

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FIDELITY NATIONAL INFORMATION SERVICES, INC.,
Petitioner,

v.

DATATREASURY CORP.,
Patent Owner.

IPR2014-00489 (Patent 5,910,988)
IPR2014-00490 (Patent 6,032,137)
IPR2014-00491 (Patent 5,910,988)¹

Before MICHAEL P. TIERNEY, WILLIAM V. SAINDON, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

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

¹ This decision addresses an issue that is identical in each case. We, therefore, exercise our discretion to issue one Order to be filed in each case. Unless otherwise authorized, the parties, however, are not authorized to use this style heading for any subsequent papers.

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I. SUMMARY

Fidelity National Information Services, Inc. (“Petitioner”) requests rehearing of the Board’s decisions denying institution of an *inter partes* review of U.S. Patent No. 5,910,988 (IPR2014-00489, Ex. 1001, “the ’988 patent”) (IPR2014-00489, Paper 9 (“Decision”); IPR2014-00491, Paper 9) and of U.S. Patent No. 6,032,137 (IPR2014-00490, Ex. 1001, “the ’137 patent”) (IPR2014-00490, Paper 9), entered August 13, 2014. Paper 10 (“Req. Reh’g.”).² For the reasons that follow, Petitioner’s request is denied.

II. DISCUSSION

The applicable standard for a request for rehearing is 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, opposition, or a reply.

Petitioner argues that the Decision misapprehends that the Petition’s reliance on citations to the Gray Declaration is proper under both the governing statute and regulations. Req. Reh’g. 6–8 (citing *Apple Inc. v. Virnetx Inc.*, IPR2014-00237, Papers 15, 24; *Apple Inc. v. Virnetx Inc.*, IPR2014-00238, Paper 15, 24; *SAP Am., Inc. v. Versata Dev. Group, Inc.*,

² Citations provided are to IPR2014-00489. Although the challenged claims and particular citations to prior art in the Requests for Rehearing in IPR2014-00490 and IPR2014-00491 differ, those Requests present the same substantive issues.

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CBM2012-00001, Paper 36–37, n.12). The decisions relied upon by Petitioner, however, do not purport to establish a blanket rule that prior art citations found only in an expert declaration will *always* satisfy 37 C.F.R. § 42.104(b). In the *Apple Inc. v. Virnetx Inc.* cases, the panel held only that “*on the specific facts of this case . . . Apple’s Petition meets the requirements of § 42.104(b)(4), albeit minimally.*” IPR2014-00237, Paper 24, 2-3 (emphasis added). In *SAP Am., Inc. v. Versata Dev. Group, Inc.*, the panel relied upon a claim chart attached to a declaration, but did not determine that it was required to do so by 37 C.F.R. § 42.104(b) under all circumstances. Moreover, Petitioner does not establish that the instant Petition is similar factually to the petitions at issue *Apple* and *SAP*. Even if it did, we would not be compelled to reach the same result because those cases are not precedential.

Petitioner also argues that the Petition provides sufficient direct citations to the references to support institution. Req. Reh’g. 8–9. We disagree. With respect to claim 42, for example, the only direct citation to prior art in the claim-by-claim analysis is for “at least one second local area network for transmitting data within a corresponding one of said at least one intermediate subsystem.” Pet. 23 (citing Ex. 1012, 3:49–51, 7:19–21), *id.* at n.6 (citing Ex. 1012, 6:4–9, 8:29–35). In the claim-by-claim analysis of claim 42 found at paragraphs 715–734 of Mr. Gray’s Declaration, only paragraph 732 includes citations directly to prior art. Ex. 1004 ¶ 732 (citing Ex. 1012, 3:49–51, 6:4–9, 8:29–35). In the Rehearing Request, Petitioner argues that claim 42 includes four elements—T₃E1, T₃E2, T₃E3, and T₃E4—and that these elements are also discussed in Section VII of the Petition. Req. Reh’g. 8. Although Section VII of the Petition includes three figures

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from the prior art, the citations in that section are solely to Exhibits 1004 (Gray Decl.) and 1005 (Muller Decl.); there are no direct citations to prior art. Thus, we are not persuaded that the few direct citations to prior art found in the Petition and in the Gray Declaration establish a reasonable likelihood that claim 42, and the other challenged claims, are unpatentable.

Petitioner also argues that the Gray Declaration is statutorily-allowed evidence in support of a petition, which simplifies and explains the prior art relied upon by the Petition. Req. Reh’g. 10–12. Specifically, Petitioner alleges that our Decision “does not identify any argument in the Gray Declaration that is necessary for institution, but is not found in the Petition.” *Id.* at 10. As discussed above, however, the Petition and the Gray Declaration do not include direct citations to the prior art for every limitation of each challenged claim. Without citations to the prior art, the Petition is merely attorney argument, which is insufficient on this record to establish a reasonable likelihood that Petitioner would prevail in establishing unpatentability.

Finally, Petitioner argues that we should allow it to submit a Revised Petition (Ex. 1051) that includes citations to the references from the Gray Declaration. Req. Reh’g. 13–14. Petitioner argues that the Revised Petition “makes explicit what the Board appears to have found lacking in the original Petition.” *Id.* at 13-14. Petitioner does not identify specific authority to correct a Petition at this stage, nor does Petitioner persuade us that such a correction is appropriate under these facts. Accordingly, Petitioner’s request is denied.

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III. CONCLUSION

For the foregoing reasons, the Board did not abuse its discretion when it determined that the Petition did not establish a reasonable likelihood that claims 22–25, 36–50, and 66–123 of the '988 patent are unpatentable.

IV. ORDER

It is hereby

ORDERED that Petitioner's request for rehearing is *denied*; and
FURTHER ORDERED that Exhibit 1051 is expunged.

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