

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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XACTWARE SOLUTIONS, INC.  
Petitioner,

v.

EAGLE VIEW TECHNOLOGIES, INC.  
Patent Owner.

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Case IPR2016-00582  
Patent 8,078,436 B2

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**PETITIONERS' REQUEST FOR REHEARING  
PURSUANT TO 37 C.F.R. §§ 42.71(c) AND (d)**

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## **I. INTRODUCTION**

Pursuant to 37 C.F.R. § § 42.71(c) and (d), Petitioner Xactware Solutions, Inc. (“Xactware”) respectfully requests rehearing of the Board’s August 16, 2016 Decision (the “Decision”) (Paper 15) denying institution of *inter partes* review of Claims 1-5, 7-13, 15-23, 25-31, 33-40, 42, 46-52, 54-56 of U.S. Patent No. 8,078,436 to Pershing et al. (the “’436 patent”).

Xactware respectfully submits that the Board abused its discretion in finding that the evidence of record did not satisfy a threshold showing that the publication by Hsieh, entitled “Design and Evaluation of a Semi-Automated Site Modeling System,” Carnegie Mellon, November 1995 (“Hsieh”) (Xactware Exhibit 1004) was not publicly available before Apr. 17, 2007, the critical date of the ’436 patent. The Board misapprehended and overlooked the evidence within Hsieh which establishes at least a preliminary showing of public accessibility prior to the critical date of the ’436 patent.

## **II. LEGAL STANDARDS**

A request for rehearing “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 reply.” 37 C.F.R. § 42.71(d). “When rehearing a decision on petition, the panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). An abuse of discretion

occurs where a decision is based on a factual finding that is unsupported by substantial evidence and/or represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005).

### III. ARGUMENT

#### A. **Only A Preliminary Showing of Public Accessibility is Required, and Petitioner Met That Showing**

The Board abused its discretion in finding that “Petitioner has not met its burden of at least a **preliminary showing** that Hsieh is a printed publication.” Decision at 7 (emphasis added). The Board properly found that only a preliminary showing is required at the institution phase. Pursuant to 37 C.F.R. § 42.108(c), the burden of proof for institution is a “reasonable likelihood” standard, which is less than the ultimate burden of proof of preponderance of evidence under 37 C.F.R. § 42.1(d). However, Petitioner respectfully submits that the evidence within Hsieh suffices as at least a preliminary showing that Hsieh was publicly available before the critical date.

The Board improperly found that Hsieh was not publicly available because there was insufficient evidence to prove that Hsieh was indexed “**prior to the critical date.**” Decision at 6 (emphasis added). The Board did not find that there was insufficient evidence that Hsieh was in fact indexed or catalogued. Indeed, the

Board appears to have acknowledged that Hsieh includes evidence of indexing and cataloging, as it acknowledged that Hsieh includes a Dewey decimal number on the front page. Decision at 6. A book with a Dewey decimal number is evidence that the book was indexed because that is the purpose of a Dewey decimal number. *See Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323 (Fed. Cir. 2008) (“To make the card catalog system relevant, the library must shelve the books according to some order, like the Dewey Decimal or Library of Congress systems.”).

Further, the Board misapprehended and overlooked the fact that Hsieh includes evidence that it was indexed prior to the critical date. There is a Carnegie Mellon Library barcode on the last page of Hsieh, and right next to the barcode, there is a stamped date of “May 30 1996.” The Carnegie Mellon Library barcode indicates that Hsieh was in the library system because the purpose of a barcode is to scan the reference in and out a book for someone to borrow. The date next to the barcode is a library stamp which indicates the date the library applied the barcode. The Board noted the barcode, but did not consider the date right next to the barcode. The very fact that the stamped date appears right next to the barcode proves that the date of May 30 1996 is related to the barcode.

The May 30, 1996 date further evidences that Hsieh was entered into the Carnegie Mellon Library catalog system almost **ten years before** the critical date of the '436 patent. Based on this evidence, it is reasonable to conclude that there is

at least a preliminary showing that Hsieh was publicly available before the critical date. A bar code with a date stamp right next to it (dated 10 years before a prior art reference date) warrants that at least a reasonable inference be drawn in Xactware's favor on the issue of public accessibility, particularly for purposes of determining whether to institute review.

Additionally, as the Board recognizes, Hsieh bears a date of "November 1995" on Carnegie Mellon's own library cover page and on the first page of the original thesis. Hsieh also has a call number (in the label on the first page) indicating a date of 1995. The length of time between 1995 and the critical date (over 11 years) is strong evidence of public availability. Hsieh was written at Carnegie Mellon and was indexed and catalogued at the same entity. A thesis paper written at a university and indexed at the same university certainly would be placed on the shelf and made publicly available within eleven years.

In *Fujitsu Semiconductor Ltd. v. Zond, LLC*, Case No. IPR2014-00821, Paper 47, Final Written Decision (September 25, 2015), the Board found that "a *specific* date of cataloging and shelving before the critical date would have been desirable, **[but] is not required.**" (emphasis added). In *Zond*, the Board found that a publication date of seven years before the critical date was sufficient to prove public accessibility on the basis of the passage of time alone. *See id.* at 28. This determination was made in a final written decision where the burden of proof is

higher than it is here. The passage of time from what Xactware submits is evidence of indexing, cataloging, and publication (1995-1996) to the critical date is over 10 years, far greater than in *Zond*.

**B. The Board's Criticism of Petitioner's Evidentiary Support of Public Accessibility is Unfounded**

The Board mentioned that no affidavit was submitted regarding the publication evidence on Hsieh. Petitioner respectfully submits that an affidavit was not required at institution given the plethora of evidence on Hsieh pointing toward public availability. Requiring an affidavit at institution unnecessarily increases the burden of proof at institution from a threshold showing of a reasonable likelihood to proving public accessibility beyond a reasonable doubt. Nonetheless, Petitioner submits that the evidence on Hsieh discussed above not only meets the threshold showing required at institution, but exceeds it.

The Board also mentioned that Petitioner did not explain the publication evidence in Hsieh in its petition. The lack of explanation within the petition also should not be grounds for finding that Hsieh was not publicly accessible. Petitioner's attorney argument is not evidence and therefore should not be required. The evidence on the face of Hsieh is compelling, was submitted with the petition, and was more than enough to show public accessibility at the institution stage.



**C. The Board Has Instituted on Prior Art With Less Compelling Evidence of Public Accessibility**

In *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, Case No. IPR2013-00369, Paper 16, Decision Instituting Inter Parties Review (Dec. 19, 2013), the Board found that a report from the Department of Computer Science at the University of Colorado at Colorado Springs was publicly accessible. *See Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, pp. 15-16. The only evidence the Board had in that case on was that the prior art reference had a report date on its cover of “April, 1997.” *See id.* This evidence alone was sufficient to convince the Board that the “Petitioner has made a threshold showing that [the prior art reference] is a ‘printed publication’ within the meaning of 35 U.S.C. § 102.”

The evidence of record in Hsieh is *more substantial* than in the prior art reference in the *Palo Alto* case. *See Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, Case No. IPR2013-00369, Exhibit 1006. As mentioned above, Hsieh has a date of November 1995 on the library cover page and on the first page of the publication itself. Hsieh also has a call number indicating the year 1995. There is also a Carnegie Mellon University Library stamp on the second page. Additionally, there is a Carnegie Mellon University barcode with a date of May 30 1996. Finally, the call number on the cover page has a Dewey Decimal number which is a clear indication of indexing and cataloging. All of this evidence viewed

as a whole clearly indicates that Hsieh was published in 1995 and indexed by Carnegie Mellon University Library in 1996. This is more than satisfies a reasonable likelihood that Hsieh was publically accessible before the critical date. *See also Alternate Legal Solutions, Inc., v. Employment Law Compliance, Inc.*, Case No. IPR2014-00562, Paper 16 (Dec. 15, 2014) (instituting an *inter parties* review on a prior art thesis with only a date on the cover page).

**IV. CONCLUSION**

For the reasons set forth above, Xactware respectfully requests that the Board reverse its prior decision, and institute proceedings.

9/9/2016  
Dated

9/9/2016  
Dated

Mark E. Nikolsky  
By: Mark E. Nikolsky (Lead Counsel)  
Reg. No. 48,319

Amit R. Parikh  
By: Amit R. Parikh (Back-up Counsel)  
Reg. No. 65,271

Attorneys for Xactware  
McCarter & English, LLP  
Four Gateway Center  
100 Mulberry Street  
Newark, New Jersey 07102

**V. CERTIFICATE OF SERVICE**

I hereby certify that true and complete copies of this Request for Rehearing, including this Certificate of Service has been caused to be served in its entirety on Kirkland & Ellis, LLP, Counsel for Patent Owner, via email to Gianni Cutri (gcutri@kirkland.com) and Jared Barcenas (jbarcenas@kirkland.com).

9/9/2016  
Dated

Mark E. Nikolsky  
By: Mark E. Nikolsky (Lead Counsel)  
Reg. No. 48,319

9/9/2016  
Dated

Amit R. Parikh  
By: Amit R. Parikh (Back-up Counsel)  
Reg. No. 65,271

Attorneys for Xactware  
McCarter & English, LLP  
Four Gateway Center  
100 Mulberry Street  
Newark, New Jersey 07102