UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INGENICO INC.,
Petitioner,

v.

IOENGINE, LLC,
Patent Owner.

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IPR2019-00416
Patent 8,539,047 B2

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Before ELIZABETH M. ROESEL, SHEILA F. McSHANE, and
SCOTT B. HOWARD, *Administrative Patent Judges.*

HOWARD, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request on Rehearing of Final Written Decision
37 C.F.R. § 42.71(d)

INTRODUCTION

IOENGINE, LLC ("Patent Owner") filed a Request for Rehearing (Paper 61, "Req. Reh'g") seeking review of the Board's Final Written Decision (Paper 60, "Final Decision," "Final Dec."). In the Final Decision, we determined that Ingenico Inc. ("Petitioner") had shown by a preponderance of the evidence that claims 1–21, 23–25, 27, and 28 of U.S. Patent No. 8,539,047 B2 (Ex. 1001, "the '047 Patent") are unpatentable.

For the reasons set forth below, Patent Owner's Request for Rehearing is *denied*.

ANALYSIS

A. *Legal Standard*

The applicable requirements for a request for rehearing are set forth in 37 C.F.R. § 42.71(d), which provides:

> A party dissatisfied with a decision may file a single 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 believed 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) (2019).

We review our decision under an abuse of discretion standard. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

   B.   *Patent Owner's Arguments on Rehearing*

      1.   *Construction of "Interactive User Interface"*

In the Final Decision, we concluded that the term "interactive user interface" means "a display containing interface elements with which a user may interact to result in a computer taking action responsively." Final Dec. 18. Patent Owner argues that we "incorrectly resurrected Petitioner's previously rejected, ambiguous reference to a 'computer.'" Req. Reh'g 2 (emphasis omitted). According to Patent Owner, a computer is ambiguous, the challenged claims are unambiguous, and a computer is unsupported. *Id.* at 2–8. We address the three arguments below.

First, Patent Owner argues that the Final Decision "provides no clarity on what 'computer' responds to user interaction." Req. Reh'g 4. According to Patent Owner, this ambiguity is improper. *Id.* at 2–3 (citing *Atlas IP, LLC v. Medtronic, Inc.*, 809 F.3d 599, 608 (Fed. Cir. 2015); *Home Semiconductor Corp. v. Samsung Elecs. Co., Ltd.*, 701 F. App'x 1006, 1011-12 (Fed. Cir. 2017)).

We disagree with Patent Owner that the word "computer," in the context of the Final Decision, leads to ambiguity into the claim construction. As discussed in the Final Decision, "both Petitioner and Patent Owner [agree] that the construction of 'interactive user interface' should include an identification of what responds to the interaction." Final Dec. 16–17.[1]

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[1] We note that page 16 of the Final Decision states "Additionally, we ***disagree*** with both Petitioner and Patent Owner that the construction of 'interactive user interface' should include an identification of what responds to the interaction." Final Dec. 16 (emphasis added). As the context of the Final Decision makes clear, that sentence should have stated "agree" not "disagree."

Rather, the only dispute between the parties was the identification of which computer had to take responsive action. *Id.*

We do not agree with Patent Owner that not specifying a single computer—either the portable device or the terminal—that responds to the interaction adds ambiguity into the claims. Although the construction allows the responsive action to be taken by either the portable device or the terminal, the construction provides an identification of an element (the computer) taking action in order to define the metes and bounds of the claim.[2]

Moreover, we find the two cases cited by Patent Owner to be inapposite. In *Atlas*, the district court's claim construction was open to two possible readings: one that required every remote to transmit a frame or one that required at least one remote to transmit a frame—and was ambiguous on its face. 809 F.3d at 608. In this case, the construction has only a single reading in which "a computer" may include either the terminal or the portable device.

Similarly, in *Home* the Federal Circuit held that the Board added ambiguity by replacing the claim term "over" with "above" and then resolving an ambiguity by interpreting "above." 701 F. App'x at 1011. In

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[2] Patent Owner's assertion that the construction is now broad enough to encompass any other computer, such as a remote network server, presents a straw man argument. *See* Req. Reh'g 4. Patent Owner's position attempts to decouple the construction of the term from the record, which includes the language of the specific claims, the specification disclosures, and well as the arguments presented by the parties. For instance, Petitioner's argument relied not on some other computer such as a remote server, but the computer (Iida's camera) that it mapped to the portable device. Accordingly, we never addressed nor considered whether a remote computer could perform the responsive action.

this case, however, we simply construed "interactive user interface" without making any improper replacement.

Second, Patent Owner argues that the term "interactive user interface" "is unambiguous" and requires that "user interaction results in the terminal taking action responsively by responding to the user." Req. Reh'g 4. Specifically, Patent Owner argues the Final Decision "misapprehends Claims 24 and 25 as requiring the IUI to be generated by first program code executed on the portable device" and "what 'presenting' an [interactive user interface] means." *Id.* at 5.

We disagree. Although the independent claims require a first program code which, when executed, "[cause/causes] an interactive user interface to be presented on the first output component" of the terminal, the claims are silent as which processor controls the interactive user interface. *See* Ex. 1001, 31:3–5, 32:20–22, 33:20–23.

Nor do we agree that we misapprehended or overlooked Patent Owner's arguments regarding the word "presenting." To the contrary we considered, and based on the record at trial, rejected Patent Owner's argument. *See* Final Dec. 67–69.

Third, Patent Owner argues that the inclusion of a "computer" in the construction is not supported. Req. Reh'g 6–8. Specifically, Patent Owner argues that the specification section we relied on makes it clear that terminal—not the portable device—responds to user interaction with the interactive user interface. *Id.* at 6–7. Patent Owner further argues that we ignored the prosecution history and claim language which requires "third program code run by the portable device 'in response to [a] communication[] resulting from user interaction with the [IUI],' not in response to user interaction itself." *Id.* at 7–8 (emphasis omitted) (alterations in original).

We are not persuaded by Patent Owner's arguments that we misapprehended or overlooked the evidence in the record. We have reconsidered the section of the specification cited in the Final Decision (Final Dec. 17–18) and disagree with Patent Owner's reading. Even including the additional sentence Patent Owner relies upon, we still read the section as referring to the portable device responding to the user's interaction with the interface. Nothing in the cited language indicates that the terminal responds in any fashion to the interaction. *See* Ex. 1001, 4:54–66. Moreover, elsewhere, the Specification refers to the portable device's CPU as running the program code that controls the user interface. *See id.* at 22:50–56 (referring to the TCAP's central processing unit 1003 as the "CPU"), 26:7–27 (describing how the CPU executes the program code for the user interface), Fig. 10 (showing the CPU and user interface module as part of the TCAP); *cf.* Final Dec. 6–77 (describing Figure 10 and TCAP 1001).

Furthermore, we did not read out the terminal's ability to respond to user interaction with the user interface. *See* Req. Reh'g 7–8. To the contrary, we found Patent Owner's argument persuasive and modified our original construction from the Institution Decision to allow either computer—the terminal or the portable device—to respond to user interaction with the interface. *See* Final Dec. 17 ("As Patent Owner correctly points out, not all interactive user interfaces that exist generally in the art are associated with a portable device. PO Resp. 20–21. Therefore, in contrast to the preliminary construction in the Institution Decision, we do not define an interactive user interface as requiring that the portable device respond to a user interacting with the interface; instead, we simply refer to a generic computer.").

We also do not find Patent Owner's citation to the prosecution history to be persuasive. *See* Req. Reh'g 7. The cited sections of the prosecution history are silent as to which computer must respond to the user's interaction with the user interface. *See* Ex. 1014, 130, 153, 156–57, 159–67. Instead, the prosecution history simply recites the language of the claims, which we considered. *See* Final Dec. 16–17, 67–69.

Accordingly, Patent Owner has not identified any issues the Board misapprehended or overlooked with regard to the construction of "interactive user interface" and we find no abuse of discretion in our conclusions in the Final Written Decision.

2. *Whether the Combination of Iida and Genske Is Based on Improper Hindsight*

Patent Owner also argues that the combination of Iida and Genske is based on improper hindsight. *See* Req. Reh'g 8–12.

Patent Owner argues that "[w]here an advantage provided by one reference is already possessed by another, it is clear hindsight to combine them." *Id.* at 9. Patent Owner further argues that the Final Decision "relies on hindsight and takes two significant leaps in an entirely different direction, justifying them as a purported 'upgrade.'" *Id.* at 10 (emphasis omitted). Patent Owner also argues that the combination is incompatible with Iida's embodiment and Genske does not disclose a first program code. *Id.* at 12–13.

Except for one issue with we discuss in more depth below, Patent Owner's arguments are not persuasive because they are best characterized as disagreements with the Board's Decision rather than identifying anything we misapprehended or overlooked. Specifically, in the Final Decision we addressed the reasons for the modifications, the alleged incompatibility, and

the teaching of the first program code. *See* Final Dec. 36–48. A rehearing request is not an opportunity to reargue issues that the Board already addressed. *See* 37 C.F.R. § 42.71(d) (limiting rehearing requests to matters "misapprehended or overlooked").

As to the exception noted above, Patent Owner argues "[t]here is no motivation to 'upgrade' when Iida's camera-executed static images already work with all devices. Where an advantage provided by one reference is already possessed by another, it is clear hindsight to combine them." Req. Reh'g 9 (citing *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1369 (Fed. Cir. 2012)). In *Kinetic*, the issue was whether a person having ordinary skill in the art would have combined the teachings publications which "both . . . independently accomplish similar functions, namely, draining fluids." *Kinetic Concepts, Inc*. 688 F.3d at 1369. One set of publications involved negative pressure to drain wounds. *Id.* at 1362–63. The other set of publications disclosed a different type of wound drainage system. *Id.* at 1365. The obviousness theory was predicated on combining the two sets of publications to meet a limitation in the claim of using negative pressure to treat a wound, where wound treatment had not been found to be present in the negative pressure publications. *Id.* at 1361, 1363. Because each publication was complete in teaching a wound drainage method, the court found "a person having ordinary skill in the art, who was merely seeking to create a better device to drain fluids from a wound, would have no reason to combine the features of both devices into a single device." *Id.* at 1369.

The facts of this case are distinguishable. Iida teaches a digital still camera and "an image saving area dedicated to the user [that] is opened on an image server connected to the Internet." Ex. 1003, codes (54), (57).

Among other things, Iida teaches a series of menu screens with which a user interacts. *See*, *e.g.*, Figs. 6A–6H, ¶¶ 56, 83. Iida states that it can be used with devices carried by a user, such as "a portable telephone, PDA (Personal Digital Assistant), wearable computer, or mobile computer." Ex. 1003 ¶ 14 (Iida); Ex. 1002 ¶ 89 (Geier Testimony). Genske was relied upon as an example of a portable cellular telephone and was used by Petitioner to "provide[] more detail regarding the terminal by pointing out that it can include a graphical user interface ('GUI') 215." Ex. 1002 ¶ 89 (citing Ex. 1004 ¶ 55 (Genske)). Thus, unlike in *Kinetics*, there is evidence in this case that there were reasons to modify Iida with Genske's teachings. Further, in the case before us, the teachings of the references are not merely redundant with each other but are additive with Genske providing a graphical user interface that a skilled artisan would incorporate into Iida's design. *See* Paper 1, 57–62 (Petition).

Patent Owner also cites three non-precedential Board decision. *See* Req. Reh'g 9 (citing *Ex parte Bakshi*, Appeal No. 2001-2542 (BPAI Sept. 24, 2003);[3] *Ex parte Toy*, Appeal 2004-0931 (BPAI April 21, 2004)[4]; *Ex parte Richard*, Appeal No. 2016-004425 (PTAB Nov. 8, 2017).[5] This cases stand for the same proposition as *Kinetic*. For example, in *Richard*, the Board determined there was no reason to modify Hennick's polymers with LCST to provide controlled release because Hennick already taught that feature. *See Richard*, at 20. Accordingly, the Board decisions are

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[3] Available at https://e-foia.uspto.gov/Foia/RetrievePdf?system=BPAI&flNm=fd012542
[4] Available at https://e-foia.uspto.gov/Foia/RetrievePdf?system=BPAI&flNm=fd040931
[5] Available at https://e-foia.uspto.gov/Foia/RetrievePdf?system=BPAI&flNm=fd2016004425-11-06-2017-1

distinguishable from the instant case for the same reason as discussed above regarding *Kinetic*.

Accordingly, Patent Owner has not identified any issues the Board misapprehended or overlooked with regard with regard to the combination of Genske and Iida, and we find no abuse of discretion in our findings and conclusions in the Final Written Decision.

3. *Whether the Prior Art Teaches a Local Area Network in the Communications Network*

Patent Owner argues the Board misapprehended its argument that "[t]he antecedent basis for 'communications network' is Claim 1's 'a communications network node,'" and, as a result, "that the 'local area network' of claims 7 and 12 must be between the terminal and portable device on the one hand and a communications network device on the other hand." Req. Reh'g 14 (emphasis omitted). Patent Owner further argues that HomeRF in Iida refers to the wrong connection. *Id.* at 15.

We are not persuaded that we misapprehended or overlooked Patent Owner's argument. To the contrary, we considered, and rejected, Patent Owner's argument in the Final Decision:

> We are also not persuaded by Patent Owner's arguments on whether the use of HomeRF in Iida "relates to the wrong connection." *See* PO Resp. 45 (emphasis omitted). Contrary to Patent Owner's arguments, nothing in independent claim 1 or dependent claims 7 and 12 requires that the communications network be a network containing nodes. *See* PO Resp. 44–45. To the contrary, although claim 1—from which claims 7 and 12 depend—recites a communications network node, claim 1 does not recite a communications network or define where the communications network begins or ends. Thus, the HomeRF system described in Iida is a communications network because it [] allows the camera to communicate with the terminal. *See* Ex. 1002 ¶¶ 56–57.

Final Dec. 64.

Moreover, although we rejected Patent Owner's proposed construction, we also found that claims 7 and 12 would have been obvious under Patent Owner's construction. Final Act. 64–65. Patent Owner does not argue in the Rehearing Request that our conclusion of obviousness on this alternative reasoning was in error. Therefore, even if we erred in not adopting Patent Owner's implicit claim construction—which we did not— we are not persuaded by Patent Owner's argument that we abused our discretion in finding claims 7 and 12 obvious.

Accordingly, Patent Owner has not identified any issues the Board misapprehended or overlooked with regard with regard our conclusion that claims 7 and 12 would have been obvious and we find no abuse of discretion in our conclusions in the Final Written Decision.

CONCLUSION

For the above reasons, Patent Owner has not persuaded us that we misapprehended or overlooked any fact or argument that demonstrates we should modify our Final Written Decision. Therefore, we deny Patent Owner's Request for Rehearing of the Final Written Decision in this proceeding.

ORDER

It is

ORDERED that Patent Owner's Request for Rehearing of the Final Written Decision is *denied*.

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