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Paper 19  
Entered: October 10, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HEWLETT-PACKARD COMPANY  
Petitioner

v.

TECHNOLOGY PROPERTIES LIMITED LLC,  
and MCM PORTFOLIO LLC  
Exclusive Licensee and Patent Owner

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Case IPR2013-00217  
Patent 7,162,549

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Before JONI Y. CHANG, GLENN J. PERRY, and JENNIFER S. BISK,  
*Administrative Patent Judges.*

BISK, *Administrative Patent Judge.*

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

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## SUMMARY

Patent Owner, MCM Portfolio LLC (“MCM”), requests rehearing of the Board’s decision (Paper 10) (“Decision”), entered September 10, 2013, instituting *inter partes* review of claims 7, 11, 19, and 21 of U.S. Patent 7,162,549 (Ex. 1001). Paper 13 (“Rehearing Req.”). For the reasons that follow, MCM’s request for rehearing is *denied*.

## DISCUSSION

The applicable standard for granting a request for rehearing is abuse of discretion. The requirements are 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, an opposition, or a reply.

MCM argues that a Federal Circuit decision issued subsequent to the filing of the Preliminary Response (Paper 9, filed June 28, 2013) requires the Board to reconsider its decision that 35 U.S.C. § 315(b) does not bar institution of *inter partes* review based on HP’s Petition. Rehearing Req. 3. Specifically, the Board determined that MCM’s assertion that HP and Pandigital are successive owners of the same allegedly infringing property was not enough to support the existence of privity between HP and Pandigital for purposes of § 315(b). Decision 7-8.

In its Request for Rehearing, MCM argues that the Federal Circuit’s August 29, 2013, decision in *Aevoe Corporation v. AE Tech Company, LLC*, mandates that *inter partes* review not be instituted. Rehearing Req. 3-4 (citing *Aevoe Corp. v. AE Tech Co.*, 2013 WL 4563014 (Fed. Cir. 2013)). In particular,

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MCM suggests that *Aevoe* requires the Board to consider, on the issue of privity, MCM's notice to HP that HP's sales of products manufactured by Pandigital were infringing MCM's patent and the subsequent notice to HP of the Texas Action against Pandigital involving those products. Rehearing Req. 3-4.

We do not agree that *Aevoe* requires a reconsideration of our decision regarding lack of privity. *Aevoe* involves an order that enjoined AE Tech and its agents from the "making, manufacturing, importing, offering for sale, selling, and/or otherwise using" a particular patent. *Aevoe*, 2013 WL 4563014 at \*3. Thus, the privity relationship at issue in that case was one related to the infringing products and the reach of the governing injunction. *Id.* at \*8 ("[B]y virtue of their distribution agreement, the S&F Defendants were 'privies' of AE Tech, did not act independently of AE Tech, and were, thus, subject to the original injunction. *See Golden State Bottling Co.* 414 U.S. at 179, 94 S. Ct. 414 (stating that a purchaser acquiring property with knowledge that the wrong enjoined remained unremedied is considered in privity for purposes of Rule 65(d)).").

As we have explained, privity is a contextual concept. *Synopsys v. Mentor Graphics Corp.*, IPR2012-00042, Decision to Institute, Paper 16 at 17 (Feb. 22, 2013). The facts and circumstances present in *Aevoe* are not present here. The allegedly infringing products referred to by MCM are not at issue in this proceeding. Thus, we are not persuaded that *Aevoe* requires that we reconsider our decision that MCM has failed to show that HP and Pandigital are privies for purposes of this proceeding.

MCM makes several other arguments relating to the issue of privity and the § 315(b) bar, but does not identify any arguments or evidence that it asserts the

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Board misapprehended or overlooked.<sup>1</sup> *See* Rehearing Req. 9-15; 37 C.F.R. § 42.71(d). A request for rehearing is not an opportunity to express disagreement with a decision.

MCM's request for rehearing is *denied*.

PETITIONER:

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<sup>1</sup> We agree with MCM that there is a typographical error on page 8 of the Decision. The sentence “*Petitioner* provides no persuasive evidence that HP could have exercised control over Pandigital’s participation in the Texas Action” should read “*Patent Owner* provides no persuasive evidence that HP could have exercised control over Pandigital’s participation in the Texas Action.” Decision 8 (emphases added). However, this does not change the outcome of either the Decision or this decision on request for rehearing. An errata correcting the typographical error will be issued simultaneously with this decision.