore, that we were mistaken in our determination that the MacPherson declaration only relates to the actual dissemination of a print version of the proceedings at a conference. *Id.* Additionally, Petitioner argues that we overlooked our obligation as the fact-finder to compare Exhibit A of the declaration (Ex. 1036, 6–13) with Nüsser (Ex. 1006), which would have confirmed they are identical. Req. Reh'g at 8–10 (citing *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 1371–72 (Fed. Cir. 2021)).

Petitioner also argues that the Board failed to address, and thus misapprehended or overlooked, the copyright registration for the IEEE 52nd Vehicular Technology Conference Proceedings, which included Nüsser. *Id.* at 12. According to Petitioner, the copyright registration lists a "Date of Publication" of "2000-09-24," confirming the September 2000 dates on the

face of Nüsser and demonstrating that Nüsser was publicly accessible at that time. *Id.* at 7–8, 12–13; Ex. 1010, ¶ 28, pp. 75–77 (Attach. B8). Petitioner argues our discussion of the indicia on the face of Nüsser disregarded this additional evidence. Req. Reh’g 7–8, 12–13.

D. Analysis

Petitioner’s argument on rehearing is persuasive. Our Decision correctly noted significant issues with certain declaration evidence submitted to establish the date on which Nüsser was publicly accessible, including Dr. Hall-Ellis’s testimony that it was available electronically on June 23, 2000 and her testimony relating to library records for the digital version of the proceedings. Dec. 19–21 (discussing Ex. 1010 ¶¶ 37, 38, 47, 50; Ex. 2024, 18:6–20:17, 24:15–24, 45:5–20, 62:20–63:10). However, in dismissing Mr. MacPherson’s declaration as directed only to the actual dissemination of a print version, we did not fully consider how his testimony supports the public accessibility of Nüsser. *See id.* at 15–16, 24.

Additionally, in dividing our analysis into an analysis of the print version of the proceedings and the digital version, we did not fully consider the record evidence as relating to versions of the same document. *See id.* at 17 (describing the record as not including “evidence regarding any identity of the print version with the digital version”); *Valve Corp.*, 8 F.4th at 1371–72.

Our discussion of the probative value of the indicia on the face of Nüsser did not consider them in context of the entirety of the evidence presented. Dec. 22 (discussing the probative value of “the indicia alone”). Upon re-evaluation of the totality of the evidence and arguments presented, we determine that Nüsser qualifies as a prior art printed publication, as

discussed in our revised Final Written Decision, Paper 65. Therefore, we grant Petitioner's request for rehearing.

III. CONCLUSION

For the foregoing reasons, we are persuaded that we overlooked certain of Petitioner's arguments and evidence in our Final Written Decision.

IV. ORDER

It is hereby
ORDERED that Petitioner's Request for Rehearing is *granted*; and
FURTHER ORDERED that our Final Written Decision (Paper 58) is vacated.

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Patent 7,127,210 B2

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