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Paper 13
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

SIGHTSOUND TECHNOLOGIES, LLC
Patent Owner

Case CBM2013-00021
Patent 5,966,440

Before MICHAEL P. TIERNEY, JUSTIN T. ARBES, and GEORGIANNA W. BRADEN, *Administrative Patent Judges.*

Opinion for the Board filed by *Administrative Patent Judge* ARBES.

Opinion Concurring filed by *Administrative Patent Judge* TIERNEY.

ARBES, *Administrative Patent Judge.*

DECISION
Institution of Covered Business Method Review
37 C.F.R. § 42.208

having a "second party hard disk" rather than a "non-volatile storage portion."

Based on the information presented in the Petition and supporting evidence, we are not persuaded that claims 1, 64, and 95 are more likely than not unpatentable as claiming patent-ineligible subject matter under 35 U.S.C. § 101.

C. Asserted Ground Based on Obviousness-Type Double Patenting

Petitioner contends that claims 1, 64, and 95 of the '440 patent are unpatentable for obviousness-type double patenting in view of claim 3 of the '573 patent and claim 3 of Patent 5,675,734.[4] Pet. 52-79. According to Petitioner, obviousness-type double patenting is a permissible ground for challenging claims in a covered business method review. *Id*. at 52-53. We disagree.

Under the AIA, any ground that could be raised under 35 U.S.C. § 282(b)(2) or (3) can be raised in a post-grant review or, with exceptions not relevant here, in a covered business method review. *See* AIA § 18(a)(1); 35 U.S.C. § 321(b). The grounds under 35 U.S.C. § 282(b)(2) and (3) are (emphasis added):

> (2) Invalidity of the patent or any claim in suit on *any ground specified in part II as a condition for patentability*.
>
> (3) Invalidity of the patent or any claim in suit for failure to comply with—
>
> (A) any requirement of section 112, except that the failure to disclose the best mode shall not be a basis

[4] Patent 5,675,734 is a continuation of Application 08/023,398, which is a continuation of the '573 patent.

> on which any claim of a patent may be canceled or held invalid or otherwise unenforceable; or
>
> (B) any requirement of section 251.

Title 35, Part II includes 35 U.S.C. § 101.

There are two types of double patenting: (1) "same invention" double patenting, and (2) "obviousness-type" double patenting. "Same invention" double patenting prevents a person from obtaining more than one patent on identical subject matter. *In re Longi*, 759 F.2d 887, 892 (Fed. Cir. 1985). This type of double patenting "finds its support in the language of 35 U.S.C. § 101," which states that "[w]hoever invents or discovers any new and useful process . . . may obtain *a* patent therefor." *Id*. "Obviousness-type" double patenting prevents a person from obtaining claims in a second patent that are not patentably distinct from the claims of the person's first patent. *Id*. Obviousness-type double patenting is a "judicially created doctrine grounded in public policy (a policy reflected in the patent statute) rather than based purely on the precise terms of the statute." *Id.* The doctrine exists to "prevent the extension of the term of a patent, even where an express statutory basis for the rejection is missing." *Id.* As a result, obviousness-type double patenting is often called "nonstatutory" or "judicially created" double patenting, whereas "same invention" double patenting is called "statutory." *See, e.g.*, *Otsuka Pharm. Co., Ltd. v. Sandoz, Inc.*, 678 F.3d 1280, 1297 (Fed. Cir. 2012) ("[n]onstatutory double patenting is a judicially created doctrine grounded in public policy"); *Sun Pharm. Indus., Ltd. v. Eli Lilly & Co.*, 611 F.3d 1381, 1384 (Fed. Cir. 2010) (comparing "statutory double patenting, which stems from 35 U.S.C. § 101," with "obviousness-type double patenting, which is a judicially created doctrine"); *Takeda Pharm. Co., Ltd. v. Doll*, 561 F.3d 1372, 1375 (Fed. Cir. 2009)

("[n]on-statutory, or 'obviousness-type,' double patenting is a judicially created doctrine").

Obviousness-type double patenting is a judicially created, policy based doctrine, not a statutory "ground specified in part II as a condition of patentability," as required by 35 U.S.C. § 282(b)(2). Therefore, obviousness-type double patenting is not a permissible ground for challenging claims in a covered business method review.

Petitioner's arguments to the contrary are not persuasive. Petitioner's position is that obviousness-type double patenting is a permissible ground because it is "drawn by the courts from 35 U.S.C. § 101." Pet. 52-53. Petitioner cites as support two cases stating that obviousness-type double patenting is "borne out of 35 U.S.C. § 101" and "based on an interpretation of the statute." *Id.* (citing *Eli Lilly & Co. v. Teva Pharm. USA, Inc.*, 619 F.3d 1329, 1341 (Fed. Cir. 2010), and *Boehringer Ingelheim Int'l GmbH v. Barr Labs., Inc.*, 592 F.3d 1340, 1355 n.1 (Fed. Cir. 2010) (Dyk, J., dissenting-in-part)). The fact that obviousness-type double patenting arose as a judicially created doctrine based on the language of 35 U.S.C. § 101, however, does not mean that the doctrine itself is statutory. The doctrine is not in the statute. Petitioner also cites a statement from Senator Leahy in the legislative history of the AIA that the Office can consider in a covered business method review "any challenge that could be heard in court." 157 Cong. Rec. S1363 (daily ed. Mar. 8, 2011); *see* Pet. 53. The language of 35 U.S.C. § 282(b)(2), however, is clear that only grounds specified in Title 35, Part II as conditions for patentability may be raised. As obviousness-type double patenting does not appear in Part II, it is not a ground that can be raised in a covered business method review.

D. Conclusion

We conclude that Petitioner has not demonstrated that the challenged claims are more likely than not unpatentable based on the asserted grounds. Therefore, we do not institute a covered business method review on any of the asserted grounds as to any of the challenged claims.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied as to all challenged claims of the ’440 patent.

TIERNEY, *Administrative Patent Judge*, concurring in the result only.

I concur in the result only.

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