

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INVUE SECURITY PRODUCTS, INC.,  
Petitioner,

v.

MOBILE TECH., INC.,  
Patent Owner.

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Case IPR2019-00079  
Patent 9,786,140 B2

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Before BARBARA A. BENOIT, DANIEL J. GALLIGAN, and  
SCOTT B. HOWARD, *Administrative Patent Judges*.

BENOIT, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
35 U.S.C. § 314(a)

## I. INTRODUCTION

This is a preliminary proceeding to decide whether to institute *inter partes* review of U.S. Patent No. 9,786,140 B2 (Ex. 1001, “the ’140 patent” or “the challenged patent”). *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.4(a) (delegating authority to institute trial to the Board). InVue Security Products, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) seeking *inter partes* review of claims 26, 38–50, 52–67, and 72–92 (“the challenged claims”) of the ’140 patent. Patent Owner, Mobile Tech, Inc. (“MTI”), filed a Preliminary Response to the Petition (Paper 5, “Prelim. Resp.”). Pursuant to 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a), we have authority to determine whether to institute review. As discussed below, institution of an *inter partes* review is discretionary.

Upon consideration of the Petition and Preliminary Response, we exercise our discretion and deny institution of an *inter partes* review.

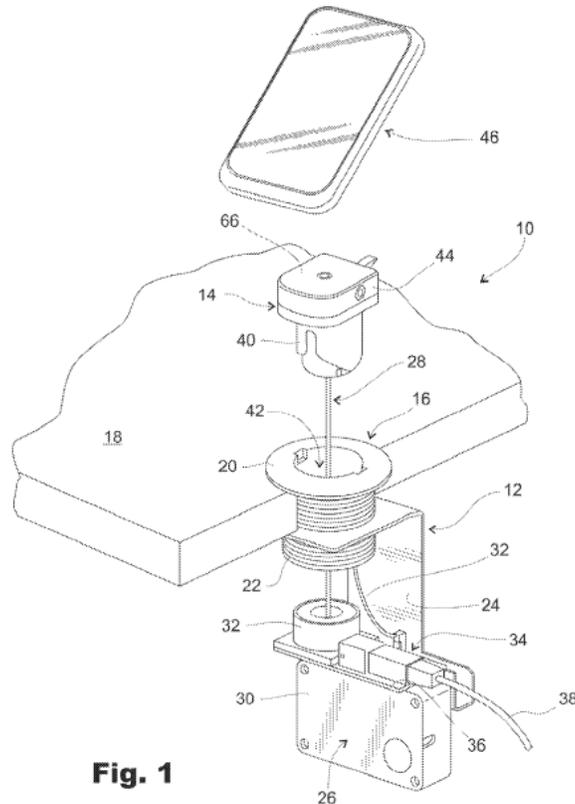
### A. *Related Proceedings*

As required by 37 C.F.R. § 42.8(b)(2), each party identifies judicial or administrative matters that would affect or be affected by a decision in this proceeding. Pet. 67; Paper 3 (Patent Owner’s Mandatory Notices). The parties identify a district court case. Pet. 67; Paper 3, 2. Petitioner further identifies an additional petition for *inter partes* review that challenges different claims of the ’140 patent—IPR2019-00078 challenging claims 1–25, 27–37, 51, 68–71, and 93–96. Pet. 1 n.1. Patent Owner also identifies a pending application related to the ’140 patent. Paper 3, 2.

*B. The Challenged Patent*

The '140 patent generally relates to retail displays that provide power and security for hand-held electronic devices. Ex. 1001, [57], 1:5–8.

Figure 1 is reproduced below.



**Fig. 1**

Figure 1 shows post assembly 10 including base assembly 12 and puck assembly 14, to which hand-held 46 is mounted. *Id.* at 9:51–53, 10:16–17. Base assembly 12 includes base portion 16, which has annular flange 20 and threaded portion 22 extending downward to bracket 24. *Id.* at 9:54–59. Bracket 24 carries mechanical retractor 26, which includes a spring-loaded steel cable 28 that is drawn from and returned to mechanical retractor housing 30 as puck assembly 14 is lifted and returned from base assembly 12. *Id.* at 9:60–66. When puck assembly 14 rests on base assembly 12, contacts 54, 56 engage to create an electrical connection

between puck assembly 14 and base assembly 12, which receives power from an under-the-counter source module through cable 38. *Id.* at 10:7–10, 10:38–42, 10:63–66. Puck assembly 14 includes electronics control board (“ECB”) 58, which connects to the power jack of hand-held 46 via a voltage-adjusting adaptor cable 72. *Id.* at 11:22–26, 11:28–31. ECB 58 includes one or more security sensors that trigger security signals. *Id.* at 11:63–12:20. ECB 58 uses steel cable 28 as a transmitting antenna to wirelessly communicate security signals to toroid 32 on mechanical retractor 26. *Id.* at 12:21–38, 12:58–60. The challenged patent discloses “that creating antenna structure in the form of a mechanical steel retractor cable is a highly reliable way to generate electronic signals over a long period of time without malfunctions.” *Id.* at 12:55–58.

### *C. Illustrative Claim*

Claim 26, reproduced below, is illustrative of the claimed subject matter and is the sole challenged independent claim:

26. A cable management apparatus for use in mounting an electronic device to a display, the apparatus comprising:

a puck assembly adapted to receive an electronic device;

a base assembly; and

a tether assembly adapted to connect the puck assembly with the base assembly, wherein the tether assembly comprises a portion that is adapted to transmit an optical signal;

wherein the puck assembly is adapted to be moveable between (1) a rest position in which the puck assembly engages with the base assembly and (2) a lift position in which the puck assembly

disengages from the base assembly while the puck assembly and base assembly remain connected to the tether assembly;

wherein the base assembly further comprises (1) base assembly circuitry configured to receive power from a power source, and (2) a base assembly electrical contact connected to the base assembly circuitry;

wherein the puck assembly comprises (1) a puck assembly electrical contact, (2) puck assembly circuitry connected to the puck assembly electrical contact, and (3) a connector connected to the puck assembly circuitry and a power cable that is connectable to a power input of the electronic device;

wherein the base assembly contact and the puck assembly contact are adapted to contact each other when the puck assembly is in the rest position to form an electrical connection between the puck assembly circuitry and the base assembly circuitry;

wherein the puck assembly circuitry is configured to, when the puck assembly is in the rest position, draw power from the power source through the electrical connection and provide the drawn power to the connector for charging the electronic device via the power cable; and

wherein the base assembly contact and the puck assembly contact are adapted to lose contact with each other when the puck assembly is in the lift position to thereby break the electrical connection.

Ex. 1001, 21:52–22:24.

## II. DISCUSSION

### A. *Discretionary Denial of Institution*

Pursuant to 35 U.S.C. § 314(a), an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner

would prevail with respect to at least 1 of the claims challenged in the petition.” To prevail in challenging Patent Owner’s claims in an instituted trial, Petitioner must demonstrate by a preponderance of the evidence that the claims are unpatentable. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d).

Even when a petitioner demonstrates a reasonable likelihood of prevailing with respect to one or more claims, however, institution of review remains discretionary. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review . . . .” (emphasis omitted)); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

Institution is an all-or-nothing affair. The Supreme Court and Federal Circuit have held that we lack authority to institute a proceeding as to fewer than all identified claims or challenges in a petition. *See SAS*, 138 S. Ct. at 1359 (“[E]verything in the statute before us confirms that [the petitioner] is entitled to a final written decision addressing all of the claims it has challenged . . . .”); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (“[35 U.S.C. § 314] require[s] a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition . . . .”).

As a threshold matter, we consider whether to exercise the Board’s discretion under 35 U.S.C. § 314(a) to deny institution of an *inter partes* review in the particular circumstances of this proceeding. In exercising our

discretion, we remain mindful of the statutory requirement to take into account when promulgating regulations “the efficient administration of the Office [and] the ability of the Office to timely complete proceedings.” *See* 35 U.S.C. § 316(b). Congress has mandated that a determination be made whether to institute an *inter partes* review within three months after receiving a Preliminary Response to the Petition (or, if no Preliminary Response is filed, three months after the last date on which such response may be filed) and, if instituted, a final written determination in an *inter partes* review must be issued not more than one year after institution, absent a showing of good cause or other circumstances not applicable here. 35 U.S.C. §§ 314(b), 316(a)(11).

We also are mindful to construe our rules to “secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b); *Deeper, UAB v. Vexilar, Inc.*, Case IPR2018-01310, slip op. at 42 (PTAB Jan. 24, 2019) (Paper 7) (informative).

## *B. The Petition*

### *1. Three Grounds Nominally Asserted*

Petitioner challenges claims 26, 38–50, 52–67, and 72–92. Pet. 2–3. Petitioner nominally asserts three grounds against these fifty-one challenged claims:

<b><u>Ground 1:</u></b>	Logokett Anticipates Claims 26, 38-50, 52-67, and 72-92 under 35 U.S.C. §102 and/or Renders them Obvious in Combination with Known Prior Art Identified in Section IV under 35 U.S.C. §103
<b><u>Ground 2:</u></b>	Deconinck Renders Obvious Claims 26, 38-50, 52-67, and 72-92 in Combination with Known Prior Art Identified in Section IV under 35 U.S.C. §103
<b><u>Ground 3:</u></b>	MTI's Video Publication Renders Obvious Claims 26, 38-50, 52-67, and 72-92 in Combination with Known Prior Art Identified in Section IV under 35 U.S.C. §103

Pet. 3.

As reflected in the table reprinted above, Petitioner contends that each of the challenged claims is anticipated by Logokett and also contends that each of the challenged claims is rendered obvious in three asserted grounds of obviousness. Pet. 3. Each ground of obviousness relies on a particular “primary” reference (“Logokett” or “Deconinck” or “MTI’s Video Publication”) “in Combination with Known Prior Art Identified in Section IV.” Pet. 3 (Grounds 1, 2, and 3); *see, e.g.*, Pet. 37 (“Each of these limitations [in independent claim 26] is either disclosed expressly by, or obvious view of, each of the primary references—**Logokett**, **Deconinck**, and the **Video**—in combination with the known prior art discussed in **Section IV.**”).

## *2. Twenty-nine Asserted References*

In Section IV Petitioner identifies twenty-six references in addition to the “primary” references of Logokett, Deconinck, and MTI’s Video Publication. Pet. 9–36; Prelim. Resp. 3–4 (listing twenty-nine asserted

references). The asserted references are listed here in the order in which they appear in Section IV of the Petition.

PCT International Application Publication No. WO 2011/045058 A2, published April 21, 2011, filed in the record as Exhibit 1002 with an English language translation filed as Ex. 1003 (“Logokett”).

U.S. Patent No. 7,327,276 B1, issued February 5, 2008, filed in the record as Exhibit 1004 (“Deconinck”).

A video titled “MTI Virtual Store Tour 2009,” available as of May 8, 2009<sup>1</sup>, filed in the record as Exhibit 1009 (“the Video” or “MTI’s Video Publication”) and a transcript of the Video filed as Exhibit 1010 (“the Video transcript”).

U.S. Patent No. 3,274,631, issued September 27, 1966, filed in the record as Exhibit 1025 (“Spohr”).

U.S. Patent Application Publication No. 2008/0204239 A1, published August 28, 2008, filed in the record as Exhibit 1031 (“Marszalek”).

U.S. Patent No. 3,840,795, issued October 8, 1974, filed in the record as Exhibit 1026 (“Roszyk”).

US Patent No. 7,352,567 B2, issued April 1, 2008, filed in the record as Exhibit 1006 (“Hotelling”).

U.S. Patent Application Publication No. 2009/0322278 A1, published December 31, 2009, filed in the record as Exhibit 1034 (“Franks”).

U.S. Patent Application Publication No. 2010/0081473 A1, published April 1, 2010, filed in the record as Exhibit 1021 (“Chatterjee”).

US Patent No. 8,558,688 B2, issued October 15, 2013, filed in the record as Exhibit 1030 (“Henson”).

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<sup>1</sup> The Petition states that the Video was publicly available as of May 8, 2009. Pet. 14 (citing Ex. 1011, 2; Ex. 1028, 11–12).

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U.S. Patent No. 4,370,020, issued January 25, 1983, filed in the record as Exhibit 1013 (“Davey”).

U.S. Patent No. 4,920,334, issued April 24, 1990, filed in the record as Exhibit 1012 (“DeVolpi”).

U.S. Patent No. 5,003,292, issued March 26, 1991, filed in the record as Exhibit 1032 (“Harding”).

U.S. Patent Application Publication No. 2007/0159328 A1, published July 12, 2007, filed in the record as Exhibit 1029 (“Belden 2007”).

U.S. Patent Application Publication No. 2004/0229498 A1, published November 18, 2004, filed in the record as Exhibit 1033 (“Fort”).

U.S. Patent No. 7,701,339 B2, issued April 20, 2010, filed in the record as Exhibit 1015 (“Irmscher”).

U.S. Patent Application Publication No. 2007/0194918 A1, published August 23, 2007, filed in the record as Exhibit 1045 (“Rabinowitz”).

U.S. Patent Application Publication No. 2006/0097875 A1, published May 11, 2006, filed in the record as Exhibit 1016 (“Ott”).

U.S. Patent No. 7,710,071 B2, issued May 4, 2010, filed in the record as Exhibit 1027 (“Rodarte”).

U.S. Patent Application Publication No. 2012/0205326 A1, published August 16, 2012, filed in the record as Exhibit 1007 (“Richter”).

“FREEDOM™ LP3 PRODUCT MANUAL,” dated March 2010, filed in the record as Exhibit 1017 (“2010 Freedom LP3 Manual”).

U.S. Patent Application Publication No. 2011/0068920 A1, published March 24, 2011, filed in the record as Exhibit 1020 (“Yeager”).

U.S. Patent No. 7,522,047 B2, issued April 21, 2009, filed in the record as Exhibit 1041 (“Belden 2009”).

PCT International Application Publication No. WO 2012/069816 A1, published May 31, 2012, filed in the record as Exhibit 1049 (“Seabrook”).

U.S. Patent No. 9,303,809 B2, issued April 5, 2016, filed in the record as Exhibit 1019 (“Reynolds”).

“FREEDOM UNIVERSAL 2.0 PRODUCT MANUAL,” dated December 2008, filed in the record as Exhibit 1040 (“2008 Freedom Universal 2.0 Manual”).

“FREEDOM™ LP3 PRODUCT MANUAL,” dated March 2011, filed in the record as Exhibit 1018 (“2011 Freedom LP3 Manual”).

“PowerPro System,” filed in the record as Exhibit 1036 (“PowerPro System Publication”).

“Instructions for PowerPro Detangler,” filed in the record as Exhibit 1035 (“PowerPro Detangler Publication”).

Pet. 9–36; *see* Prelim. Resp. 3–4 (listing twenty-nine asserted references).

Petitioner contends that each of the references is a patent or a printed publication as required by 35 U.S.C. § 311(b) and that each is prior art to the challenged claims. Pet. 9–36; Pet. 14–15 (contending the Video constitutes a “prior art printed publication under [35 U.S.C. §] 102(a)(1)”) (citing *Ex Parte Richard P. Mettke*, Reissue 09/134,861, 2008 WL4448201, at \*6 (BPAI Sept. 30, 2008); *Intex Rec. Corp. v. Bestway Inflatables & Materials Corp.*, IPR2016-00180, Paper 33, \*25 (May 26, 2017)).

### 3. Sections IV–VI of the Petition

Petitioner presents unpatentability contentions in Sections IV–VI of the Petition. In Section IV of the Petition, titled “Known Prior Art,” Petitioner discusses “features disclosed in the primary references and the known prior art.” Pet. 9; *see* Pet. 9–37. Petitioner organizes its discussion of the known prior art into the following sections:

Section IV.A Logokett (Pet. 9–11)

Section IV.B Deconinck (Pet. 11–13)

Section IV.C MTI’s 2009 Virtual Tour Video (Pet. 13–18)

Section IV.D Electrical contact charging prior art discussing Spohr, Marszalek, Deconinck, Roszyk, Hotelling, Chatterjee, Franks (Pet. 19–20)

Section IV.E Fiber optic tether prior art discussing Logokett, Deconinck, the Video, Davey, DeVolpi, Harding, and Belden 2007 (Pet. 20–22)

Section IV.F Wireless security and information prior art referring to Sections IV.E, IV.B, and IV.C and Fort, Irmscher, Rabinowitz, Ott, Logokett, Deconinck, and the Video (Pet. 23–27)

Section IV.G Base and puck contours/orientation prior art referring to Hotelling, Rodarte, Chatterjee, Richter, and 2010 Freedom LP3 Manual (Pet. 27–30)

Section IV.H Display angle prior art referring to Yeager and Belden 2009 (Pet. 30–32)

Section IV.I Fitting and swivel prior art referring to Logokett, Deconinck, the Video, Seabrook, Reynolds, 2008 Freedom LP3 Manual, 2011 Freedom LP3 Manual, the PowerPro Detangler Publication, and the PowerPro System Publication (Pet. 32–36).

Notably, each of Sections IV.D–IV.I includes multiple references—from two to nine references—either directly or by referring to other sections (as Section IV.F does). Petitioner refers to these sections in unpatentability contentions presented in Sections V and VI.

In Section V, Petitioner contends that the prior art reads on “basic components” of the challenged claims and various claim terms. Pet. 36–37 (“Independent claim 26 generally recites an apparatus for displaying an electronic device having the following basic components: [a] puck assembly . . . [a] power cable . . . [a] base assembly . . . [a] tether assembly . . . .”); Pet. 37–39 (Section V.A regarding asserted ground 1

relying on Logokett); Pet. 39–42 (Section V.B regarding asserted ground 2 relying on Deconinck); Pet. 42–44 (Section V.C regarding asserted ground 3 relying on the Video).

In Section VI, Petitioner presents a claim chart that purportedly “supports each identified ground” and refers to Sections IV and V. Pet. 44; *see* Pet. 44–66. Petitioner’s claim chart, however, typically presents a sentence or two for each ground challenging a limitation or group of similar limitations. *See, e.g.*, Pet. 49–50 (grouping claims 38–50, 52–67, and 72–92); Pet. 50–51 (grouping claim limitations from claims 39a, 64a, and 80a–80c).

#### 4. Patent Owner Contentions

Patent Owner contends that the Petition should be denied because it does not identify the specific grounds of unpatentability as required by 35 U.S.C. § 312(a)(3) and 37 C.F.R. § 42.104(b)(2). Prelim. Resp. 2–7. Patent Owner contends that Petitioner “does not identify which combination of references it relies upon for each challenged claim.” Prelim. Resp. 6. Patent Owner also contends that the Petition should be denied for setting forth numerous, underdeveloped obviousness grounds. Prelim. Resp. 14–21; *see also* Prelim. Resp. 14 (citing *Zetec, Inc. v. Westinghouse Elec. Co.*, Case IPR2014-00384, 2014 WL 3704254, at \*8–9 (PTAB July 23, 2014); *TRW Auto. US LLC v. Magna Elecs. Inc.*, Case IPR2014-00293, 2014 WL 4421850 (PTAB Aug. 28, 2014)).

#### C. Analysis

Section 312(a)(3) of 35 U.S.C. requires a petition to “identif[y], in writing and *with particularity*, each claim challenged, the grounds on which

the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” (Emphasis added). As the Federal Circuit has explained, “[i]n an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3)); *see also Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” (quoting 35 U.S.C. § 312(a)(3))). Consistent with the statute and case law, our *Trial Practice Guide* advises that petitioners should “avoid submitting a repository of all the information that a judge could possibly consider, and instead focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,763 (Aug. 14, 2012).

The statutory requirement for particularity in a petition for IPR takes on heightened importance when considered in conjunction with the all-or-nothing approach required for institution. *See SAS*, 138 S. Ct. at 1359–1360; *PGS Geophysical*, 891 F.3d at 1360. The Board has explained that the lack of particularity as to one or more of the asserted grounds may justify denial of an entire petition. For example, where a petition contains voluminous or excessive grounds, Office guidance indicates “[t]he panel will evaluate the challenges and determine whether, in the interests of efficient administration of the Office and integrity of the patent system (*see* 35 U.S.C. § 316(b)), the entire petition should be denied under 35 U.S.C.

§ 314(a).” *SAS Q&As* (June 5, 2018) (“*SAS Q&As*”),<sup>2</sup> at Part D, Effect of *SAS* on future challenges that could be denied for statutory reasons, Question D2; *see also Chevron Oronite Co. v. Infineum USA L.P.*, Case IPR2018-00923, slip op. at 10–11 (PTAB Nov. 7, 2018) (informative) (exercising discretion not to institute when Petition only establishes a reasonable likelihood of prevailing on two claims out of twenty challenged claims); *Deeper, UAB v. Vexilar, Inc.*, Case IPR2018-01310, slip op. at 41–43 (PTAB Jan. 24, 2019) (informative) (exercising discretion not to institute when Petition only establishes a reasonable likelihood of prevailing on two claims on a single ground where the Petition challenges twenty-three claims on two grounds each).

*1. Lack of Particularity and Numerous Underdeveloped Grounds*

In the particular circumstances of this proceeding, we agree with Patent Owner that the Petition suffers from a lack of particularity as well as from numerous underdeveloped grounds. *See* Prelim. Resp. 2–7, 14–21.

First, the obviousness grounds in the Petition lack particularity as to the prior art references asserted against each claim in each ground. Specifically, Petitioner formulates its grounds as being based on “Known Prior Art in Section IV” without indicating which combinations of the other eighteen references are asserted in combination with the “primary” reference of the ground—Logokett, Deconinck, and the Video—for each claim. Pet. 3 (each asserted ground); Pet. 37 (“Each of these limitations is either disclosed

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<sup>2</sup> Available at: [https://www.uspto.gov/sites/default/files/documents/sas\\_qas\\_20180605.pdf](https://www.uspto.gov/sites/default/files/documents/sas_qas_20180605.pdf).

expressly by, or obvious in view of, each of the primary references—**Logokett, Deconinck, and the Video**—in combination with the known prior art discussed in **Section IV.**”). One interpretation is that Petitioner is relying on *all* twenty-nine references in each asserted ground, albeit relying on Logokett, Deconinck, and the Video in different ways in each ground (as set forth in Section V). Prelim. Resp. 5. An equally plausible interpretation of the Petition is that Petitioner is relying on one of the primary references in combination with *one or more* of the “Known Prior Art.” Prelim. Resp. 5.

A more likely interpretation seems to be, however, that the Petition is relying on all the prior art discussed in Sections IV.D–IV.I for claim features discussed in those sections, respectively. Thus, by piecing together the references to claims in various subsections in Section IV, one could uncover Petitioner’s prior art evidence on which Petitioner intends to rely for each asserted ground for each claim. *See, e.g.*, Prelim. Resp. 19 (interpreting contention of obviousness over Deconinck in the Petition as relying on “Deconinck in combination with any one or more of seven references, further in combination with any one or more of five references, and further in combination with any one or more of another five references”).

This, however, would require the panel or the Patent Owner to scour the Petition to discern Petitioner’s evidence as to each of fifty-one claims in each of three obviousness grounds. Moreover, a Petition that requires the panel or the Patent Owner to do so lacks particularity and is tantamount to impermissibly shifting Petitioner’s burden under 35 U.S.C. § 312(a)(3).

Second, the Petition’s lack of particularity as to what prior art references are asserted against each claim in each ground is exacerbated by Petitioner’s inclusion of the “primary” references—Logokett, Deconinck,

and the Video—in the Known Prior Art section (Section IV). This inclusion introduces additional ambiguity as to the evidence Petitioner relies on for each claim in each asserted ground. For example, regarding fiber optic tether prior art in Section IV.E, Petitioner indicates Logokett discloses the use of fiber optic tether, which would have been an obvious design choice in Deconinck and the Video, according to Petitioner. Pet. 21. The Petition is unclear whether Petitioner intends to rely on Logokett for teaching the use of fiber optic tethers in its other two asserted grounds relying on Deconinck and the Video as “primary” references, or only relies on Logokett in the ground relying Logokett as the “primary” reference. Pet. 21.

Third, in addition to lacking particularity as to the prior art references asserted against each claim in each ground, Petitioner’s obviousness challenges assert numerous prior art references in each ground, resulting in voluminous and excessive grounds. As discussed above, the Petitioner in its Petition most likely seems to be asserting groups of prior art references as defined in Section IV. This means that each obviousness ground does not necessarily rely on all twenty-nine references, alone or in combination, identified in Section IV, despite the plain statements in Petitioner’s table of asserted grounds. Pet. 3. Even if each ground asserted against each claim does not rely on all twenty-nine references in the Known Prior Art Section IV, the Petition still includes combinations of numerous references for each claim feature identified in Sections IV.D–IV.I. As noted above, Petitioner asserts two to nine references in each section without identifying the references that apply to each claim.

Fourth, the unpatentability challenges in the Petition are voluminous and excessive in terms of the number of grounds asserted against each claim.

Petitioner challenges each of fifty-one claims four times—asserting one anticipation ground and three obviousness grounds relying on an ill-defined collection of twenty-nine possible prior art references. In view of Petitioner’s voluminous obvious grounds that also lack particularity, the Petition appears to provide an opportunity to fit evidence together into a coherent explanation that supports an argument that demonstrates a reasonable likelihood that Petitioner would prevail. We decline to do so. *See Stampa v. Jackson*, 78 USPQ2d 1567, 1571 (BPAI 2005) (quoting *Ernst Haas Studio, Inc. v. Palm Press, Inc.*, 164 F.3d 110, 111–12 (2d Cir. 1999) (“Appellant’s Brief is at best an invitation to the court to scour the record, research any legal theory that comes to mind, and serve generally as an advocate for appellant. We decline the invitation.”)).

Fifth, in addition to lacking particularity and having voluminous and excessive grounds, the Petition’s obviousness contentions are underdeveloped in that Petitioner argues only individual features in a claim and does not address the subject matter of a claim as whole as required to demonstrate obviousness. 35 U.S.C. § 103(a) (“A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious . . . .”); *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406 (2007); Prelim. Resp. 21–23. For example, Petitioner argues that it would have been an obvious design substitution to use electrical contacts in place of the wireless transfer means (Pet. 40) and it would have been obvious to incorporate a fiber optic tether assembly (Pet. 41). *See* Prelim. Resp. 22. But, as Patent Owner points out, Petitioner “never argues that it would have been obvious to modify the reference to have *both* electrical contacts and a

fiber optic tether,” as required for example by independent claim 26—much less provide sufficient evidence of a reason to combine the references in such a manner. Prelim. Resp. 22; Pet. 19 (indicating claim 26 requires electrical contacts); Pet. 20 (indicating claim 26 requires a fiber optic tether); *see PAR Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1193–94 (Fed. Cir. 2014) (indicating to prove obviousness a party “must demonstrate . . . that a skilled artisan would have had reason to combine the teaching of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success from doing so.” (quotation omitted)).

## 2. *Procedural Fairness to the Parties*

Even if we were to identify a particular combination of prior art identified in the Petition that did not lack particularity and was sufficiently developed to demonstrate a reasonable likelihood that Petitioner would prevail in showing unpatentability and, on that basis, institute an *inter partes* review, we could not institute on the identified particular combination of prior art alone. Rather, following the all-or-nothing institution approach, we would be required to institute on all challenges in the Petition, not merely those that did not lack particularity or were not voluminous and excessive.

Patent Owner then would be required to identify and respond to all grounds in the Petition. In other words, Patent Owner would be required to defend against four asserted grounds (i.e., three obviousness and one anticipation) against each of fifty-one of challenged claims and do so despite the lack of particularity by which of the twenty-nine references are asserted against each claim. This would place a significant and unfair burden on the

Patent Owner. Furthermore, this also might compromise our ability to complete proceedings in the time frame mandated by Congress. As such, instituting review here runs counter to securing the just, speedy, and inexpensive resolution of the proceeding.

Considering the totality of the issues presented above, we determine that the Petition fails to meet the particularity requirement of 35 U.S.C. § 312(a)(3) and that it presents voluminous and excessive grounds. We further determine that, in the interests of efficient administration of the Office and integrity of the patent system, and as a matter of procedural fairness to Patent Owner, the petition should be denied under 35 U.S.C. § 314(a).

We do not take lightly exercising our discretion to deny institution. Petitioner, however, filed its Petition well after the Supreme Court and Federal Circuit made clear that institution is an all-or-nothing decision. *See* Paper 4 (according the Petition a filing date of October 12, 2018). Yet Petitioner elected to file a Petition challenging fifty-one claims as unpatentable in view of three separate obviousness grounds and asserting twenty-nine prior art references (in addition to asserting the claims are anticipated). As the Supreme Court explained in *SAS*, “the petitioner is master of its complaint” and “the petitioner’s contentions . . . define the scope of the litigation all the way from institution through to conclusion.” *SAS*, 138 S. Ct. at 1355, 1357.

### III. CONCLUSION

We exercise our discretion under 35 U.S.C. § 314(a) to deny *inter partes* review.

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#### IV. ORDER

Accordingly, it is

ORDERED that the Petition is denied as to all challenged claims of U.S. Patent No. 9,786,140 B2 and no *inter partes* review is instituted.

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