Trials@uspto.gov
571-272-7822

Paper 55
Entered: November 14, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC., and
BLIZZARD ENTERTAINMENT, INC.,
Petitioner,

v.

AC TECHNOLOGIES S.A.,
Patent Owner.

Case IPR2015-01802
Patent 7,904,680 B2

Before MICHAEL R. ZECHER, MATTHEW R. CLEMENTS, and JEFFREY W. ABRAHAM, *Administrative Patent Judges.*

CLEMENTS, *Administrative Patent Judge.*

DECISION
Granting Petitioner's Request for Rehearing and
Dismissing Petitioner's Motion to Exclude
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(d), Amazon.com, Inc. and Blizzard Entertainment, Inc. (collectively, "Petitioner") request rehearing of our Final Written Decision (Paper 32, "Dec."). Paper 33 ("Req. Reh'g"); Dec. 13–21 (analyzing obviousness). Specifically, Petitioner "submits that the Board overlooked Petitioners' second basis for the [unpatentability] of Claims 2, 4, and 6 based upon the server-to-server portion of Rabinovich's system." Req. Reh'g 2. With our authorization (Paper 34), Patent Owner filed a Response to Petitioner's Request for Rehearing. Paper 35. Patent Owner argued, *inter alia*, that granting Petitioner's Request for Rehearing would violate Patent Owner's due process rights. Paper 35, 5–8.

On July 11, 2017, we issued an Order authorizing Patent Owner to file an additional brief addressing whether claims 2, 4, and 6 are unpatentable under 35 U.S.C. § 103 as obvious over Rabinovich under the construction of "computer unit" adopted in our Final Written Decision, and authorizing Petitioner to file a reply. Paper 36, 4–5.

Patent Owner filed a brief (Paper 47, "PO Br.") to which Petitioner filed a Reply (Paper 49, "Pet. Reply"). Petitioner also filed a Motion to Exclude. Paper 52. Patent Owner filed an Opposition (Paper 53), to which Petitioner filed a Reply (Paper 54).

For the reasons set forth below, Petitioner's Request for Rehearing is *granted*, and Petitioner's Motion to Exclude is *dismissed* as moot.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify

specifically all matters we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *Id.* With this in mind, we address the arguments presented by Petitioner.

III. ANALYSIS

The Petition presents three grounds of unpatentability:

Reference	Basis	Claims challenged
Rabinovich[1]	§ 103	1–15
Rabinovich (under Patent Owner's claim constructions)	§ 102	1, 3, 5, 7–15
Rabinovich (under Patent Owner's claim construction)	§ 103	2, 4, 6

Pet. 4–5. We instituted on the first and second grounds—i.e., claims 1–15 under 35 U.S.C. § 103 as obvious over Rabinovich and claims 1, 3, 5, and 7–15 under 35 U.S.C. § 102 as anticipated by Rabinovich. Paper 10 ("Dec. to Inst.") 26. With respect to the third ground, we stated

> Petitioner argues that claims 2, 4, and 6 are unpatentable under 35 U.S.C. § 103(a) as obvious over Rabinovich. Pet. 56–57. Petitioner presents this as a third ground based upon an alternative claim construction of the term "computer unit." We addressed Petitioner's contentions in our analysis above of Ground 1 and determined that Petitioner has established a reasonable likelihood of showing that claims 2, 4, and 6 are unpatentable as obvious over Rabinovich under our construction of "computer unit." As a result, *this ground is moot*.

[1] Rabinovich, M., et al., "Dynamic Replication on the Internet," Work Project No. 3116-17-7006, AT&T Labs Research Technical Memorandum HA6177000-980305-01TM (March 5, 1998). Exhibit 1006.

Dec. to Inst. 25 (emphasis added). In our Final Written Decision, we determined that (1) Petitioner had not established that claims 1–15 of U.S. Patent No. 7,904,680 B2 (Ex. 1002, "the '680 patent") are unpatentable as obvious over Rabinovich; and (2) Petitioner had established that claims 1, 3, 5, and 7–15 are unpatentable as anticipated by Rabinovich. Dec. 21–38 (analyzing anticipation). Although the third ground incorporated Petitioner's analysis from the second ground, and we were persuaded by the second ground, we did not determine that claims 2, 4, and 6 were unpatentable as obvious over Rabinovich. As a result, Petitioner "submits that the Board overlooked Petitioners' second basis for the [unpatentability] of Claims 2, 4, and 6 based upon the server-to-server portion of Rabinovich's system." Req. Reh'g 2.

In its additional brief, Patent Owner makes two arguments, which we address in turn.

A. Jurisdiction

Patent Owner argues that we lack jurisdiction to determine whether claims 2, 4, and 6 would have been obvious over Rabinovich because we denied institution of this ground as moot. PO Br. 1–2. Petitioner counters that Patent Owner's argument exceeds the scope of the additional briefing we authorized in our Order (Paper 36) and argues that we may consider whether claims 2, 4, and 6 would have been obvious over Rabinovich.

Our reviewing court has held that

> [d]ue process requires notice and an opportunity to be heard by an impartial decision-maker. *Abbott Labs. v. Cordis Corp.*, 710 F.3d 1318, 1328 (Fed. Cir. 2013). As formal administrative adjudications, IPRs are subject to the Administrative Procedure Act ("APA"). [*SAS Institute, Inc. v. ComplementSoft, LLC*, 825 F.3d 1341, 1351 (Fed. Cir. 2016)]. Under the APA, the Board

> must inform the parties of "the matters of fact and law asserted." 5 U.S.C. § 554(b)(3). It also must give the parties an opportunity to submit facts and arguments for consideration. *Id.* § 554(c). Each party is entitled to present oral and documentary evidence in support of its case, as well as rebuttal evidence. *Id.* § 556(d).

Intellectual Ventures II LLC v. Ericsson Inc., 686 Fed.Appx. 900 (Fed. Cir. 2017). By instituting the first ground (i.e., the ground based on obviousness over Rabinovich), we put Patent Owner on notice that we would be determining whether dependent claims 2, 4, and 6 would have been obvious over Rabinovich. To the extent our characterization of the third ground (i.e., another ground based on obviousness over Rabinovich) as "moot" in our Decision on Institution created any ambiguity, we have subsequently received briefing and evidence from both parties to address explicitly whether dependent claims 2, 4, and 6 would have been obvious over Rabinovich based on the construction of "computer unit" in our Decision on Institution and maintained in our Final Written Decision. Both parties have now had adequate notice and opportunity to be heard on that issue. As a result, we are not persuaded that we lack jurisdiction to determine whether claims 2, 4, and 6 would have been obvious over Rabinovich.

B. Obviousness of claims 2, 4, and 6

Dependent claims 2 and 4 depend from independent claims 1 and 3, respectively, and recite "wherein the at least one computer unit and the at least two data storage units are connected over a wireless network." Dependent claim 6 depends from independent claim 5, and recites "wherein the at least one first means and the at least two second data storage means are connected over a wireless network."

Petitioner's contentions in the third ground (i.e., a ground based on obviousness over Rabinovich) with respect to claims 2, 4, and 6 refer back to its contentions in the first ground (i.e., also a ground based on obviousness over Rabinovich). Pet. 56 ("For the same reasons set forth with respect to Claim 2 in Section VI(A)(1) above, [Claim 2] would also have been obvious under Patent Owner's claim construction."), 57 ("For the same reason set forth with respect to Claim 2, Claim [4/6] would have been obvious."). Specifically, Petitioner contends that

> by 1999, wireless networks (either server/server connections or client/server connections) were well known to those of ordinary skill in the art and in common usage (Ex. 1005 at ¶ 262), as noted by the Examiner during the prosecution of the '680 Patent. (Ex. 1009 at 88 ("However, Examiner takes Official Notice that such wireless networks were notoriously well known in the art and commonly used at the time of the invention, for the well known benefit of allowing communication between mobile units, or otherwise desirable to have disconnected from fixed wiring.").) Accordingly, it would have been obvious to a person of ordinary skill in the art that the network of Rabinovich could be either wired or wireless.

Pet. 36.

Patent Owner identifies two types of wireless network—infrastructure and ad hoc—and argues that, "[b]ecause the Board construed **both** the "computer unit" and "data storage units" as hosts . . . the claims necessarily require a wireless connection between two **hosts**" and, therefore, "only the ad hoc wireless network meets the wireless network limitation of the dependent claims." PO Br. 3. Specifically, Patent Owner argues that "the ad hoc network is the only one of the two types of wireless networks that connects **hosts**" and "the wireless connection in [an infrastructure] network is between a host and a **client**." *Id.* at 3–4. Patent Owner then argues that

Rabinovich "is designed to operate in wired networks" and, therefore, a person of ordinary skill in the art would not have used Rabinovich's replication methods on an ad hoc wireless network. *Id.* at 4–6.

Petitioner counters that the "wireless network" recited in the dependent claims is not limited to an ad hoc network and Rabinovich was not designed for use only in wired networks. Pet. Reply 1.

Apart from the claims, the '680 patent does not use the term "wireless network." The specification uses the term "wireless" in only one paragraph:

> The individual components of the inventive system according to an embodiment of the present invention are connected with each other via data transmission means, which can comprise electrically conductive connections, and/or bus systems, and/or computer networks, and/or wired or wireless (mobile) telephone networks, and/or the Internet. The present invention is thus suited for each computer structure and arrangement as well as for each computer system which utilises distributed and networked means.

Ex. 1002, 3:41–49. Thus, the '680 patent itself does not limit the recited "wireless network" to an ad hoc network. Moreover, we are not persuaded by Patent Owner's contention that our construction of "computer unit" requires limiting the recited "wireless network" to an ad hoc network. Specifically, dependent claims 2 and 4 each recite "wherein the at least one computer unit and the at least two data storage units are connected over a wireless network." Dependent claim 6 recites a similar limitation. We construed "computing unit" to encompass any computing device. Dec. 6. We did not, as Patent Owner contends, "construe[] **both** the 'computer unit' and 'data storage units' as hosts" (PO Br. 3). Although our construction *encompasses* Rabinovich's hosts, it does not require the recited "computer unit" and "data storage units" to be hosts. Moreover, even assuming that

both units are Rabinovich's "hosts," dependent claims 2, 4, and 6 require only that they be "connected over a wireless network," not "between" or "directly connected to each other," as Patent Owner contends (PO Br. 3). Thus, we are not persuaded by Patent Owner's contention that two hosts "connected over a wireless network" necessarily requires a wireless connection "between" two hosts. *Id.* Based on our review of the '680 patent, we construe "connected over a wireless network" as broad enough to encompass a connection through a wireless hub.

Because we determine that the "wireless network" recited in dependent claims 2, 4, and 6 need not be an ad hoc network, Patent Owner's argument that Rabinovich's replication method would have been unsuitable for use over an ad hoc network does not persuasively rebut Petitioner's showing.

Having considered the arguments and evidence of both parties, we are persuaded that Petitioner has shown by a preponderance of the evidence that dependent claims 2, 4, and 6 are unpatentable under 35 U.S.C. § 103(a) as obvious over Rabinovich.

IV. MOTION TO EXCLUDE

Petitioner filed a Motion to Exclude Exhibit 2012 and any reference to Exhibit 2012 made by Patent Owner in its Brief. Paper 52, 1. Patent Owner filed an Opposition (Paper 53), to which Petitioner filed a Reply (Paper 54).

We decline to assess the merits of Petitioner's Motion to Exclude. Even without excluding the identified evidence, we have concluded that Petitioner has demonstrated, by a preponderance of the evidence, that claims 2, 4, and 6 are unpatentable. Accordingly, Petitioner's Motion to Exclude is *dismissed* as moot.

V. ORDER

For the reasons given, it is:

ORDERED that Petitioner's Request for Rehearing (Paper 33) is *granted*; and

FURTHER ORDERED that claims 2, 4, and 6 of the '680 patent are held unpatentable;

FURTHER ORDERED that Petitioner's Motion to Exclude is *dismissed* as moot; and

FURTHER ORDERED that, because the analysis contained herein modifies our Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

For PETITIONER:

Daniel T. Shvodian
Christopher L. Kelley
Wing Liang
PERKINS COIE LLP
DShvodian@perkinscoie.com
ckelley@perkinscoie.com
wliang@perkinscoie.com

For PATENT OWNER:

Minghui Yang
HARDY PARRISH YANG, LLP
myang@hpylega.com

Steven E. Tiller
WHITEFORD TAYLOR & PRESTON LLP
stiller@wtplaw.com

Andrew G. DiNovo
DINOVO PRICE ELLWANGER LLP
adinovo@dpelaw.com