

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDERSECRETARY AND DIRECTOR OF
THE UNITED STATES PATENT AND TRADEMARK OFFICE

NESTED BEAN, INC.,
Petitioner,

v.

BIG BEINGS USA PTY LTD and LB ONLINE & EXPORT PTY LTD
d/b/a LOVE TO DREAM ONLINE AND EXPORTS,
Patent Owner.

IPR2020-01234
Patent 9,179,711 B2

Before KATHERINE K. VIDAL, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

ORDER
Granting Request for Rehearing by the Director
Authorizing Supplemental Briefing
37 C.F.R. § 42.71

Big Beings USA Pty Ltd. and LB Online Expert Pty Ltd d/b/a Love to Dream Online and Experts (“Patent Owner”) requests Director review of the finding in the Patent Trial and Appeal Board (“Board”) Final Written Decision determining dependent claims 3–16 (“dependent claims”) of U.S. Patent No. 9,179,711 B2 (“the ’711 patent”) unpatentable (Paper 34, “Dec.”). Paper 35 (“Reh’g Req.”); Ex. 3100. Patent Owner submits that to the extent the dependent claims depend from claim 1, which was not unpatentable, the dependent claims likewise must be found not unpatentable notwithstanding Patent Owner’s use of multiple-dependent claiming. Reh’g Req. 9.

I have reviewed the Board’s Final Written Decision and the Papers of record in this proceeding. I determine that Director review of the Board’s Final Written Decision is appropriate because Patent Owner raises a question as to whether the Board legally erred when it found “claims 3–16 anticipated (or rendered obvious []) by the prior art if *either* version of these claims (the version depending from claim 1 or the version depending [from] claim 2) is described by the prior art.” Dec. 35 n.7. Patent Owner additionally raises a question as to the proper interpretation of 35 U.S.C. § 112, fifth paragraph,¹ governing multiple-dependent claiming. *See Interim process for Director review*² Question 10 (setting forth issues that may warrant Director review).

Patent Owner relies on an interpretation of 35 U.S.C. § 112, fifth paragraph, governing multiple-dependent claiming, but cites no authority specifically

¹ The relevant section of the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, took effect on March 16, 2013. Because the application from which the ’711 patent issued claims priority to a foreign patent application that was filed before March 16, 2013, the citation to 35 U.S.C. § 112 is to the pre-AIA version in effect as of the earliest priority date.

² Available at <https://www.uspto.gov/patents/patent-trial-and-appeal-board/interim-process-director-review>.

addressing and resolving the interpretation issue presented. The parties did not develop this issue during trial because the issue did not present itself until the Board's Decision found claim 2 unpatentable, but found claim 1 not unpatentable. *Compare, e.g.*, Dec. 35, 69–70 (summary table), *with* Paper 15 at 29, 36 (Decision on Institution finding that Petitioner established a reasonable likelihood of showing that claims 1 and 2 are unpatentable as anticipated or obvious). Although parties typically are not permitted to present new arguments on rehearing, because the issue here did not arise until the Board issued its Decision, additional briefing is warranted. In order to allow both parties to address the proper interpretation of § 112, fifth paragraph, and whether the Board legally erred, the parties should explain whether they believe the issue is one of first impression, in which case the parties should present their case accordingly. Alternatively, the parties should cite and discuss controlling case law.

Accordingly, based on the foregoing, it is:

ORDERED that Director review of the Board's Final Written Decision (Paper 34) is initiated;

FURTHER ORDERED that Patent Owner submit within two weeks of this order a supplemental brief not to exceed 10 pages (i) addressing the question as to whether the interpretation of 35 U.S.C. § 112, fifth paragraph, governing multiple-dependent claiming on which Patent Owner relies is an issue of first impression; (ii) if so, addressing the legislative history, appropriate statutes, and regulations, as well as any policy issues or persuasive authority; (iii) if not, addressing any authoritative case law specifically addressing Patent Owner's interpretation.

FURTHER ORDERED that Petitioner submit within two weeks of Patent Owner's supplemental brief a responsive brief not to exceed 10 pages addressing

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(i) and (ii) above and any authoritative case law specifically addressing Petitioner's interpretation.

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