

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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COX COMMUNICATIONS, INC.,  
Petitioner,

v.

AT&T INTELLECTUAL PROPERTY I, L.P.,  
Patent Owner.

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Case IPR2015-01227  
Patent 7,907,714 B2

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Before MICHAEL R. ZECHER, BRIAN P. MURPHY, and  
SHELIA F. McSHANE, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION

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

## I. INTRODUCTION

Patent Owner, AT&T Intellectual Property I, Limited Partnership (“AT&T”), timely filed a Request for Rehearing under 37 C.F.R. § 42.71(d). Paper 15 (“Req. Reh’g”). AT&T’s Request for Rehearing seeks reconsideration of the Decision to Institute an *inter partes* review of claims 1–22 of U.S. Patent No. 7,907,714 B2 (Ex. 1001, “the ’714 patent”). Paper 13 (“Dec. to Inst.”).

In its Request for Rehearing, AT&T contends that our determination to institute an *inter partes* review is improper for at least two reasons. First, AT&T argues that we misapprehended or overlooked the following aspects of its real parties in interest argument presented in the Preliminary Response (Paper 12, “Prelim. Resp.”): (1) Petitioner, Cox Communications, Inc. (“Cox”), bears the burden of complying with 35 U.S.C. § 312(a)(2)—not AT&T; (2) sworn statements and public reports regarding the overlap in corporate leadership of Cox and CoxCom, LLC do not amount to speculation or conjecture; and (3) we improperly assumed that a parent-child relationship automatically forecloses the possibility that a child entity should have been named as a real party in interest in a petition when, as here, only the parent entity was identified. Req. Reh’g 1–6. Second, AT&T argues we misapprehended or overlooked the purported dispositive effect of 37 C.F.R. § 42.104(b)(3) on Cox’s failure to take a position on claim construction in the Petition. *Id.* at 6–10.

As we explain below, we have considered the arguments presented by AT&T in its Request for Rehearing, but we discern no reason to modify the Decision to Institute. As a consequence, we deny AT&T’s Request for Rehearing.

## 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.* 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 may be indicated if a decision is 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). With this in mind, we address the arguments presented by AT&T in turn.

## III. ANALYSIS

### *A. We Did Not Misapprehend or Overlook Certain Aspects of AT&T's Real Parties in Interest Argument Presented in the Preliminary Response*

AT&T contends that in the Decision to Institute we misapprehended or overlooked the relevant standards and burdens for determining compliance with § 312(a)(2). Req. Reh'g 1–2. In particular, AT&T asserts that we erroneously placed the burden on AT&T to establish non-compliance with § 312(a)(2), instead of placing the burden on Cox to establish compliance with this statutory provision. *Id.* at 2; *see also id.* at 4–6 (presenting similar arguments). We disagree with AT&T's

characterization of our real parties in interest analysis in the Decision to Institute.

As an initial matter, we do not state in the Decision to Institute that AT&T bears the burden of demonstrating that Cox did not identify all real parties in interest in the Petition. *See generally* Dec. to Inst. 7–12. In an *inter partes* review proceeding, we generally accept the petitioner’s identification of real parties in interest at the time of filing the petition. Our practice in this regard, however, acts as a rebuttable presumption that benefits the petitioner. When patent owner provides sufficient rebuttal evidence that reasonably brings into question the accuracy of a petitioner’s identification of real parties in interest, the burden remains with the petitioner to establish that it has complied with the statutory requirement to identify all real parties in interest. *See, e.g., Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc.*, Case IPR2013-00453, slip op. at 8 (PTAB Jan. 6, 2015) (Paper 88) (discussing who bears the burden to comply with § 312(a)(2)); *Zerto, Inc. v. EMC Corp.*, Case IPR2014-01254, slip op. at 6–7 (PTAB Feb. 12, 2015) (Paper 32) (discussing the same).

To be clear, in this case we determined that AT&T did not present sufficient rebuttal evidence that reasonably brings into question the accuracy of Cox’s identification of real parties in interest in the Petition. We analyzed AT&T’s arguments regarding real parties in interest and, in each instance, determined that AT&T presented insufficient evidence demonstrating that Cox’s regional subsidiaries or CoxCom, LLC control, direct, or fund Cox’s participation in this proceeding. *See generally* Dec. to Inst. 9–12. Given that we determined AT&T did not present sufficient rebuttal evidence, it was unnecessary for Cox to proffer evidence establishing that it has complied

with the statutory requirement to identify all real parties in interest in the Petition.

Next, AT&T contends that we misapprehended or overlooked the evidence it presented regarding the significant overlap in corporate leadership between Cox and CoxCom, LLC. Req. Reh’g 3. In particular, AT&T argues that we mischaracterized this overlap as based on speculation and conjecture when, according to AT&T, the evidence it provided to support its argument was based on sworn statements from a Cox employee and public reports. *Id.* (citing Ex. 2021, 24, 47, 64; Ex. 2022, 1; Ex. 2023). AT&T asserts that sworn statements and citations to public reports do not amount to speculation or conjecture, and our characterization of this evidence as such was erroneous. *Id.*

We considered AT&T’s evidence regarding significant overlap in corporate leadership between Cox and CoxCom, LLC in the Decision to Institute and found it to be unpersuasive. Dec. to Inst. 12. Although we recognize that AT&T provided a Declaration from Ms. Stephanie Allen-Wang, who serves as Intellectual Property counsel for Cox, its regional subsidiaries, and CoxCom, LLC (Ex. 2022 ¶ 2), this Declaration, by itself, does not support AT&T’s summary of the degree of executive leadership overlap that it alleges in Exhibit 2023. It simply supports the fact that Ms. Allen-Wang serves as Intellectual Property counsel in various entities within Cox’s corporate structure. In addition, AT&T acknowledges that the public reports (Ex. 2022) it provides in further support of this argument are the only publicly available sources that provide limited information and “minimal visibility” into Cox’s private corporate structure. Prelim. Resp. 23 n.5. In our view, we fairly characterized AT&T’s summary

of the degree of executive leadership overlap that it alleges in Exhibit 2023 as being speculative because the information gleaned from the public reports has uncertain evidentiary value, particularly at this stage of the proceeding.

Lastly, AT&T contends that we improperly assumed that a parent-child relationship automatically forecloses the possibility that a child entity should have been named as a real party in interest in a petition when, as here, only the parent entity was identified. Req. Reh’g 4. In particular, AT&T argues that another panel of this Board recently faced with a similar circumstance determined that a child entity should have been named as a real party in interest in the petition and, as a result, denied the petition. *Id.* at 5 (citing *Zhejiang Yankon Group, LTD. v. Cordelia Lighting, Inc.*, Case IPR2015-01420, slip op. 14–16 (PTAB Nov. 25, 2015) (Paper 9) (“*Zhejiang*”). AT&T asserts that, similar to the holding in *Zhejiang*, we should have determined that CoxCom, LLC should have been identified as a real party in interest in the Petition because, e.g., Cox and CoxCom, LLC share the same counsel—namely, Ms. Allen-Wang. *Id.* (citing *Zhejiang*, 14–16).

We do not agree with AT&T that we misapprehended or overlooked the holding in *Zhejiang*. AT&T directs us to the holding in *Zhejiang* for the first time in its Request to Rehearing. *Compare* Prelim. Resp. 9–26, with Req. Reh’g 4–5. We could not have overlooked or misapprehended arguments or evidence not presented and developed by AT&T in the Preliminary Response.

Even if we were to consider AT&T’s new argument regarding the holding in *Zhejiang*, that case is distinguishable factually from this case in at least one respect. In *Zhejiang*, the U.S. subsidiary negotiated the purchasing

or licensing of the involved patent on behalf of the parent entity. In this case, AT&T does not present argument or evidence that Cox's regional subsidiaries or CoxCom, LLC negotiated the purchasing or licensing of the '714 patent on behalf of Cox. We, therefore, maintain our initial position that, on the current record, AT&T does not present sufficient rebuttal evidence that reasonably brings into question the accuracy of Cox's identification of real parties in interest in the Petition. *See* Dec. 12.

*B. We Did Not Misapprehend or Overlook the Purported Dispositive Effect of 37 C.F.R. § 42.104(b)(3) on This Proceeding*

AT&T contends that, because the Petition failed to include any positions on claim construction, we were required to comply with § 42.104(b)(3), as well as follow the guidance provided in the *Office Patent Trial Practice Guide*, determine that the Petition was defective, and deny it. *Req. Reh'g* 6–7. AT&T also alleges that the Petition's insufficient notice of claim construction positions may harm AT&T because it will be required to rebut Cox's un-advanced "secret" positions in its Patent Owner Response, placing it at a tactical disadvantage. *Id.* at 7–8.

In the Decision to Institute, we acknowledged AT&T's assertions that the Petition failed to include any statements on claim construction, and that dismissal of the Petition was sought based on non-compliance with § 42.104(b)(3) and the guidance provided in the *Office Patent Trial Practice Guide*. Dec. to Inst. 13. We, however, explained that controlling case law dictates that there is heavy presumption that claim terms should be accorded their ordinary and customary meanings. *Id.* We also noted that the claims challenged in the Petition did not include means-plus-function limitations that invoke 35 U.S.C. § 112 ¶ 6, which require the identification of

corresponding structure, material, or acts in the specification. *Id.* at 13–14. In that light, we determined that an explicit construction of claim terms was not necessary to determine whether the asserted prior art renders obvious the subject matter of each challenged claim, and we declined to dismiss the Petition. *See id.*

We have considered AT&T’s argument that we misapprehended or overlooked the purported dispositive effect of § 42.104(b)(3). We, however, disagree that § 42.104(b)(3) is dispositive based on the particular circumstances presented in this case.

AT&T views our consideration of the type of claim terms at issue in the Decision to Institute to be indicative of our misapprehension of the requirements of § 42.104(b)(3). Req. Reh’g 9. AT&T argues that we overlooked that “Rule 42.104(b)(3)’s requirement to identify structure for § 112 ¶ 6 claims is an additional requirement for those types of claims, and does nothing to negate the more generally applicable requirement that the petition set forth how a challenged claim is to be construed.” *Id.* (emphasis omitted). AT&T’s argument misses the point.

The discussion of the type of claim terms in the challenged claims was not intended to suggest that a statement on claim construction is required only for claims including means-plus-function limitations that invoke § 112 ¶ 6, but rather was to explain why, under these particular circumstances, we declined to dismiss the Petition simply because it does not include a position on claim construction. This issue is relevant because, if the challenged claims include means-plus-function limitations that invoke § 112 ¶ 6, absent an identification of corresponding structure in the specification, the scope of the claims could not be determined without speculation and, as a



consequence, we would be unable to determine whether there are any differences between the claimed invention and the prior art asserted in the Petition. On the other hand, when, as here, the challenged claims do not include means-plus-function limitations that invoke § 112 ¶ 6, the challenged claims may, in some instances, be assessed in light of the asserted prior art, regardless of whether a petitioner provides a specific position regarding claim construction in its petition, by relying upon the canon of claim construction that there is a heavy presumption claim terms are accorded their ordinary and customary meaning.

AT&T also contends that our invocation of a “heavy presumption” of according claims terms their ordinary and customary meanings cannot trump the requirements of § 42.104(b)(3). Req. Reh’g 8. AT&T’s argument is misplaced. Again, as we explained above, our discussion of this presumption in the Decision to Institute was to explain why, under these particular circumstances, we declined to dismiss the Petition simply because it did not include a position on claim construction.

In any event, we have discretion to waive or suspend a requirement set forth in parts 1, 41, and 42 of the Code of Federal Regulations under 37 C.F.R. § 42.5(b). Implicit in our denial of AT&T’s request to dismiss the Petition for failure to comply with § 42.104(b)(3) was the exercise of our discretion pursuant to § 42.5(b) to waive the requirement that the Petition identify how the challenged claims are to be construed. The exercise of our discretion in this regard is justified for at least two reasons. First, upon independently assessing the challenged claims, we determined that an explicit construction of claim terms was not necessary to determine whether there was a reasonable likelihood the asserted prior art renders obvious the

subject matter of the challenged claims. Second, AT&T did not assert that any particular claim term required construction inconsistent with the ordinary and customary meaning in order to determine whether there was a reasonable likelihood the asserted prior art renders obvious the claimed subject matter.<sup>1</sup>

Finally, we are not persuaded by AT&T's argument that, in its Patent Owner Response, it will have to "prebut" un-advanced positions by Cox in the absence of definitive positions on claim terms. Req. Reh'g 7–8. AT&T is in a similar situation it would have been if the Petition contained a "simple statement that the claim terms are to be given their broadest reasonable interpretation," because, in that case, the Petition would not have advanced any alternative claim constructions different than the broadest reasonable interpretation using the ordinary and customary meaning of the claim terms. *See* Dec. 13–14; *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48764 (Aug. 14, 2012). In contrast, the effect of the dismissal of the Petition on Cox for that reason alone would have been significant and unprecedented. We, therefore, maintain our determination that Cox's failure to include a position regarding claim construction in the Petition does not mandate dismissal under § 42.104(b)(3). *See* Dec. 14.

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<sup>1</sup> AT&T contends that certain portions of the preamble of independent claim 1 are entitled to patentable weight because they recite limitations and provide antecedent basis for certain claim terms or phrases found in the body of this claim. Prelim. Resp. 28. AT&T's position was unopposed. Dec. to Inst. 14 (stating that "Cox does not present arguments or evidence as to whether the preamble of independent claim 1 is entitled to patentable weight"). After applying controlling case law, we determined that the aforementioned recitations in the preamble of independent claim 1 are entitled to patentable weight because they state necessary and defining aspects of the invention embodied in this challenged claim. *Id.* at 15–16.

#### IV. CONCLUSION

For the foregoing reasons, AT&T has not demonstrated that we abused our discretion in instituting an *inter partes* review of claims 1–22 of the '714 patent. In particular, AT&T has not persuaded us that we misapprehended or overlooked certain aspects of AT&T's real parties in interest argument or the purported dispositive effect of § 42.104(b)(3) on this proceeding.

#### V. ORDER

Accordingly, it is ORDERED that AT&T's Request for Rehearing is DENIED.

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