

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INVUE SECURITY PRODUCTS, INC.,
Petitioner,

v.

MOBILE TECH, INC.,
Patent Owner.

Case PGR2019-00019
Patent 10,026,281 B1

Before RAMA G. ELLURU, TERRENCE W. McMILLIN, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

DECISION
Denying Institution of Post-Grant Review
35 U.S.C. § 324

I. INTRODUCTION

InVue Security Products, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an post-grant review of claims 1–30 of U.S. Patent No. 10,026,281 B2 (Ex. 1001, “the ’281 patent”). Mobile Tech, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 5, “Prelim. Resp.”).

A post-grant review may not be instituted unless “the information presented in the petition . . . , if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 324(a); *see also* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”). Section 324(b) further provides that “[t]he determination required under subsection (a) may also be satisfied by a showing that the petition raises a novel or unsettled legal question that is important to other patents or patent applications.” Upon consideration of the Petition, the Preliminary Response, and the supporting evidence, we conclude that the information presented in the Petition does not demonstrate that it is more likely than not that any of the claims challenged in the Petition is unpatentable and that the Petition does not raise a novel or unsettled legal question. Accordingly, we do not institute a post-grant review as to the challenged claims of the ’281 patent.

A. *Related Matters*

The parties indicate that the ’281 patent has been asserted in *Mobile Tech., Inc. v. InVue Security Products, Inc.*, 3:18-cv-00052 (W.D.N.C.). Pet. 91;¹ Paper 4, 2. In addition, the Patent Owner states, “U.S. Patent

¹ The Petition states the case number is 3:18-cv-00505. However, the case with this number was consolidated with 3:18-cv-00052 and closed.

Application Serial Nos. 12/351,837 and 15/826,017, pending before the U.S. Patent and Trademark Office, are related to the '281 Patent.” Paper 4, 2.

B. The '281 Patent

The '281 patent is titled, “Display for Hand-Held Electronics.” Ex. 1001, (54). “The invention disclosed here is a display system for managing power and security for a plurality of hand-held electronic devices sold to consumers in a retail location.” *Id.* at (57) (Abstract). Figure 1 of the '281 patent is reproduced below.

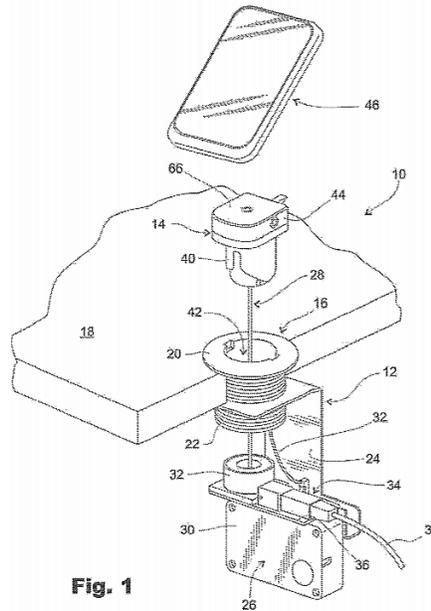


Figure 1 depicts “a ‘post’ position for mounting an electronic hand-held device to a retail display.” *Id.* at 8:25–26. “The post assembly 10 includes a base assembly portion (indicated generally at 12) and a puck assembly portion (indicated generally at 14).” *Id.* at 9:55–57. Spring-loaded steel cable 28 or tether “is drawn from and returned to the retractor housing 30 as the puck assembly 14 is lifted from and returned to the base assembly 12.” *Id.* at 9:66–10:3. Figure 22 of the '281 patent is reproduced below.

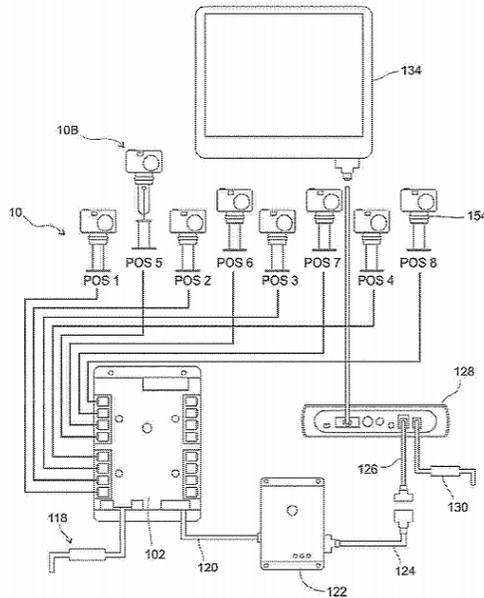


Fig. 22

Figure 22 depicts “a display system having a plurality of post positions along with a display monitor that shows media content depending on which device is examined by a consumer.” *Id.* at 8:64–67. “Post assembly position 10B in FIG. 22 represents a typical puck ‘lift’ condition.” *Id.* at 13:46–47. “[W]hen the puck at post position 10B is lifted, the controller 102 detects the lift signal and communicates it to the media player. The UIM [user interface] module 122, in essence translates the signal and instructs the media player 128 to play content that has been uniquely mapped to post position 10B.” *Id.* at 14:1–6.

C. Illustrative Claims

Petitioner challenges claims 1–30 (all claims) of the ’281 patent. Pet. 1. Claims 1 and 25 are independent apparatus claims and claim 30 is an independent method claim. Independent apparatus claim 1 is reproduced below.

1. A cable management apparatus for use in mounting an electronic device to a display, the apparatus comprising:
 - a puck assembly adapted to receive the electronic device;
 - a base assembly; and
 - a tether assembly adapted to connect the puck assembly with the base assembly;wherein the puck assembly is adapted to be moveable between (1) a rest position in which (i) the puck assembly is in engagement with the base assembly and (ii) the puck assembly and the base assembly are connected to the tether assembly, and (2) a lift position in which (i) the puck assembly is disengaged from the base assembly and (ii) the puck assembly and the base assembly are connected to the tether assembly;
- wherein the base assembly comprises a base assembly electrical contact, the base assembly electrical contact configured to receive power from a power source;
- wherein the puck assembly comprises (1) a puck assembly electrical contact, (2) a power storage device, and (3) puck assembly circuitry connected to the puck assembly electrical contact and the power storage device;
- wherein the base assembly electrical contact and the puck assembly electrical 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 power source;
- 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 power storage device to charge the power storage device; and
- wherein the base assembly electrical contact and the puck assembly electrical contact are adapted to lose contact with each other in response to movement of the puck assembly from the rest position to the lift position to thereby break the electrical connection.

Ex. 1001, 18:49–19:19. Independent method claim 30 is reproduced below.

30. A method for using an apparatus, the apparatus comprising (1) a puck assembly that includes a rechargeable storage device, (2) a base assembly on which the puck assembly rests, and (3) a tether assembly that connects the puck assembly with the base assembly, wherein the tether assembly includes a tether, the method comprising:

the base assembly receiving power from a power source;

the puck assembly receiving power from the base assembly via an electrical connection between a plurality of base assembly electrical contacts and a plurality of puck assembly electrical contacts that contact each other when the puck assembly is in the rest position;

connecting an electronic device to the puck assembly via a cable;

the puck assembly providing power received via the electrical connection between the base assembly electrical contacts and the puck assembly electrical contacts to the connected electronic device via the cable;

the puck assembly charging the rechargeable power storage device with power received via the electrical connection between the base assembly electrical contacts and the puck assembly electrical contacts;

lifting the puck assembly from the rest position to a lift position in which the puck assembly does not rest on the base assembly, wherein the tether assembly remains connected to the puck assembly and the base assembly when the puck assembly is in the lift position; and

in response to the lifting, (1) breaking the electrical connection between the base assembly electrical contacts and puck assembly electrical contacts, and (2) operating circuitry in the puck assembly with power from the rechargeable storage device.

Id. at 22:35–66.

D. Asserted Grounds of Unpatentability²

Petitioner challenges claims 1–12, 22, 23, 25–27, and 30 of the '281 patent as obvious in view of Deconinck (Ex. 1002)³ “in combination with Hotelling (X1003)^[4] and/or Chatterjee (X1004).^[5]” Pet. 2.

Petitioner challenges claims 13–21, 24, 28, and 29 of the '281 patent as obvious in view of Deconinck “in combination with Hotelling and/or Chatterjee.” Pet. 2.

Petitioner challenges claims 13–21, 24, 28, and 29 of the '281 patent as obvious in view of Deconinck “in combination with Hotelling/Chatterjee and further in view of Darwinkel (X1006)^[6] and/or Taylor (X1007).^[7]” Pet. 2.

Petitioner challenges claims 1–30 of the '281 patent as anticipated by Wheeler.⁸ Pet. 2.

Petitioner challenges claims 1–30 of the '281 patent as anticipated by and/or obvious in view of MTI 2009 Video.⁹ Pet. 3.

Petitioner relies on the Declaration of Harry Direen, Ph.D., P.E. (Ex. 1005) to support its challenges to the claims of the '281 patent.

² In the analysis below, we shall refer to the first 3 challenges as the “Obviousness Challenges” and the last 2 challenges as the “Anticipation and Alternative Challenges.”

³ US 7,327,276 B1, issued February 5, 2008.

⁴ US 7,352,567 B2, issued April 1, 2008.

⁵ US 2010/0081473 A1, filed September 26, 2008.

⁶ WO 2009/001273 A1, published December 31, 2008.

⁷ US 6,314,236 B1, issued November 6, 2001.

⁸ US 2014/0159898 (Ex. 1008), filed November 27, 2013.

⁹ Exhibit 1014.

II. ANALYSIS

A. *Obviousness Challenges*

1. *Challenges Not Stated With Particularity*

In a petition for post-grant review, a petitioner is required 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.” 35 U.S.C. § 322(a)(3). Each of the Obviousness Challenges uses the phrase “and/or” in identifying the relied-upon references. Pet. 2.

Patent Owner contends that, based on the way Petitioner set forth its Obviousness Challenges using “and/or” as a connector for the cited art, Petitioner identifies *at least* 15 obviousness grounds. Prelim. Resp. 23. Patent Owner also points out that Petitioner relies on “Knowledge in the Art” in setting forth its Obviousness Challenges (*see* Pet. 26 (“Claims 1–12, 22–23, 25–27, and 30 are Rendered Obvious by Deconinck in View of Hotelling/Chatterjee **and the Knowledge in the Art**”) (emphasis added)), 44 (“Dependent Claims 13–21, 24, 28–29 are Obvious in View of Deconinck and Hotelling/Chatterjee (Ground 2) and in further view of Darwinkel/Taylor (Ground 3), **along with the Knowledge in the Art**”) (emphasis added)), and that Petitioner identifies *at least* 12 different references as “Known Prior Art.” Prelim. Resp. 21–22 (citing Pet. 14–26). Patent Owner argues:

Even scouring through the Petition’s claim charts (*see* Paper 1, at 28–90), it is difficult if not impossible to identify the combinations used for each challenged claim. For individual limitations, the claim chart repeatedly refers back to subsections of Section IV or Section V (which in turn refer to subsections of Section IV), thus potentially incorporating one or more

(unidentified) references from the “Knowledge in the Art.” *See, e.g.*, Paper 1, at 29–30, 32–33, 34, 36–37, 40, 43, 47, 50 (referencing Sections V.A and IV.B, which references at least 10 pieces of prior art); *id.* at 34–35 (referencing Sections IV.B and V.B); *id.* at 37 (referencing Section IV.A); *id.* at 39, 48–49, 52–53, 56–57, 59, 61–68, 83 (referencing Section IV.B). And other limitations reference individual pieces of prior art that aren’t ostensibly listed as part of the grounds. *See* Paper 1, at 33, 35, 41 (referencing Marszalek, Ex. 1023); *id.* at 83 (referencing LP3 Manual, Ex. 1024).

Prelim. Resp. 24–25.

We agree with Patent Owner that the Obviousness Challenges are not set forth with particularity because it is unclear what each challenge encompasses and what evidence Petitioner relies upon to establish unpatentability under each challenge. For example, Petitioner’s first purported “ground” of unpatentability is that “Deconinck (X1002) renders obvious claims 1-12, 22-23, 25-27, and 30 in combination with Hotelling (X1003) and/or Chatterjee (X1004) under 35 U.S.C. §103.” Pet. 2 (emphases omitted). As Patent Owner notes in the passage of the Preliminary Response quoted above, Petitioner’s discussion of this “ground” repeatedly refers to Section IV.B of the Petition, which itself discusses numerous references. *See* Pet. 26–44 (discussion of “Ground 1”); Pet. 16–23 (Section IV.B). Furthermore, in its claim chart for claim 25, Petitioner asserts the following:

Deconinck discloses circuitry in the housing 30 for receiving power from the stand assembly and providing it to the electronic device (X1002, 9:30-34; FIGS. 15-18, Ref. 150). If not expressly disclosed, it would have been obvious to pass power directly or indirectly to the power cable connected to the electronic device in the rest position (X1005, ¶¶64-68). For example, Marszalek illustrates that passing power directly to the

power cable when resting for charging the electronic device would have been one design option known to a POSITA (X1023, ¶[0076]).

Pet. 33 (emphases omitted). Marszalek is one of the references discussed in Section IV.B of the Petition (Pet. 17), but it is not identified as forming the basis for unpatentability in Petitioner’s identification of “Ground 1.” Pet. 2, 26. Yet, Petitioner expressly relies on Marszalek for its obviousness contentions in “Ground 1.” Pet. 33.

Thus, Petitioner has not set forth grounds of unpatentability with the requisite specificity. *See* 35 U.S.C. § 322(a)(3). However, as explained below, we do not deny institution solely on this basis.

2. Element Not Shown in Cited Art: Tether Assembly Connected to the Base and Puck Assemblies

All the independent claims of the ’281 patent require that the tether assembly be connected to both the base assembly and the puck assembly. Patent Owner argues that Petitioner fails to explain how Deconinck, the primary reference cited in the Obviousness Challenges, or any other prior art reference teaches a tether apparatus with these connections. Prelim. Resp. 32–36.

Each independent claim of the ’281 patent recites that the puck assembly, when lifted and at rest, is connected to the tether assembly, and the base assembly is connected to the tether assembly. Ex. 1001, 18:53-62 (Claim 1: “a tether assembly adapted to connect the puck assembly with the base assembly; wherein the puck assembly is adapted to be moveable between (1) a rest position...and (2) a lift position in which...the puck assembly and the base assembly are connected to the tether assembly”),

21:9-62 (Claim 25: “a tether assembly adapted to connect the puck assembly with the base assembly; wherein the puck assembly is adapted to be moveable between (1) a rest position...and (2) a lift position in which...the puck assembly and the base assembly are connected to the tether assembly”), 22:38-39, 22:59-61 (Claim 30: “tether assembly that connects the puck assembly with the base assembly...wherein the tether assembly remains connected to the puck assembly and the base assembly when the puck assembly is in the lift position”). Thus, all the claims require that the puck assembly be connected to the base assembly via the tether assembly.

Petitioner contends “Deconinck discloses a retractable cable assembly that tethers a puck to the base assembly.” Pet. 28, 31, 34 (citing Ex. 1002, 6:38–39, Fig. 1). However, this contention is not sufficiently explained or supported by the citations. Figure 1 of Deconinck is reproduced below.

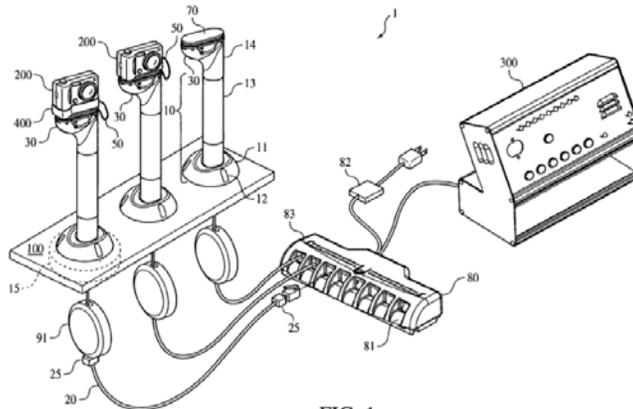


FIG. 1

Figure 1 depicts “a security system for displaying a handheld electronic device.” Ex. 1002, 6:32–33. Petitioner contends that stand assembly 10 in Figure 1 corresponds to the claimed base assembly in the ’281 patent and that housing 30 in Figure 1 corresponds to the claimed puck assembly. *See, e.g.*, Pet. 14 (“Deconinck discloses a device for displaying electronics comprising a stand assembly 10 (‘base’) that supports a housing 30 (‘puck’)

in the rest position.”) (footnote omitted). Figure 1, however, does not depict a connection between the tether assembly and the base and puck assemblies.

The cited passage in Deconinck states, “Stand assembly 10 supports housing 30 and displayed handheld electronic device 200 and conceals a retractable cable 20 which is routed to housing 30.” Ex. 1002, 6:37–39. This passage does not teach or suggest that stand assembly 10 and housing 30 are connected by the tether.

Furthermore, with regard to the claimed “lift position,” the Petition states, “In Deconinck, when the housing 30 is lifted from the stand assembly, the housing and stand assemblage disengage while the tether remains connected.” Pet. 28–29, 31, 36 (citing Ex. 1002, 6:38–39, 12:31–35, Fig. 1). Figure 1 and 6:38–39 of Deconinck, however, do not depict the lift position or the tether connecting the stand assembly and housing. The additional passage states: “Retractable cable 20 may be a single or multiconductor cable and may be flat, round or any suitable shape. Retractable cable 20 may have a suitable connection element at one or both terminal ends adapted to couple retractable cable 20.” Ex. 1002, 12:31–35. This passage does not teach or suggest that the stand assembly and housing are connected by the tether.

Figure 1 and the two above-quoted passages from Deconinck are all the evidence Petitioner cites for the limitations in the independent claims that require that the tether assembly connect the puck assembly and the base assembly. Petitioner’s cited evidence fails to sufficiently show that the cited art (Deconinck) teaches or suggests these limitations. For this reason alone, the Petitioner’s Obviousness Challenges are not likely to succeed.

3. Summary

Petitioner has failed to set forth its Obviousness Challenges with particularity. And, Petitioner has failed to show that all of the elements of any of the challenged claims are taught or suggested by the cited art. Therefore, the Obviousness Challenges in the Petition do not support institution of past-grant review.

B. *Anticipation and Alternative Challenges*

1. *Challenges Not Stated With Particularity*

a. *Challenge Based on Wheeler*

Petitioner challenges all the claims of the '281 patent as anticipated by Wheeler. Pet. 3, 69–90. Petitioner contends, “[b]ecause the substance of the Wheeler specification is identical to the '281 patent (*see* X1031), the disclosures in Wheeler either anticipate Claims 1–30 as shown in Ground 4 *or* the claims are invalid under 35 U.S.C. § 112.” *Id.* at 69 (emphasis added). In a footnote to its reference to Section 112, Petitioner states, “[s]hould [Patent Owner] assert that Wheeler fails to anticipate any claims, [Petitioner] reserves the right to challenge those claims on that basis.”¹⁰ *Id.* at 69 n.16. Thus, Petitioner purports to allege unpatentability based on alternative, contingent grounds.

¹⁰ Patent Owner does assert that Wheeler fails to anticipate the claims. *See, e.g.*, Pet. 1 (“[N]either Wheeler nor the [MTI 2009] Video are prior art to the '281 patent.”). It is unclear whether Patent Owner’s assertion that Wheeler does not anticipate because it does not qualify as prior art satisfies Petitioner’s contingency for asserting the alternative stated in the Petition (i.e., that all the claims of the '281 patent are invalid under Section 112).

The rules governing post grant review provide that a petition must state “the specific statutory grounds permitted under 35 U.S.C. 282(b)(2) or (3) on which the challenge to the claim is based” and “must identify the specific part of the claim that fails to comply with the statutory grounds raised and state how the identified subject matter fails to comply with the statute.” 37 C.F.R. § 42.204(b)(2), (4). Petitioner fails to do so. For example, Petitioner’s attempted reservation of the right to challenge the claims on an alternative ground under Section 112 is unavailing. Petitioner fails to present argument or support a challenge to the claims under Section 112. Indeed, Petitioner fails to even specify the nature of the Section 112 challenge. Specifically, Petitioner does not specify whether the claims are invalid for lack of written description support, lack of an enabling disclosure, or some other unspecified ground under Section 112. We, thus, decline to institute trial on alternative and undeveloped grounds.

Moreover, the rules governing post-grant review require that a petition contain “a detailed explanation of the significance of the evidence including material facts” (*id.* at § 42.22(a)(2)) and identify “the relevance of the evidence to the challenge raised” (*id.* at § 42.204(b)(5)). With regard to the challenge to the claims as anticipated by Wheeler, Petitioner fails to support the challenge with adequate reasoning or explanation. In the claim charts presented by Petitioner to support its challenge to all the claims based on Wheeler, there is no explanation of the significance of the cited paragraphs in Wheeler. *See* Pet. 69–90. In each instance, the references to Wheeler include only two or more numbers, the exhibit number and one or more paragraph numbers. *Id.* An example of such cite is “(X1008, ¶105).” *Id.* at 69. Petitioner does not provide sufficient explanation as to the significance

of the cited evidence. *See id.* at 69–90. Without any explanation from Petitioner, we are left to discern on our own, based on the cited passages in Wheeler, how the disclosure is relevant to the recited elements. We decline to do so.

In light of the foregoing, we determine that the challenge based on Wheeler is not stated with particularity.

b. Challenge Based on MTI 2009 Video

Petitioner challenges all the claims of the '281 patent as anticipated by *and/or* obvious over the MTI 2009 Video. Pet. 3, 69–90. For the reasons stated below, we determine that this challenge to the claims is not set forth with particularity because it is unclear what evidence Petitioner is relying upon to establish unpatentability.

In the heading to this section of the Petition, Petitioner states, “Claims 1-30 are Anticipated by Wheeler and Obvious in View of the MTI Video and the Knowledge in the Art.” Pet. 69. Notably, this heading does not state that the claims are anticipated by the MTI 2009 Video. However, in this regard, the heading is contradicted by the statement of this challenge on page 3 of the Petition and the third sentence in the paragraph immediately below this heading which states, “the Video anticipates and/or renders obvious each limitation of Claims 1-30.” *Id.* At page 3, and outside of the heading on page 69, Petitioner does not refer to “Knowledge in the Art” in reference to this challenge. This discrepancy in the way this challenge is set forth in the Petition contributes to the lack of particularity.

And, although Petitioner contends the MTI 2009 Video anticipates all the claims of the '281 patent, Petitioner relies on another document, the LP3

Manual (Ex. 1024), as disclosing or rendering obvious elements of the claims. Pet. 72; *see also, id.* at 78, 81, 83. For example, as to limitations in several claims, Petitioner asserts that “[t]he **LP3 Manual** shows that it would have been obvious to place two sets of contacts diametrically opposed (180° from one another) and circumferentially spaced about a ring on the base and puck.” Pet. 83 (claim chart for limitations of claims 13, 15, 19, 20, 21, 24, 28, and 29). Petitioner, however, does not explain how the MTI 2009 Video describes this subject matter, as required for anticipation. “[T]o demonstrate anticipation, the proponent must show ‘that the four corners of a single, prior art document describe every element of the claimed invention.’” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (quoting *Xerox Corp. v. 3Com Corp.*, 458 F.3d 1310, 1322 (Fed. Cir. 2006)). Thus, the challenge to the claims as anticipated by the MTI 2009 Video is legally and factually deficient, and it is unclear what evidence the Petitioner is relying upon.

With regard to the alternative challenge based on obviousness in view of the MTI 2009 Video, the Petition also lacks particularity. *See* Pet. 3, 69. For example, in the claim charts (*id.* at 69–90), Petitioner states:

The LP3 Manual confirms that it would have been obvious for the LP3 to receive power from a power source and have “four metal contacts inside each base [to] . . . contact the set of contacts on each puck.”

* * *

It would have been obvious to a POSITA to have had circuitry in the puck to pass power from the electrical contacts on the puck to the rechargeable battery and/or to pass power directly from the electrical contacts to the Smart Cable for charging the electronic device.

* * *

It would have been obvious for the LP3 to operate circuitry to communicate an alarm signal externally from the puck to trigger an alarm via its wireless transmitter in order to signal an alarm relating to the removal of the electronic device from the puck.

* * *

The LP3 Manual shows that it would have been obvious to place two sets of contacts diametrically opposed (180° from one another) and circumferentially spaced about a ring on the base and puck. . . . Such placement of contacts was further a trivial modification and obvious design choice in view of the prior art.

* * *

Various contacts, including outwardly extending ones, would have been obvious to use with the LP3 product.

Id. at 72–73, 78, 83, 87 (footnote and citations omitted). These conclusory statements as to obviousness of separate elements of the claims are not supported by sufficient explanation or reasoning in the Petition to establish how or why the claimed invention as a whole would have been obvious.

2. Improper Revival of Priority Application

It is not in dispute that the '837 application was abandoned and revived. Pet. 6–7; Prelim. Resp. 9–10. Petitioner contends that revival of the '837 application was in error and cannot support Patent Owner's priority claim. Pet. 5–9. The improper revival of the '837 application is not within the limited statutory scope of a post-grant review. Therefore, we decline to consider this theory of unpatentability and to institute a post-grant review on

this basis.

Pursuant to 35 U.S.C. § 321(b), post-grant reviews are limited in scope to “any ground that could be raised under paragraph (2) or (3) of section 282(b) (relating to invalidity of the patent or any claim).” In a case directly on point, *Aristocrat Technologies Australia PTY Ltd. v. International Game Technology*, 543 F.3d 657 (Fed. Cir. 2008), the Federal Circuit determined that “‘improper revival’ is not a cognizable defense in an action involving the validity or infringement of a patent” under 35 U.S.C. § 282(b). *Aristocrat*, 543 F.3d at 659.

Petitioner argues based on comments in a concurring opinion to a later Federal Circuit decision, *Exela Pharma Sciences, LLC v. Lee*, 781 F.3d 1349 (Fed. Cir. 2015) (per curiam), that we should consider improper revival in the context of this post-grant review. Pet. 10. Contrary to Petitioner’s argument, *Exela Pharma* supports rejection of Petitioner’s improper revival argument. In *Exela Pharma*, the Federal Circuit held “that PTO revival actions are not subject to third party challenge under the APA [Administrative Procedure Act].” 781 F.3d at 1353. In a concurring opinion, Judge Dyk wrote that reconsideration of the *Aristocrat* decision was warranted, but Judge Dyk also noted that “[a]s we hold today, there is no APA review for improper revivals and no alternative mechanism for review.” *Exela Pharma*, 781 F.3d at 1355. In a separate concurrence, Judge Newman addressed Judge Dyk’s criticism of *Aristocrat* and specifically explained that consideration of improper revival is not a ground that can support institution of a post-grant review. *Exela Pharma*, 781 F.3d at 1353–1354. Judge Newman wrote:

The Patent Act is explicit as to the grounds for challenges

to issued patents; these grounds do not include challenge to PTO discretionary actions in revival of deemed-abandoned applications. A PTO decision to excuse a tardy filing is not a statutory ground of invalidity or defense to infringement under 35 U.S.C. § 282, nor is it a ground on which third persons can initiate and participate in post-issuance disputes, *see* Chapter 30 (prior art citations and requests for reexamination), Chapter 31 (inter partes review), and **Chapter 32 (post-grant review)**. Rather it is an irregularity in prosecution that “becomes irrelevant after the patent has issued.” . . . The recently enacted America Invents Act (AIA), which provides new mechanisms for third party attacks on issued patents, did not change the principle that internal PTO procedures are not subject to third party collateral attack.

Id. (citations omitted, emphasis added).

Petitioner argues that we may consider its improper revival argument under 35 U.S.C. § 324(b), which provides that a post-grant review may be instituted if “the petition raises a novel or unsettled legal question that is important to other patents or patent applications.” Pet. 9. However, in light of controlling authority in *Aristocrat* and *Exela Pharma*, we do not believe that Petitioner’s argument presents a novel or unsettled legal question.

In view of the above, we decline to reconsider the Office’s decision reviving the ’837 application.

3. Summary

Petitioner has failed to set forth the Anticipation and Alternative Challenges with particularity. In addition, Petitioner’s argument based on the alleged improper revival of the ’837 application is not properly before us in this proceeding. Therefore, institution of past-grant review based on the Anticipation and Alternative Challenges in the Petition is not warranted.

C. Exercise of Discretion to Deny Institution

If trial is instituted, the Board institutes as to all claims and all challenges or not at all. *USPTO Guidance on the Impact of SAS on AIA Trial Proceedings* (April 26, 2018) (“[T]he PTAB will institute as to all claims or none . . . if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition.”). However, in circumstances under which instituting a trial would be an inefficient use of Board resources, the Board can exercise its discretion not to institute trial. *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, Case IPR2018-00752 (PTAB Sept. 12, 2018) (Paper 8) (precedential). Therefore, even if there is merit in one or more of the challenges in the Petition based on one or more of the references cited as evidence, in light of the deficiencies in the Petition discussed above, we exercise our discretion not to institute post-grant review.

III. CONCLUSION

Based on our discussion above of all the deficiencies in the Petition, we exercise our discretion not to institute post-grant review. Therefore, we do not institute post-grant review on any claims or any challenge to the claims.

IV. ORDER

Upon consideration thereof,
it is ORDERED that:
the Petition for post-grant review of claims 1–30 of U.S. Patent No. 10,026,281 B1 is *denied*.

PGR2019-00019
Patent 10,026,281 B2

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