

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

XACTWARE SOLUTIONS, INC.,
Petitioner,

v.

EAGLE VIEW TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2016-00582
Patent 8,078,436 B2

Before HOWARD B. BLANKENSHIP, BRYAN F. MOORE, and
STACEY G. WHITE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

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

INTRODUCTION

Petitioner, Xactware Solutions, Inc., filed a Request for Rehearing (Paper 16, “Req. Reh’g”) of the Decision Denying Institution of *Inter Partes* Review (Paper 15, “Dec. on Inst.”) (“Decision”) of claims 1–5, 7–13, 15–23, 25–31, 33–40, 42, 46–52, and 54–56 of U.S. Patent No. 8,078,436 B2 (Ex. 1001, “the ’436 patent”). In the Request for Rehearing, Petitioner argues that the Decision Denying Institution overlooked certain matters in denying the Petition. For the reasons set forth below, the Request for Rehearing is *denied*.

ANALYSIS

When considering a request for rehearing, we review the Decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The party requesting rehearing bears the burden of showing that the Decision should be modified, and “[t]he request must specifically identify all matters the party believes [we] misapprehended or overlooked.” 37 C.F.R. § 42.71(d).

Petitioner argues that we misapprehended and overlooked evidence that Hsieh was indexed prior to the critical date. Req. Reh’g 2–5. Petitioner points to indicia on the first few pages of Hsieh showing dates and bar codes, provides an explanation of the import of those indicia, and argues that we should have found a reasonable inference of public accessibility before the critical date. We considered the indicia along with Petitioner’s failure to explain the import of the indicia and found the evidence presented by Petitioner lacking. Dec. 5–6 (citing *In re Lister*, 583 F.3d 1307, 1311 (Fed. Cir. 2009)). A request for rehearing is not an opportunity merely to disagree with the Panel’s assessment of the arguments or weighing of the evidence. It is not an abuse of discretion to have performed an analysis or reached a

conclusion with which Petitioner disagrees, and mere disagreement with the Board's analysis or conclusion is not a proper basis for rehearing. We also will not consider any new argument in regard to the indicia on rehearing. Thus, we are not persuaded by this argument.

Petitioner further argues that the passage of time from the date Hsieh was written until the critical date was sufficient evidence that Hsieh would have been made publicly available because a specific date of availability is not required to show public availability. Req. Reh'g 4–5 (citing *Fujitsu Semiconductor Ltd. V. Zond, LLC*, Case IPR2014-00821, slip op. at 28 (PTAB Sept. 25, 2015) (Paper 47) (“*Zond*”). Petitioner fails to acknowledge a dissent in *Zond* disagreed with that result and, further, *Zond* is not precedential. We considered the passage of time along with the lack of explanation from Petitioner regarding the indicia on Hsieh to come to our decision. Dec. on Inst. 5–6. Thus, we are not persuaded by this argument.

Petitioner also argues that it was not required to explain the indicia on Hsieh nor was it required to provide affidavit evidence regarding the indicia on Hsieh to prove the date of public accessibility. Req. Reh'g. 5. Even at the preliminary stage, the burden of proof rests with Petitioner—§ 314(a) imposes a burden on Petitioner to establish in its Petition a reasonable likelihood of success, which includes, among other things, making a threshold showing Hsieh was publically available before the critical date. *See also*, Dec. on Inst. 6 (citing *Lister*, 583 F.3d at 1317 (“substantial evidence that the *Lister* manuscript was publicly accessible” not provided and evidence does not “suffice[] to prove a prima facie case of accessibility that would shift the burden” to [applicant] *Lister*). Thus, we are not persuaded by this argument.

Finally, Petitioner points to one case in which it argues the Board instituted with less evidence of public accessibility than presented here. Req. Reh'g. 6–7. The case cited by Petitioner is not precedential and further, Petitioner did not discuss whether other cases came to an opposite conclusion. Thus, we are not persuaded by this argument.

CONCLUSION

The Request for Rehearing does not demonstrate that we misapprehended or overlooked any matters raised in the Petition declined to institute review. 35 U.S.C. §§ 314(a).

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Request for Rehearing is denied.

PETITIONER:

Mark E. Nikolsky
mnikolsky@mccarter.com
Joseph G. Monaghan
jmonaghan@mccarter.com
MCCARTER & ENGLISH, LLP

PATENT OWNER:

Gianni Cutri
gianni.cutri@kirkland.com
Jared Barcenas
jared.barcenas@kirkland.com
KIRKLAND & ELLIS LLP