

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SQUARE, INC.,
Petitioner,

v.

UNWIRED PLANET, LLC,
Patent Owner.

Case CBM2014-00156
Patent 7,711,100 B2

Before JAMES B. ARPIN, ZHENYU YANG, and KEVIN W. CHERRY,
Administrative Patent Judges.

ARPIN, *Administrative Patent Judge.*

DECISION
Denying Request for Rehearing
37 C.F.R. § 42.208

I. INTRODUCTION

Square, Inc. (“Petitioner”) requests rehearing of our Decision (Paper 11 (“Dec. on Inst.” or “Decision”)), entered on December 24, 2014, denying institution of a covered business method patent review of claims 1–4 of U.S. Patent No. 7,711,100 B2 (Ex. 1001, “the ’100 patent”) on certain asserted grounds. Paper 19, 1 (“Corr. Reh’g Req.”). For the reasons that follow, Petitioner’s Corrected Request for Rehearing is *denied*.

II. BACKGROUND

In its Petition, Petitioner relied on the following references:

Exhibit	References
1005	Behruz Vazvan, “ <i>High Value Added Solutions for Creating New Markets for Mobile Communication Systems and Harmonizing their Mobility Aspects</i> ,” allegedly published September 30, 1996 (“Vazvan”)
1006	U.S. Patent No. 5,682,525 to Bouve <i>et al.</i> , issued October 28, 1997 (“Bouve”)

Pet. iii. Petitioner asserted the following three grounds of unpatentability (Pet. 1–3, 18–73):

Claims	Grounds	References
1–4	35 U.S.C. § 101	<i>Not applicable</i>
1–4	35 U.S.C. § 102(b)	Vazvan
1–4	35 U.S.C. § 103(a)	Vazvan and Bouve

We instituted a covered business method patent review with respect to the challenge under 35 U.S.C. § 101. Dec. on Inst. 2. Because we were not persuaded that Petitioner made a sufficient showing that Vazvan is a printed publication, i.e., that it was publicly accessible, we did not institute with respect to the challenges under 35 U.S.C. §§ 102(b) and 103(a). *Id.* at 17–

20. Petitioner now argues that we misunderstood or overlooked governing law, as well as evidence from the reference itself showing that Vazvan is a printed publication with respect to the '100 patent. Corr. Reh'g Req. 1.

III. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co. Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988). “The burden of showing that a decision should be modified lies with the party challenging the decision.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). In its request for rehearing, the dissatisfied party must (1) “specifically identify all matters the party believes the Board misapprehended or overlooked” and (2) “identify the place where each matter was previously addressed.” 37 C.F.R. § 42.71(d); Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768.

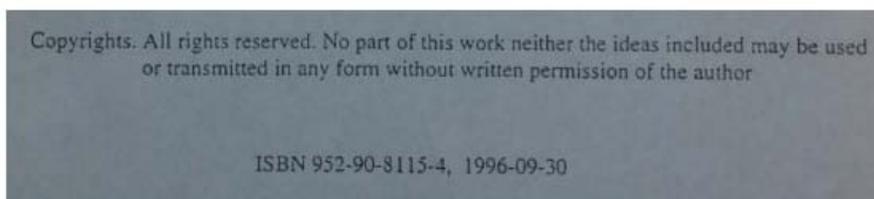
IV. ANALYSIS

In its Corrected Request for Rehearing, Petitioner argues that our determination that Petitioner failed to make a sufficient showing that Vazvan is a printed publication, i.e., that it was publicly accessible, is incorrect for several reasons. Corr. Reh'g Req. 2. First, Petitioner argues that we misapprehended or overlooked the publication date and the copyright notice on the face of the Vazvan reference. *Id.* Second, Petitioner argues that we misapprehended or overlooked the significance of the library markings that appear on the Vazvan reference. *Id.* Third, Petitioner argues that we

misapprehended the significance of the questions raised by Patent Owner in its Preliminary Response concerning the public availability of Vazvan and that these questions should be properly addressed, not by denying institution, but through routine discovery. *Id.* For the reasons set forth below, we disagree.

A. Copyright Notice and Alleged Publication Date

In its Petition, Petitioner argued that “Vazvan was published on September 30, 1996 with ISBN 952-90-8115-4. The effective filing date of the ’100 patent is December 23, 1997. Accordingly, Vazvan is prior art under 35 U.S.C. § 102(b).” Pet. 39 (emphasis added). In its Corrected Request for Rehearing, Petitioner argues that “[t]he cover of the Vazvan reference bears a publication date and corresponding copyright notice. A copyright notice on a prior art reference is *prima facie* evidence that the reference was publicly available as of the notice date.” Corr. Reh’g Req. 3 (reproducing a portion of Ex. 1005, 1). The copyright notice and the ISBN notice are reproduced below:



As noted above, however, Petitioner must identify the place where each matter that we allegedly misapprehended or overlooked previously was addressed in the Petition. 37 C.F.R. § 42.71(d). In its Corrected Request for Rehearing, Petitioner does not cite to, and we are unable to find, where this argument previously was addressed in its Petition; and, in its Petition, the Petition does not argue, or even mention, that the copyright notice date for

Vazvan is September 30, 1996, or that a copyright notice date is prima facie evidence of publication.¹

Petitioner must present its arguments in its Petition, and cannot expect the Board to institute review based on arguments not made and evidence not identified. *See, e.g., DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (Fed. Cir. 1999) (“A brief must make all arguments accessible to the judges, rather than ask them to play archeologist with the record.”); *A.C. Dispensing Equip. Inc. v. Prince Castle LLC*, Case IPR2014-00511, slip op. at 5–6 (PTAB Sep. 10, 2014) (Paper 16) (“Petitioner should not expect the Board to search the record and piece together the evidence necessary to support Petitioner’s arguments.”). We could not have misapprehended or overlooked an argument that was not previously raised, and the Corrected Request for Rehearing is not the place for Petitioner to raise new arguments. *See Berk-Tek LLC v. Belden Tech. Inc.*, Case IPR2013-00057, slip op. at 3 (PTAB May 15, 2013) (Paper 22) (“A request for rehearing is not an opportunity to submit new analysis, after the Decision has noted the deficiencies in the petitioner’s original analysis.”).

Petitioner also argues that we made a legal error in failing to accept the date that Petitioner associates with the copyright notice as a publication

¹ It was Patent Owner who mentioned the notice and argued that the statement accompanying the notice that “[n]o part of this work neither the ideas included may be used or transmitted in any form without the written permission of the author” is evidence against its public accessibility. Prelim. Resp. 37–38. Such limitations on distribution have been considered in weighing evidence of public accessibility. *See Samsung Elecs. Co. Ltd. v. Rembrandt Wireless Techs., LP*, Case IPR2014-00891, slip op. at 8–12 (PTAB Dec. 10, 2014) (Paper 8) (draft available in password-protected form to a limited distribution was not sufficiently accessible).

date. *See* Corr. Reh'g Req. 5. Petitioner argues that the publication date and the copyright notice are prima facie evidence of Vazvan's prior art date. *Id.* at 4–5.

Initially, Petitioner notes that the Federal Circuit found that a copyright *registration* was sufficient evidence of public availability, but acknowledges that the Federal Circuit did not address the question of whether a copyright *notice* on the face of a document also was sufficient. *Id.* at 5 (citing *In re Lister*, 583 F.3d 1307 (Fed. Cir. 2009)). Petitioner alleges, however, that the Board has determined that a copyright notice is sufficient evidence of public availability. *Id.* (citing *FLIR Systems, Inc. v. Leak Surveys, Inc.*, Case IPR2014-00411, slip op. at 18–19 (PTAB Sep. 5, 2014) (Paper 9)).² To the extent that the panel in *FLIR Systems* determined that the date of a copyright notice was evidence of the publication date of a reference, that panel appears to have relied on particular facts of that case. *Id.* at 19 (citing IPR2014-00411, Ex. 1007, 00006 (copyright notice with date appearing in the notice and including revision information)). This is a significant difference from the facts presented by Petitioner regarding Vazvan in this case. *See* Dec. on Inst. 17–20; Ex. 1005, 1 (copyright and ISBN notices, reproduced above). To the extent that it is based on facts different from those presented in the *FLIR Systems* case, the decision in this case is distinguishable over the *FLIR Systems* decision based on the facts.

Despite the copyright notice in this case, we do not assume facts that Petitioner must prove in its Petition, namely, that the September 30, 1996 ISBN date that appears on the face of Vazvan is *its publication date* and that,

² The Board has not designated the cited *FLIR Systems* decision as representative, informative, or precedential.

as of that date, Vazvan was *publicly accessible*. Moreover, it is not the Board's task to prove that the date on the face of Vazvan is *not* the publication date; instead, Petitioner must show that the references that it relies upon to challenge the patentability of the claims of the '100 patent are appropriate prior art for covered business method patent review. 37 C.F.R. § 42.304(b)(2); *see also Elec. Frontier Foundation v. Personal Audio, LLC*, Case IPR2014-00070, slip op. at 20–24 (PTAB Apr. 18, 2014) (Paper 21) (Petitioner bears the burden of proving that a reference is a printed publication). Petitioner further notes that Vazvan was not published in the United States and argues that we cannot evaluate properly Vazvan's copyright notice under U.S. copyright laws. *Id.* at 4. Nevertheless, Petitioner does not show where it argued in its Petition that the copyright laws applicable to Vazvan identify the date associated with Vazvan's copyright and ISBN notices as its publication date or how the interaction between foreign copyright law and U.S. patent law affects the prior art status of this reference. Once again, we could not have misapprehended or overlooked an argument that was not previously raised, and the Corrected Request for Rehearing is not the place for Petitioner to raise new argument.

B. Library Cataloguing and Circulation of Vazvan

Petitioner argues that we misapprehended or overlooked that Vazvan originated from a Finnish library and that this origin is another indication of the public accessibility of Vazvan. Corr. Reh'g Req. 5–6. Specifically, Petitioner argues that the following seal appears on the inside cover of Vazvan:



Id. at 5 (reproducing a portion of Ex. 1005, 2). Petitioner argues in its Corrected Request for Rehearing that “the Vazvan reference bears this stamp [that] shows that it is *currently* publicly available – it was obtained by Square for use in its Petition. It is also, at a minimum, suggestive of the public availability of the Vazvan reference *at or near the time of its publication.*” *Id.* at 7 (emphases added). We note that this seal is undated, and we are not persuaded that the seal is sufficient evidence that Vazvan was publicly accessible prior to the priority date of the ’100 patent. Petitioner does not indicate in its Corrected Request for Rehearing where it argued the significance of this seal to the public accessibility of Vazvan in its Petition (*id.* at 5–8), and we are unable to find where Petitioner cited to the library seal or raised this argument in its Petition. As we noted above, it is not sufficient that evidence may be available in the record, if Petitioner does not argue its significance. We could not have misapprehended or overlooked an argument that was not previously raised, and the Request for Rehearing is not the place for Petitioner to raise new argument.

C. Rebuttal of Prima Facie Evidence

Petitioner argues that Patent Owner’s arguments in its Preliminary Response were insufficient to rebut the prima facie evidence of Vazvan’s

publication date.³ Corr. Reh’g Req. 9–11. In particular, Petitioner argues that

the Board gave significant weight to various statements in the Vazvan reference it found suggestive of a lack of publication. The Board stated that “Petitioner [did] not explain how these statements in Vazvan are consistent with its contention that Vazvan was a printed publication as of the effective filing date of the ’100 patent.” . . . But the explanation is implicit in the remainder of the reference.

Id. at 10–11 (quoting Dec. on Inst. 19). From our review of Vazvan and our consideration of Petitioner’s presented arguments and supporting evidence, we were persuaded otherwise. *See supra* Sec. IV.A. Thus, we did not misapprehend or overlook Petitioner’s arguments and evidence; instead, we found them insufficient in view of Patent Owner’s arguments. Dec. on Inst. 17–20.

D. Improper Reliance on Routine Discovery

Petitioner argues that the copyright notice and the library seal are sufficient to meet the “reasonable likelihood” standard applied by the Board in determining whether to institute review. Corr. Reh’g Req. 8–9 (citing 35 U.S.C. § 314(a)). Petitioner asserts “[t]hat threshold having been crossed, additional facts establishing the public availability of the Vazvan reference are properly the subject of routine discovery in these proceedings.”⁴ *Id.* at 9.

³ Petitioner suggests that Patent Owner’s argument regarding the significance of the positioning of staples in Vazvan “borders on the absurd.” Corr. Reh’g Req. 10; *see* Prelim. Resp. 43–44. However, because we found Petitioner’s showing insufficient for other reasons, we did not reach that argument. Dec. on Inst. 20 n.3.

⁴ Petitioner argues that, to the extent Patent Owner contends that Vazvan was not authenticated properly, Petitioner would be entitled to respond with

Initially, we note that Petitioner incorrectly states the standard for determining institution for a covered business method patent review. Such reviews are governed by 35 U.S.C. § 324(a), which requires that a covered business method review may not be instituted “unless . . . *it is more likely than not* that at least 1 of the claims challenged in the petition is unpatentable” (emphasis added). *See* Dec. on Inst. 1. In order to obtain institution on the asserted grounds of unpatentability based on Vazvan, Petitioner was required to make a sufficient showing under the proper standard that Vazvan, alone and in combination with Bouve, would render the claims unpatentable, which includes a sufficient showing that Vazvan is a printed publication, i.e., that it was publicly accessible. We determined that Petitioner failed to do so. *Id.* at 19–20.

Moreover, as noted above, Petitioner must set forth the reasons for institution on the asserted grounds for unpatentability in its Petition. 37 C.F.R. § 42.304(b). Routine discovery is not an appropriate method for repairing deficiencies in the Petition.

V. CONCLUSION

For the foregoing reasons, Petitioner has not demonstrated that we misapprehended or overlooked matters raised in the Petition in our Decision on Institution. 37 C.F.R. § 42.71(d).

authenticating evidence. Corr. Reh’g Req. 10 (citing Prelim. Resp. 38–40). As we noted, Petitioner’s ability to submit such evidence is governed by the requirements of 37 C.F.R. § 42.64. *See* Dec. on Inst. 20 n.2.

VI. ORDER

Accordingly, it is
ORDERED that Petitioner's Corrected Request for Rehearing is
denied.

PETITIONER:

Sasha G. Rao
Brandon H. Stroy
BINGHAM MCCUTCHEN, LLP
sasha.rao@bingham.com
brandon.stroy@bingham.com

PATENT OWNER:

Timothy E. Bianchi
Thomas C. Reynolds
Joseph Williams
Brett Schuman
SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
tbianchi@slwip.com
treynolds@slwip.com
jwilliams@slwip.com
bschuman@goodwinproctor.com