

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

DOLBY LABORATORIES LICENSING CORPORATION,
Patent Owner.

IPR2021-00275
Patent 10,237,577 B2

Before BRYAN F. MOORE, SHARON FENICK, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Petitioner filed a Petition (Paper 1, "Pet."), requesting an *inter partes* review of claims 1, 7, and 8 ("the challenged claims") of U.S. Patent 10,237,577 B2 ("the '577 patent"). Patent Owner filed a Preliminary Response. Paper 11 ("Prelim. Resp.") (filed as parties and board only); Paper 20 (redacted version). After authorization (Paper 13), Petitioner filed

a Reply (Paper 14) and Patent Owner a Sur-reply (Paper 15, “PO Sur-reply”)) limited to discussing the application of the written description standard in the determination of the priority date for the challenged claims of the ’577 patent.

Upon consideration of the parties’ contentions and supporting evidence, we determined that Petitioner had established a reasonable likelihood that it would prevail with respect to at least one of the challenged claims, and granted institution of *inter partes* review. Paper 21 (“Dec.”).

Subsequently, Patent Owner filed a Request for Rehearing of the Decision granting institution. Paper 24 (“Req. Reh’g”). Patent Owner additionally requested that the Precedential Opinion Panel (POP) review the Decision on Institution. *See* Ex. 3001 (Patent Owner email requesting POP review); Paper 25 (Notification of Receipt of POP Request). The POP denied the request. Paper 29. Thus, jurisdiction over this proceeding has returned to this panel. *Id.*

For the reasons that follow, the Request for Rehearing is *denied*.

II. STANDARD OF REVIEW

On request for rehearing, “[t]he burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). “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, a reply, or a sur-reply.” *Id.* When rehearing a decision on a petition, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings,” or the Board committed “a clear error of

judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted).

III. ANALYSIS

A. *Decision to Institute*

Although Patent Owner contended that nine entities should be listed as real parties-in-interest (RPIs) (Prelim. Resp. 48–70), in the Decision to Institute we declined to resolve whether these parties are in fact RPIs as no time bar or estoppel provisions under 35 U.S.C. § 315 would be implicated in this proceeding and the interest of time and efficiency did not compel such resolution. Dec. 3–5 (applying *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 at 18 (PTAB Oct. 6, 2020) (precedential) (“*SharkNinja*”). In our Decision we noted that Patent Owner had asserted that *SharkNinja* was distinguishable because, according to Patent Owner, “the Petition would be withdrawn were we to insist that additional RPIs be named,” and “Petitioner has not offered and cannot offer to name its members as RPIs.” *Id.* at 4 (citing Prelim. Resp. 69–70). We determined that the purported advantages Patent Owner argued were speculative and did not relate to an advantage in the *inter partes* proceeding before us, and following *SharkNinja*, in the interest of time and efficiency we declined to decide the RPI issues at the time of institution. *Id.* at 3–5.

B. *Rehearing Request*

In its Rehearing Request, Patent Owner contends that it presented evidence that “one or more of nine” entities is an unnamed RPI in this proceeding. Req. Reh’g. 4. Patent Owner argues that we “overlooked Patent Owner’s argument and evidence that addressing the RPI issue *at the institution stage* would promote the interests of cost and efficiency.” *Id.* at 1, 4–5. Because Petitioner “has never represented that it would identify its

Unnamed Members as RPIs if ordered to do so, and has certainly never offered to do so,” Patent Owner argues that Petitioner would terminate the proceeding here, and thus that *SharkNinja* is distinguishable. *Id.* at 4–5.

Patent Owner additionally contends that we “overlooked and misapprehended Patent Owner’s argument regarding the unfair advantage Unified’s Unnamed Members enjoy from being deliberately omitted as RPIs.” *Id.* at 2. Patent Owner argues that we did not address the consequence to potential RPIs of being named a RPI under 35 U.S.C. § 315(e)(1) but only discussed litigation estoppel under § 315(e)(2). *Id.* at 2, 7–8. Patent Owner argues that “resolution of the [RPI issue] in Patent Owner’s favor at the institution stage would promote the interests of cost and efficiency” because it would lead to withdrawal of the Petition. *Id.* at 5. Patent Owner again argues that this is the case because Petitioner “has never argued otherwise, and has certainly presented no contrary evidence nor made any binding contrary representations.” *Id.* at 6.

C. Analysis

While Patent Owner argues that it presented evidence that Petitioner does not have permission to identify certain entities as RPIs if ordered to do so, and that Petitioner has not offered to do so or represented that it would make this identification, we do not agree that we overlooked Patent Owner’s argument or evidence. In the Decision on Institution we summarized exactly these arguments by Patent Owner, and then determined that “this alleged advantage [is] speculative at this point,” and that “Petitioner’s purported inability to name its members as RPIs can be explored, if necessary, after institution.” Dec. 4. Patent Owner’s argument and evidence that the Petition would have been withdrawn were we to have decided the RPI issue before institution was considered, and not overlooked. *Id.* We simply were

not persuaded that this evidence and argument showed that the advantage was not speculative, and determined that deferring the decision to after institution “better serves the interest of cost and efficiency,” following *SharkNinja*. *Id.* at 4–5.

With respect to Patent Owner’s argument that we overlooked and misapprehended that potential RPIs would gain an advantage in prospective future IPRs by not being named in this one, we also disagree with this contention. *See* Req. Reh’g. 2, 7–8. In our Decision on Institution, we wrote, regarding the advantage Patent Owner asserts was obtained by omitting RPIs:

We find this alleged advantage to be speculative at this point. For example, *the purported advantage is to a third party’s ability to avoid estoppel provisions in prospective IPR proceedings*, despite the fact that there is no litigation identified before us involving any of these third parties relating to the validity of the ’577 patent. Thus, the purported advantage described does not relate to an advantage in, or directly related to, the *inter partes* review before us.

Dec. 4 (emphasis added). Patent Owner argues that our analysis focuses only on litigation estoppel, but we discuss the contention that a third party would avoid estoppel in prospective IPR proceedings. *Id.* We specifically discuss litigation involving the potential RPIs relating to the validity of the challenged patent. However, we also describe “prospective IPR proceedings” and conclude that the potential RPIs would not gain advantage in the pending IPR nor is the purported advantage directly related to the pending IPR, that is, this current proceeding. *Id.* Thus, we do not agree that we overlooked or misapprehended the 35 U.S.C. § 315(e)(1) consequence of being named an RPI. To the extent our wording was ambiguous, we reiterate that no advantage to the Petitioner, either from avoiding estoppel

with respect to other proceedings before the office (as described in 35 U.S.C. § 315(e)(1)) or civil actions or other proceedings (as described in 35 U.S.C. § 315(e)(2)) has been shown, as no such proceeding or litigation has been identified.

IV. CONCLUSION

For the foregoing reasons, Patent Owner has not demonstrated that we abused our discretion.

V. ORDER

In consideration of the foregoing, it is hereby
ORDERED that the Patent Owner's Request for Rehearing is *denied*.

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