

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

NRT TECHNOLOGY CORP. AND NRT TECHNOLOGIES, INC.,  
Petitioner,

v.

EVERI PAYMENTS INC.,  
Patent Owner.

---

Case CBM2016-00080  
Patent 6,081,792

---

Before KEVIN F. TURNER, MIRIAM L. QUINN, and  
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION  
Considering Request for Rehearing  
*37 C.F.R. §§ 42.71*

## I. INTRODUCTION

NRT Technology Corp. and NRT Technologies, Inc. (“Petitioner”) filed a Request for Rehearing (Paper 13, “Reh’g Req.”) of the decision denying institution (Paper 12, “Dec.”). In that decision, we exercised our discretion under § 325(d) to deny the instant Petition (Paper 1, “Pet.”) and not institute a covered business method patent review of U.S. Patent No. 6,081,792 (Ex. 1001, “the ’792 Patent”). Dec. 12.

In its request, Petitioner argues first that our conclusion that an argument raised in the recent petition is substantially the same as a prior argument conflicts with existing case law. Reh’g Req. 1. Second, Petitioner argues that our conclusion that we can take into account prior art grounds that “could” have been raised is inconsistent with the statutory text of 35 U.S.C. § 325(d). *Id.* Finally, Petitioner argues that our finding, that the prior decision was used to bolster previously unsuccessful arguments remade in the recent Petition, is not supported by the record. *Id.* Although we consider Petitioner’s arguments below, the Request for Rehearing is *denied*.

## II. ANALYSIS

When rehearing a decision on institution, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*,

393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

Petitioner argues that its instant Petition challenged claims as being indefinite under 35 U.S.C. § 112 for failing to specify which type of processor is claimed, “leaving one skilled in the art without any reasonable certainty as to the scope of the claims.” Reh’g Req. 2 (citing Pet. 26–28). With respect to the proffered indefiniteness ground, we determined that “we have previously considered the scope of the term ‘processor,’ which Petitioner now asserts is indefinite. As such, we are persuaded that we have already considered substantially the same arguments and evidence presented in the prior petition.” Dec. 11 (citing Pet. 26–28).

Petitioner argues that such a finding misapprehends Supreme Court and Federal Circuit law, because it conflates indefiniteness and claim construction. Reh’g Req. 2–3 (citing *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2124 (2014), *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1371 (Fed. Cir. 2014), *Cox Communications, Inc. et al. v. Sprint Communication Company LP*, 838 F.3d 1224, 1231 (Fed. Cir. 2016)). Petitioner continues that, “the question of whether the claims as a whole ‘fail to specify...any reasonable certainty as to the scope of the claims’ could not as a matter of law have been previously considered based on the Board’s consideration of the construction of ‘processor’ alone.” Reh’g Req. 3–4. Additionally, Petitioner argues that the two issues cannot be substantially the same, as the claim construction of a particular term is not the dispositive question in an indefiniteness inquiry. *Id.* We do not agree.

In making our determination as to whether “the same or substantially the same prior art or arguments previously were presented to the Office,” (35 U.S.C. § 325(d)), we examined the grounds and the arguments expounded by Petitioner in the instant Petition and those previously made in the prior petition for covered business method patent review of the ’792 Patent: *NRT Tech. Corp. et al. v. Global Cash Access, Inc.*, Case CBM2015-00167 (“’167 proceeding”). Dec. 7–12. In the ’167 proceeding, the prior petition included the argument that “processor” should be construed to mean “a human or machine entity capable of processing,” noting that “the specification provides that the ‘processor’ is an entity that can receive information transmitted by the ATM terminal, process the information, and forward the information,” and the specification lacks any further description of the processor entity. *See* CBM2015-00167, Paper 1, 12–14 (citing Ex. 1001, 4:4–9; Fig. 2, same exhibit, both proceedings). The instant Petition argues that “[b]ecause the term ‘processor’ could be understood as referring to several different things and no confident choice is available, ‘processor’ is therefore indefinite.” Pet. 26. Although the issues are not identical, both arguments address the meaning of the same claim term “processor,” and both assert that the claim term can have at least two meanings.

Although we acknowledge that the prior petition argues that the processor could be a human or a machine (CBM2015-00167, Paper 1, 12–14), and the instant Petition asserts that the claim term processor can be read onto different descriptions in the specification, i.e., machine processor versus payment processing business (Pet. 18–20), similar inquiries occur in both cases. The analysis raised in the prior petition overlaps substantially with the analysis of the same term in the

instant Petition. *See e.g.*, Ex. 1007 ¶¶ 75–77 (Declaration of Dr. Alexander stating that one of ordinary skill in the art would understand the term “processor” to be indefinite because one of skill in the art would have understood the term includes both machines and humans performing the claimed functions); CBM2015-00167, Paper 1, 12–14. As stated in the decision, “[t]here is no requirement of identicalness of either prior art or arguments, and therefore, a scintilla of difference or an immaterial difference does not create necessarily ‘different’ arguments.” Dec. 12. Also, one issue need not be “dispositive” of the other issue for the issues to be the same or substantially the same to those previously presented to the Office. We acknowledge the differences between variations in claim construction and the determinations of indefiniteness pointed out by Petitioner (Reh’g Req. 2–4), but we remain persuaded that the issues and arguments are substantially the same.

Petitioner also argues that our conclusion, that we can take into account prior art grounds that “could” have been raised, is inconsistent with the statutory text of 35 U.S.C. § 325(d). Reh’g Req. 4. Petitioner contrasts the language of § 325(d) with the language of § 325(e), which provides that estoppel applies “on any ground that the petitioner raised or reasonably could have raised.” *Id.* at 4–5. Petitioner continues that the statutory language of § 325(d), i.e., “the same or substantially the same prior art or arguments previously were presented to the Office,” should not be interpreted as “*could have* been presented to the Office.” *Id.* at 5–6. Petitioner concludes that when the proper scope of § 325(d) is considered, the statute is not a basis to deny the Petition. *Id.* at 7. We do not agree.

The portion of the decision relied upon in Petitioner's rehearing request is taken out of context with respect to the full decision. An excerpted portion is provided herein:

With respect to the prior art grounds, we previously considered Akel under 35 U.S.C. § 103, in view of other prior art references. *See* '167 proceeding, slip op. at 7, 15–16 (PTAB Jan. 22, 2016) (Paper 14). As such, the new combinations proffered in the instant Petition could have been properly presented in the original petition.

Dec. 11. As recited therein, we simply made an observation about the new ground, not a determination as to whether estoppel may apply under 35 U.S.C. § 325(d). Even if such an evaluation was made, it is not out of the ordinary for the Board to consider the new grounds in the context of the old grounds. *See, e.g., NVIDIA Corp. v. Samsung Elec. Co.*, Case IPR2016-00134 (PTAB May 4, 2016) (Paper 9).

Additionally, we did not consider whether the ground “could have been properly presented” in the prior petition in determining whether the arguments were the same or substantially the same. Dec. 11. Later, in the same section, we concluded that: “we are persuaded by Patent Owner's arguments that the proposed grounds proffered in the instant Petition involve evidence and arguments we previously considered in the '167 proceeding and are substantially the same as those previously presented.” *Id.* at 12. As such, we remain persuaded that the prior arguments, or argument substantially similar thereto, were previously presented to the Office, such that our exercise of discretion under 35 U.S.C. § 325(d) is proper.

Lastly, Petitioner argues that there is no support for the conclusion made in the decision that the prior decision was used to bolster previously unsuccessful

arguments, and that reformulated arguments were remade in the recent Petition. Reh'g Req. 7. Petitioner continues that the prior decision did not make any findings regarding the definiteness of the claims to guide the instant Petition, and that the prior decision never provided a construction of “processor” that could have been helpful for the indefiniteness ground proffered in the instant Petition. *Id.* at 7–8. Additionally, Petitioner asserts that although the prior decision did not institute on grounds relying on Akel and Reeder, those failures did not provide a road map to Petitioner for the grounds proffered in the instant Petition, with the motivation for those grounds, instead, coming from Petitioner’s declarant. *Id.* at 8–9. We do not agree.

Petitioner’s argument seems to rely on the supposition that any follow-on petition would need to correct any specific errors found in a prior petition to serve as a guide for the follow-on petition to fall within the discretion of 35 U.S.C. § 325(d). For example, if a petition urging unpatentability of claims over references A and B was found to be unworthy of institution because the petition did not provide a rationale to combine those references, Petitioner’s argument suggests that only a follow-on petition asserting references A and B and a proper rationale would fall within the discretion of 35 U.S.C. § 325(d). Presumably, a petition asserting references A and C could not be considered “the same or substantially the same prior art or arguments previously were presented to the Office.” However, as stated in the Decision, our jurisprudence covers more than such special circumstances, including rejecting a “second bite at the apple” over new references or arguments, when they are the same or substantially the same as those previously presented. Dec. 11. A prior failure can guide present actions,

even if those present actions do not cure every prior error, and they merely address alternative means of reaching the same conclusion. We remain persuaded that the proposed grounds proffered in the instant Petition involve evidence and arguments we previously considered in the '167 proceeding and are substantially the same as those previously presented.

For the foregoing reasons, Petitioner has not shown that the Board abused its discretion in denying the instant Petition and not instituting a covered business method patent review of the '792 Patent.

### III. CONCLUSION

Insofar as we have addressed above the assertions set forth in Petitioner's Request for Rehearing (Paper 13), the Request is *granted*. In all other respects, the Request is *denied*.



Case CBM2016-00080  
Patent 6,081,792

PETITIONER:

Tam Thanh Pham  
Margaux A. Savee  
Christopher Hines  
POLSINELLI LLP  
[TPham@polsinelli.com](mailto:TPham@polsinelli.com)  
[MSavee@polsinelli.com](mailto:MSavee@polsinelli.com)  
[CHines@polsinelli.com](mailto:CHines@polsinelli.com)

PATENT OWNER:

Steven A. Moore  
Rene Mai  
PILLSBURY WINTHROP SHAW PITTMAN LLP  
[steve.moore@pillsburylaw.com](mailto:steve.moore@pillsburylaw.com)  
[rene.mai@pillsburylaw.com](mailto:rene.mai@pillsburylaw.com)  
[Docket\\_IP@Pillsburylaw.com](mailto:Docket_IP@Pillsburylaw.com)