

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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IN-DEPTH GEOPHYSICAL, INC. AND  
IN-DEPTH COMPRESSIVE SEISMIC, INC.,  
Petitioners,

v.

CONOCOPHILLIPS COMPANY,  
Patent Owner.

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IPR2019-00849  
Patent 9,632,193 B2

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Before SCOTT A. DANIELS, JAMES A. TARTAL, and  
SCOTT C. MOORE, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

DECISION  
*Denying Petitioner's Request for Rehearing*  
37 C.F.R. § 42.71(d)

## I. BACKGROUND

In a Decision rendered on September 6, 2019, we denied institution of trial with respect to claims 1–6 of U.S. Patent No. 9,632,193 B2 (“the ’193 patent”) on any ground of unpatentability asserted in the Petition. Paper 14 (“Dec.” or “Decision”). The Decision stated that the Petition asserted the following grounds of unpatentability:

<b>Claim(s) Challenged</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>
1, 5, and 6	103	Li, Donoho, Hennenfent I, and Hennenfent II
2 and 3	103	Li, Donoho, Hennenfent I, Hennenfent II, and Essays and Surveys
4	103	Li, Donoho, Hennenfent I, Hennenfent II, and International Encyclopedia

On September 20, 2019, Petitioner filed a Request for Rehearing (“Request” or “Req. Reh’g”) (Paper 15). Petitioner requests that we reconsider the denial of the Petition based on our determination that Petitioner has not shown sufficiently that Li qualifies as prior art under 35 U.S.C. §§ 102 and 311(b) as a printed publication accessible more than a year before the purported November 1, 2012, priority date of the ’193 patent, and requests we institute this proceeding. Req. Reh’g 4, 12.

On request for rehearing, the burden of showing a decision on whether to institute trial should be modified lies with the party challenging the decision. 37 C.F.R. § 42.71(d). “When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). “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.”

37 C.F.R. § 42.71(d). For reasons discussed below, we decline to modify the Decision. Thus, Petitioner’s Request is denied.

We also point out that between the date of our Decision, and this denial of Petitioner’s Request, the Board issued a Precedential Opinion Panel (POP) Decision addressing the question:

What is required for a petitioner to establish that an asserted reference qualifies as a “printed publication” at the institution stage?

*Hulu, LLC v. Sound View Innovations, LLC*, Case IPR2018-01039 Paper 29 at 2 (PTAB Dec. 20, 2019) (Designated: Dec. 20, 2019).

## II. ANALYSIS

### A. *Petitioner’s Arguments on Rehearing*

Petitioner argues in the Request that the Board overlooked the relevance of the date of 1 September 2012 for Li, as this date is cited in the EPO office action, and mistakenly gave credit to the Declaration testimony of Patent Owner’s Expert, Dr. Aminzadeh.<sup>1</sup> Req. Reh’g 4. Petitioner argues further that new evidence, unavailable at the time of filing the Petition, “corroborates Petitioner’s evidence proving Li’s September 1, 2012, publication date and reveals the Aminzadeh Decl. contains false and misleading statements.” *Id.* We address these issues below, in turn, starting with the date of 1 September 2012, alleged by Petitioner as the publication date of Li.

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<sup>1</sup> For consistency with the evidence at issue, we use the European date format corresponding to day, month, year, to refer to the asserted 1 September 2012 publication date.

*B. The EPO Office Action*

Petitioner argues that we overlooked the relevance of the 1 September 2012 date, as evidence of a publication date set forth by the EPO Examiner in the EPO office action (Ex. 1007), issued October 19, 2016. Ex. 1006, 2. Petitioner contends that we should “assume that the EPO, like other patent offices, identifies a date for each reference cited that indicates when the reference was published or became publicly accessible.” Req. Reh’g 7. Petitioner argues “[o]therwise, there would be no official record for confirming its status as prior art.” *Id.* The EPO guidelines for examination state “[b]y ‘relevant’ date is meant the publication date in the case of a previously published document.” Ex. 1031.

First, we did not overlook the date evidence, such as it is, set forth in the EPO office action. In our Decision we considered, specifically, the 1 September 2012 date cited in the European office action as cumulative in relation to Researchgate exhibit. Dec. 6–7. We explained that

[a]lthough the “1 September 2012” date may be indicative of something, without any further information or explanation, and similar to Researchgate exhibit, the “1 September 2012” date provides no explanation as to how and when Li was disseminated and available such that interested and ordinarily skilled persons could locate it exercising reasonable diligence.

*Id.* at 13 (citing *SRI Int’l.*, 511 F.3d 1197 (Fed. Cir. 2008)).

Second, even considering the EPO examination guidelines, Petitioner provides no explanation, persuasive evidence, or analysis that the European office action’s citation to “1 September 2012,” as a purported “publication date,” is based on any knowledge, substantive analysis, or persuasive evidence that any member of the public or relevant scientific community, apart from the authors, had access to Li. Our proceedings require that the

petition identify *with particularity* the grounds for institution and evidence supporting such grounds. 35 U.S.C. § 312(a). While we considered the European office action, Petitioner has not shown there is a presumption (or assumption) that dates identified in foreign filings are correct, or even that the EPO substantively analyzed the publication date issue. Simply pointing to a date, alleged to be a “publication date,” even where that date cascaded through various patent references, without interpretation or explanation, does not meet the threshold standard to show that it is reasonably likely that a reference was publically accessible on that date.

Third, Petitioner’s argument here as to the “relevance” of this evidence, essentially takes issue with the outcome of our Decision and the weight accorded the citation in the EPO office action. Req. Reh’g 6. That Petitioner does not agree with the weight we accorded the citation in the EPO office action or the result of our Decision does not demonstrate persuasively that we overlooked this evidence or misapprehended its relevance.

*C. Dr. Aminzadeh’s Testimony*

Petitioner argues that we mistakenly credited Dr. Aminzadeh’s testimony “even though it did not reflect any personal knowledge of when Li was published and relied on speculation as to an actual publication date.” *Id.*

We agree with Petitioner to the extent that Dr. Aminzadeh did not attest to personal knowledge of the Li paper. Dr. Aminzadeh however provided a credible explanation of the process for authoring and presenting papers at the SEG (Society of Exploration Geophysicists) conference. Dr. Aminzadeh is a member and co-author of SEG papers, as well as a former President of SEG. Ex. 2007 ¶ 3. In our Decision, we explained that

[w]e give weight to Dr. Aminzadeh's testimony because it articulates a reasonable and un rebutted explanation for the September 2012 date listed by Researchgate exhibit. Dr. Aminzadeh's testimony also persuasively explains how and why the dissemination and first public availability of Li would have most likely not occurred prior to the SEG 2012 Annual Meeting from November 4-9, 2012.

Dec. 12. We also stated in our Decision that dissemination "of Li would have most likely not occurred prior to the SEG 2012 Annual Meeting" (*id.*) because, for one reason, Dr. Aminzadeh's un rebutted testimony is that "[a]uthors submit papers to the SEG several months before the SEG conference. The papers are kept confidential by the SEG at that time." Ex. 2007 ¶ 4. Although Dr. Aminzadeh does not testify specifically to knowledge of the Li reference, Petitioner has not explained persuasively why this indicates that Dr. Aminzadeh's testimony as to the SEG confidentiality practices and paper dissemination, as set forth in his Declaration, is inaccurate or misleading.

Petitioner passed up a critical opportunity, perhaps even the only opportunity, to submit relevant additional evidence prior to our Decision denying institution. As noted by the POP panel in *Hulu*,

While the petitioner must submit evidence sufficient to meet the reasonable likelihood standard, some limited opportunities exist for the petitioner to present new evidence later, including: (1) *in a reply to a patent owner preliminary response*; (2) *in a reply to the patent owner response*; and (3) *in a motion to file supplemental information*. 37 C.F.R. §§ 42.108(c), 42.23, 42.123.

*Hulu, LLC v. Sound View Innovations, LLC*, Case IPR2018-01039 (PTAB Dec. 20, 2019) (Designated: Dec. 20, 2019) Slip Op. at 14, (Paper 29) (emphasis added). The appropriate time to submit new evidence was in

Petitioner's Reply to Patent Owner's Preliminary Response. Despite Patent Owner's eight pages of argument and evidence refuting the alleged 1 September 2012 "publication date," in the Preliminary Response, Petitioner declined to address the printed publication issue in its Reply. *See* Dec. 12, n. 10, *see also* Papers 11–12.

We might end the inquiry here. But, for completeness, we explain below why the asserted new evidence is also not persuasive that Li qualifies as a printed publication.

*D. The Asserted New Evidence*

Petitioner now asserts certain new evidence, apparently not available prior to filing the Petition, which allegedly demonstrates a publication date for Li of 1 September 2012.

First, Petitioner identifies an Australian Patent Office action dated July 16, 2019, that identifies Li and the date of "1 September 2012," which Petitioner alleges corroborates the EPO office action as to the date Li was made "publically available." *Id.* at 9 (citing Australian Patent Act 1990 Para. 24(1)(a)). This cumulative evidence is not persuasive for the same reasons as the EPO office action.

Second, Petitioner identifies 2012 SEG papers co-authored by Dr. Aminzadeh that purportedly also identify the "1 September 2012" publication date. *Req. Reh'g* 12 (citing Ex. 1020, Ex. 102[1]). Petitioner alleges that these same "publication dates" of "1 September 2012" show Dr. Aminzadeh's testimony is false and misleading. *Id.* at 8–12.

Even considering this new evidence it is unclear, and again insufficiently explained by Petitioner, how it shows Dr. Aminzadeh's testimony to be misleading. *Id.* at 11. Dr. Aminzadeh was not testifying to a

publication date of Li, or even to his own papers, but as to the typical process and confidentiality practices for submitted SEG conference papers. Evidence of routine business practices can be sufficient to prove the date a reference was made accessible to the public interested in the art. *See In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986), 781 F.2d at 899. (“The probative value of routine business practice to show the performance of a specific act has long been recognized.”). Indeed, whether the date of “1 September 2012” is associated with any SEG paper, e.g., Li or Dr. Aminzadeh’s, Petitioner still provides no underlying explanation or evidence that these documents were made publically available at that time. Thus, the date of “1 September 2012” does not contrast sharply with Dr. Aminzadeh’s testimony.

Third, Petitioner provides what it describes as a copy of a web page from the “updated SEG Library” (Ex. 1026) including the following publication history:



Sep 2012  
Pages: 4609  
ISSN (print):  
1052-3812  
ISSN (online):  
1949-4645

Publisher:  
Society of Exploration Geophysicists

History

Published: 25 Oct 2012  
Published in print: 01 Sep 2012



Req. Reh'g 10 (citing Ex. 1030 ¶¶ 9–15).<sup>2</sup> Petitioner asserts that this publication history and the updated SEG library web page was not available prior to filing the Petition on March 20, 2019. Ex. 1030 ¶¶ 12–14.

Petitioner does not aver, however, that this information was not available when Petitioner was granted authorization, and filed its Reply on July 30, 2019. *See id.* ¶ 14 (Mr. Hudson testifies that “the publication history, which includes the publication date(s) was not available prior to April of 2019.”). Petitioner’s contention that the dates in the updated SEG Library are indicia reflecting when Li became publicly available is a new argument, and a request for rehearing is not an opportunity to supplement the initial petition with new arguments.

Further, even if we were to accept this new web page evidence, and consider it sufficiently authenticated under Fed. R. Evid. 901–902 and not inadmissible hearsay under Fed. R. Evid. 802, in as much as the date is being offered here to prove the truth of the matter asserted—Petitioner fails to provide sufficient explanation, analysis, or testimony as to why “Published in print: 01 Sep 2012” on the updated SEG Library demonstrates public dissemination and access as of that date. .

To be clear, the totality of the evidence, including that from the original Researchgate exhibit, reveals a date, “1 September 2012,” and even taking the purported new evidence in the updated SEG Library web page into account, we see “Published in print” as of that date. However, none of these web pages, nor the EPO or APO office actions, and not Petitioner,

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<sup>2</sup> Ex. 1030 is a Declaration by Mr. James E. Hudson, who testifies that Ex. 1026 “is a true and correct copy of SEG Library-Li, retrieved September 9, 2019 from <https://library.seg.org/doi/abs/10/1190/segam2012-1335.1>

explain *how* or *where* Li was published so as to be accessible in print, or online, e.g., in part, as an abstract, or as a whole. Nor does the evidence and new information explain *to whom*, Li was made available on that date, in any form. Petitioner has not provided sufficient evidence or explanation for example, that the SEG papers authored by Li or Dr. Aminzadeh, were accessible through the SEG website, or otherwise, to the general public or even SEG members in an online format, or physically printed academic or industry journal. *See* Ex. 1020, Ex. 1021, Ex. 1026. Without more, simply pointing to the words “Published in Print” on a web page is not a sufficient showing that Li, or the papers authored by Dr. Aminzadeh were in fact disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence can locate them.

It is Petitioner’s burden to demonstrate at the institution stage a reasonable likelihood that a reference is a printed publication by a preponderance of the evidence. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (“In an [inter partes review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.”). Petitioner presented no additional evidence supporting its contentions, for example from someone familiar with the publication of Li or the referenced web pages, or even an explanation by Petitioner or a declarant that provided a countervailing argument to the SEG process and procedure for publication outlined by Dr. Aminzadeh in his Declaration. Instead, Petitioner simply points to purported “publication dates,” with no substantive explanation or fact witness corroboration. *Req. Reh’g* (citing Ex. 1020, Ex. 1021, Ex. 1026, Ex. 1030).

Although documents indicating a publication date of 1 September 2012 may have relevance, absent additional evidence explaining the origin and meaning of that date as to public accessibility, on the record before us, the date alone fails to show a reasonable likelihood that Li was disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it. This is especially true in the face of Dr. Aminzadeh's unrebutted testimony as to SEG's regular practices surrounding the acceptance and dissemination of SEG conference papers. While his testimony may not speak directly to a date of public accessibility for Li itself, it is relevant, uncontroverted, and probative of accessibility to SEG papers in general, given the bare "1 September 2012" date relied on by Petitioner.

Finally, as we noted above, even after receiving Patent Owner's Preliminary Response, Petitioner declined to address the printed publication issue, this despite requesting a Reply to the Preliminary Response which we authorized. *See* Dec. 12, n. 10, *see also* Papers 11–12. Patent Owner's arguments and evidence in the Preliminary Response directed to printed publication were significant and one of Patent Owner's primary arguments against institution, which covered eight pages, including reliance on Declaration testimony by Dr. Aminzadeh. *See* Prelim. Resp. 10–18 (citing Ex. 1011, Ex. 1005, Ex. 2007). Overall, having considered the arguments and asserted new evidence in Petitioner's Rehearing Request, we determine that Petitioner has not established a reasonable likelihood that Li is a printed publication, and we are unpersuaded that we misapprehended or overlooked any matters raised in the Petition.

*E. The PTAB Precedential Opinion: Hulu, LLC v. Sound View Innovations, LLC, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential).*

The guidance resulting from the Precedential Opinion Panel review in IPR2018-01039 also does not suggest that our Decision should be modified in this proceeding. In that case, the Board held that “indicia on the face of a reference, such as printed dates and stamps, are considered as part of the totality of the evidence.” *Hulu*, Paper 29 at 17–18 (citing *Nobel Biocare Servs. AG v. Instradent USA, Inc.*, 903 F.3d 1365, 1379 (Fed. Cir. 2018)). The Board found that the indicia on the face of the reference at issue on *Hulu* included a copyright date, a printing date, and an ISBN date. *Id.* at 19. The Board determined that this indicia, together with the fact that the reference was a textbook from an established publisher, was sufficient evidence to establish a reasonable likelihood that the reference was a printed publication. *Id.* at 19–20. Here, the evidence does not show that Li has similar indicia on its face. The evidence does not show that publication occurred in a known textbook, scientific journal, or any consistent media form. Neither the Petition nor the new evidence presented by Petitioner, including the EPO and APO office actions and the updated SEG Library web page, explains how or why the 1 September 2012 date is sufficient evidence of a “publication date” corresponding to a date of public accessibility.

### III. CONCLUSION

For the foregoing reasons, Petitioner has not met its burden of demonstrating that the Decision denying instituting trial (Paper 14) should be modified.

IV. ORDER

For the reasons given, it is  
ORDERED that the Petition is denied and no *inter partes* review is  
instituted.

IPR2019-00849  
Patent 9,632,193 B2

PETITIONER:

William P. Jensen  
James E. Hudson  
CRAIN, CATON & JAMES  
wjensen@craincaton.com  
jhudson@craincaton.com

PATENT OWNER:

Dion M. Bregman  
Rick L. Rambo  
Archis Ozarkar  
Alexander B. Stein  
MORGAN, LEWIS & BOCKIUS LLP  
dion.bregman@morganlewis.com  
rick.rambo@morganlewis.com  
neil.ozarkar@morganlewis.com  
alexander.stein@morganlewis.com