

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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DUNCAN PARKING TECHNOLOGIES, INC.,  
Petitioner,

v.

IPS GROUP INC.,  
Patent Owner,

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Case IPR2016-00067  
Patent 7,854,310 B2

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Before JOSIAH C. COCKS, MICHAEL W. KIM, and RICHARD E. RICE,  
*Administrative Patent Judges.*

COCKS, *Administrative Patent Judge.*

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a) and 37 C.F.R. § 42.73*

## I. INTRODUCTION

### A. Background

Petitioner, Duncan Parking Technologies, Inc. (“DPT”), filed a Petition to institute an *inter partes* review of claims 1–5 and 7–10 of U.S. Patent No. 7,854,310 B2 (Ex. 1001, “the ’310 patent”). Paper 1 (“Pet.”). We instituted trial as to claims 1–5 and 7–10 on the sole basis of determining whether those claims are unpatentable under 35 U.S.C. § 102 as anticipated by King ’054<sup>1</sup>. Paper 9 (“Inst. Dec.”).

After institution of trial, Patent Owner, IPS Group, Inc. (“IPS”), filed a Patent Owner Response (Paper 11, “PO Resp.”), to which DPT replied (Paper 19, “Pet. Reply”). IPS also filed a Motion to Exclude certain of DPT’s exhibits. Paper 24.<sup>2</sup> Oral argument was conducted on December 8, 2016. A transcript of the oral argument is included in the record. Paper 28, “Tr.”.

We have jurisdiction under 35 U.S.C. §§ 6(b) and 318(a). Having considered the evidence and arguments of both parties, we conclude that Petitioner has not met its burden of showing, by a preponderance of evidence, that claims 1–5, 7, and 9 of the ’310 patent are anticipated by King ’054 under 35 U.S.C. § 102(e). With respect to claims 8 and 10, however, we conclude that Petitioner has met its burden of showing, by a preponderance of the evidence, that those claims are anticipated by King ’054.

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<sup>1</sup> U.S. Patent No. 8,595,054 B2 issued Nov. 26, 2013 (Ex. 1004).

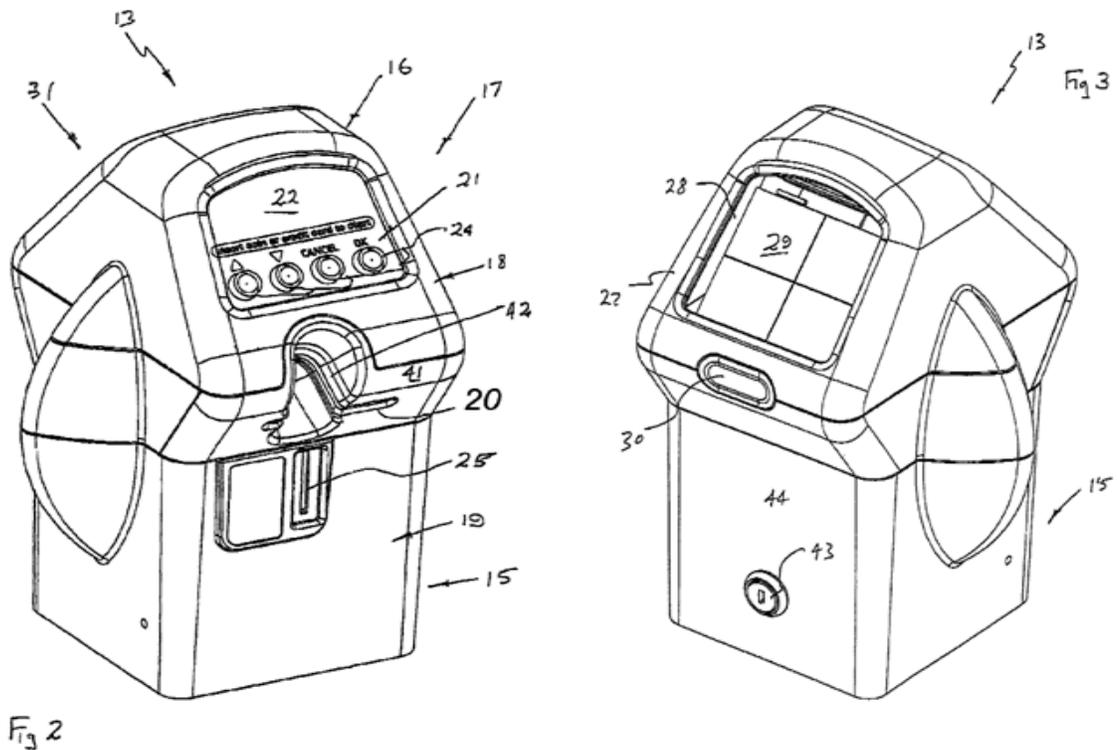
<sup>2</sup> DPT filed an Opposition to IPS’s Motion (Paper 25), and IPS filed a corresponding Reply to the Opposition (Paper 26).

*B. Related Matters*

DPT and IPS identify the following district court proceedings concerning the '310 patent: *IPS Group, Inc. v. Duncan Solutions, Inc.*, 3-15-cv-01526 BTM MDD (S.D. Cal.). Pet. 1; Paper 4, 2. The '310 patent was also the subject of another *inter partes* review proceeding (IPR2016-00068) involving the same Petitioner.<sup>3</sup>

*C. The '310 Patent*

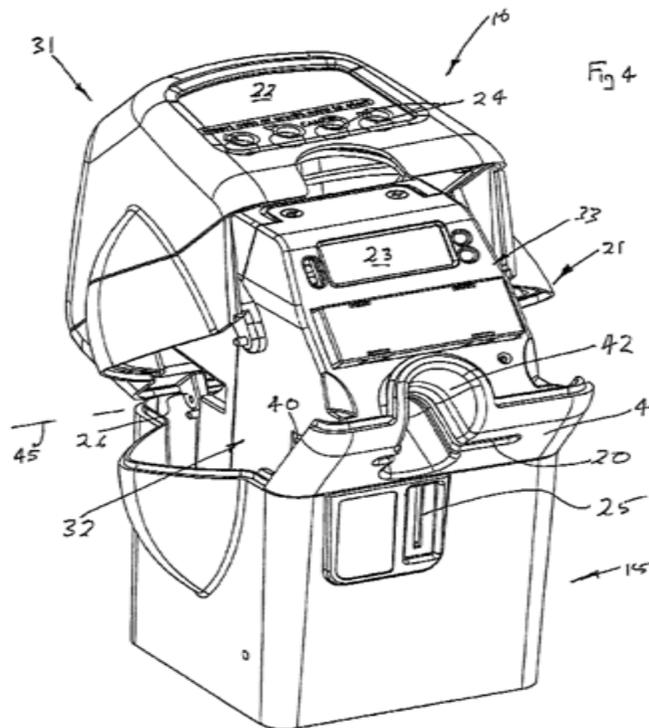
The '310 patent is titled "Parking Meter and a Device Therefor." Ex. 1001, Title. Figures 2 and 3 of the '310 patent are reproduced below:



<sup>3</sup> An *inter partes* review was not instituted in IPR2016-00068.

Figures 2 and 3 above depict, respectively, a front view and a rear view of a parking meter assembly, according to the '310 patent. *Id.* at 2:11–14. As shown in the figures, parking meter 13 includes cover panel 16 and panel set 15. *Id.* at 2:30–33. As shown, specifically, in Figure 2, cover panel 16 and panel set 15 collectively present front face 17 having control panel 21, window 22, buttons 24, coin slot 25, and card slot 20. *Id.* at 2:33–38. As shown in Figure 3, the rear of parking meter 13 includes rear face 27 with window aperture 28 allowing for transmission of light to solar panel 29. *Id.* at 2:51–54. At or adjacent rear face 27 is indicator 30 that relays whether a parking period has expired. *Id.* at 2:57–60.

Figure 4 of the '310 patent is reproduced below:



As shown in Figure 4 above, cover panel 16 is attached pivotally to panel set 15 (*id.* at 2:44), and together define housing 31 in which module 32 is located (*id.* at 2:66–67). Module 32 includes electronic device 33, which

incorporates screen 23, coin sensor 34 (not shown), and coin validator 35 (not shown). *Id.* at 2:67–3:3.

Claims 1 and 9 are independent. Claim 1 is illustrative and is reproduced below:

1. A parking meter including:

a coin sensor;

a card reader;

an electronic device electrically connected to the sensor and reader so as to receive information electronically therefrom, the electronic device having a screen to provide information visually, a telephone connection to provide receiving information in respect of a card used in respect of said card reader, and connections for at least one rechargeable battery to power the reader, sensor and device;

a solar cell operatively associated with said connections to charge said battery;

a housing in which the coin sensor, card reader, and electronic device are located, the housing comprising an intermediate panel set and a cover panel, wherein the cover panel is movably attached to the intermediate panel set, and a surface of the cover panel and a surface of the intermediate panel set comprise a front face, and the front face surface of the cover panel includes a control panel having a window and a plurality of buttons that operate the parking meter upon manipulation by a user;

a coin slot in the front face into which coins are inserted for delivery to the sensor and then to a coin receptacle;

a card slot in the front face into which a card is inserted to be read by said reader;

a rear face comprising a surface of the cover panel and a surface of the intermediate panel set providing a window aperture via which said solar cell is exposed to light;

wherein the coin sensor and the card reader are electrically linked to provide information to the electronic device to provide information of whether payment has been made;

wherein the screen of the electronic device is visible through the window of the control panel when the cover panel is attached to the intermediate panel.

## II. ANALYSIS

After reviewing all relevant papers and testimony, there is no meaningful dispute that King '054 discloses all the features of claims 1–5 and 7–10 of the '310 patent.<sup>4</sup> Rather, the central issue to be resolved by this panel is whether King '054 constitutes prior art to the '310 patent under 35 U.S.C. § 102. In that respect, the involved ground is premised on 35 U.S.C. § 102(e),<sup>5</sup> which, in pertinent part, operates as a barrier to patentability if the subject invention was described in “a patent granted on an application for patent *by another* filed in the United States before the invention by the applicant for patent” (emphasis added). Thus, to be applicable under § 102(e), the content of King '054 on which DPT relies in its proposed ground of anticipation must be “by another.” That “by another” requirement forms the core dispute between the parties.

The posture of this trial is such that, with respect to the “by another” requirement, we consider the prior art status of King '054 in connection with

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<sup>4</sup> In the Institution Decision, we cited to the Petition and content of King '054 in concluding that DPT had made an initial adequate showing that all of the features of claims 1–5 and 7–10 were present in King '054. Inst. Dec. 8–14. As a part of its Patent Owner Response, IPS does not challenge that showing except for a general contention that the features of claim 10 are not disclosed in King '054. *See* PO Resp. 25. As discussed *infra*, we do not agree with IPS’s general contention.

<sup>5</sup> The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 296–07 (2011), took effect on September 16, 2012. Because the application for the patent at issue in this proceeding has an effective filing date before that date, we refer to the pre-AIA versions of the statute.

the claims of the '310 patent in two claim groupings: (1) claims 1–5, 7, and 9; and (2) claims 8 and 10.

*A. Claims 1–5, 7, and 9*

The '310 patent names four inventors—David William King, Murray David Kirby Hunter, Matthew James Hall, and David Andrew Jones. Ex. 1001, (75). King '054 names two inventors—David William King, and Alexander Schwarz. Ex. 1004, (75). Thus, David King is named as an inventor of both the '310 patent and King '054. Nevertheless, DPT urges that King '054 anticipates claims 1–5, 7, and 9 under § 102(e). IPS contends that the content of King '054 on which DPT relies is David King's own work, and also that the claims 1–5, 7, and 9 reflect the sole invention of Mr. King. In advocating that the relevant content of King '054 is not “by another” vis-à-vis the noted claims of the '310 patent, IPS summarizes its positions as follows:

Dave King and Alex Schwarz both contributed to inventions disclosed in King'054, but they did not contribute equally and they did not both contribute to every invention, whether claimed or not. Similarly, Dave King and his Australian collaborators (including David Jones) contributed to inventions disclosed and claimed in King'310, but they did not contribute equally and they did not all contribute to every claimed invention. Because the inventions disclosed in the King patents were developed contemporaneously as complementary efforts in the same development project, they contain significantly overlapping disclosure. Because the core concepts originated with Dave King, who is the sole common inventor and who remained the driving force behind the development program with both teams of inventors, most of the overlapping disclosure represents Dave King's contribution to both King patents.

PO Resp. 4–5.

IPS offers the following evidence as underlying support for the above-noted contentions: (1) the Declaration testimony of David King (Ex. 2032); (2) the Declaration testimony of King '054 co-inventor Alex Schwarz (Ex. 2033); (3) the Declaration testimony of the '310 patent co-inventor David Jones (Ex. 2020); and (4) various documents characterized by IPS as “contemporaneous documents” describing communications, reports, memos, and illustrations associated with the development of a parking meter according to the invention of the '310 patent (*e.g.*, Exs. 2010–2019, 2021–2032, 2033–2042). According to IPS, the above-noted evidence provides corroborated proof of Mr. King’s inventorship in connection with each of the '310 patent and King '054. PO Resp. 6–15. DPT generally challenges the sufficiency of IPS’s proffered evidence. In that respect, DPT takes the view that record evidence establishes that the allegedly anticipatory content of King '054 and the '310 patent have different inventive entities such that King '054 is “by another.” Pet. Reply 4.

Throughout the course of an *inter partes* review, a petitioner has the burden of showing the unpatentability of a subject patent. *See* 35 U.S.C. § 316(e) (“In an inter partes review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”); *see In re Magnum Oil Tools Int’l, Ltd.* 829 F.3d 1364, 1375 (Fed. Cir. 2016). To the extent, however, that IPS had a burden of coming forward with relevant evidence tending to support its position that Mr. King was the sole inventor of the pertinent portions of King '054 and the '310 patent, i.e., a burden of production, we have evaluated that evidence and are satisfied that IPS has met any such burden. The question that we must now address is whether DPT has satisfied its

continuing burden in showing unpatentability, i.e., has shown that content of King '054, on which DPT relies, reflects invention that is “by another” as required by to sustain an unpatentability ground arising from 35 U.S.C. § 102(e).

DPT bases its unpatentability case on two underlying positions. We consider each of those positions in turn.

*1. DPT's First Position*

DPT's first position is that Figure 8 of King '054 shows many of the elements of claims 1–5, 7, and 9, and that Mr. Schwarz “helped conceive” of some aspects of that Figure 8, which correspond to certain elements recited in claims 1 and 9 of the '310 patent. Pet. Reply 8. DPT, thus, concludes that “[a]s such, Schwartz is clearly a joint inventor of at least a portion of the anticipatory [King '054] disclosure. Consequently, the [King '054] anticipatory disclosure is ‘by another’ under § 102(e), and thus invalidates claims 1–5 and 7–10 of the '310 Patent.” *Id.* at 9.

Figure 8 of King '054 depicts a block diagram illustrating components of a parking meter device. Ex. 1004, 3:26–27. According to DPT, Mr. Schwarz is responsible for the creation of “the ‘connections’ and ‘operative[ ]’ elements reflected in Figure 8 of [King '054] and recited in independent claims 1 and 9 of the '310 Patent.” Pet. Reply. 8. There is, evidently, no dispute that Mr. Schwarz contributed to the creation of at least some aspects of the block diagram of Figure 8.<sup>6</sup> Yet, although Mr. Schwarz may have developed the particular block diagram of Figure 8, the record

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<sup>6</sup> At oral argument, IPS acknowledged that Mr. Schwarz conceived of the schematic shown in King '054's Figure 8. *See* Tr. 24–25.

suggests that Mr. King was aware that components of the parking meter that he envisioned generally would be connected to, and operable with, one another. *See, e.g.*, Ex. 2032 ¶¶ 13–17 (describing Mr. King’s efforts to conceptualize the mechanical aspects of a retrofitable parking meter and “working out how the electronics would work together, including designing a controller and software.”); *see also* Ex. 2033 ¶ 9 (Mr. Schwartz testifying that “[Mr. King] alone identified the components themselves that would be included in the parking meter described in the ’054 patent, as well as the high-level idea that they would need to be connected in a functional way.”) We are skeptical that the general recitation in claims 1 and 9 of connections and operative associations of components constitutes more than what Mr. King broadly envisioned on his own, even if Mr. Schwartz’s Figure 8 of King ’054 also shows such connections and operative association of components.

Nevertheless, even assuming, as is urged by DPT, that Figure 8 is necessary to account for some of the elements required by the claims of the ’310 patent, it also is apparent that certain other elements of the claims, e.g., claims 1 and 9, are not disclosed in that figure. Indeed, it is clear from the Petition that DPT relies on content of King ’054 that is outside of any depiction or description associated with Figure 8. *See, e.g.*, Pet. 21–33 (identifying content from, among other portions, Figures 3–7 of King ’054 in accounting for various claim features); *see also* Tr. 8 (“JUDGE COCKS: Let me rephrase. In the [P]etition you relied on more than just Figure 8 of the ’054 patent to account for the claims of the ’310 patent? MR. VIVARELLI: Correct.”)

Thus, there is no question that DPT's anticipation ground for the claims of the '310 patent is premised on more than simply the disclosure of King '054's Figure 8. Yet, there is no clear indication who is the inventor of the additional disclosure of King '054 that makes up the whole of that ground. IPS is of the view that the additional disclosure relied upon was created solely by Mr. King, and DPT provides no pertinent elucidation indicating that IPS's view is incorrect. Indeed, DPT does not dispute that the various additional disclosures of King '054 on which DPT relies as an anticipatory disclosure for claim 1–5, 7, and 9 was the sole work of Mr. King himself. In other words, the record at hand simply provides little reason to disbelieve that Mr. King was the sole inventor of the applied portions of King '054, beyond Figure 8, on which DPT relies in urging that claims 1–5, 7, and 9 of the '310 patent are anticipated. We discuss this issue further below.

## *2. DPT's Second Position*

The second position that factors into DPT's proposed ground rests on the theory that Mr. King and Mr. Jones jointly invented the claims of the '310 patent. Pet. Reply 10. DPT contends that if they were joint inventors of the claims of the '310 patent, then the inventive entity of the '310 patent is different than that of King '054. In attempting to substantiate its position, DPT relies on various exhibits pertaining to a parking meter project described as the "Magnetic Card Reader Parking Meter (MCR PM)" project that was started when Mr. King hired design firm Design+Industry Pty. Ltd. ("D+I"), a "product development design consultancy" located in Australia. Pet. Reply 11–25. For instance, DPT points to e-mail correspondence from Mr. King to Mr. Jones describing the parking meter project as something

they “can do together” and characterizing the project as “our project.” Pet. Reply 12–13, 18 (citing Ex. 2018, 6 and Ex. 2034, 1.). Similarly, DPT points to notes from a meeting on March 12, 2005 in which Mr. King and Mr. Jones reach a “joint resolution” concerning components of a parking meter. Pet. 13 (citing Ex. 2039). DPT also draws attention to a parking meter design termed “Configuration 9,” which DPT contends bears resemblance to the illustration of a parking meter from Figure 2 of the ’310 patent. Pet. 13–14.

The communications between Mr. King and the design firm D+I (including Mr. Jones), and the other evidence submitted by DPT, certainly demonstrate that there were numerous back and forth exchanges between Mr. King and D+I in the course of developing a commercial parking meter. Nevertheless, such collaboration in developing an operable, commercial product does not, itself, establish joint inventorship for all claims of the ’310 patent. The touchstone of inventorship is conception, which is “the completion of the mental part of the invention.” *Burroughs Welcome Co. v. Barr Laboratories, Inc.*, 40 F.3d 1223, 1227–28 (Fed. Cir. 1994). “[T]he test for conception is whether the inventor has an idea that was definite and permanent enough that one skilled in the art could understand the invention.” *Id.* at 1228.

Here, we conclude that the record as a whole adequately establishes that Mr. King had mentally conceptualized a solar powered and credit card enabled single-space parking meter that was intended to retrofit existing parking meter housings. Although Mr. King engaged D+I to implement various mechanical aspects of such a parking meter, in our view, the record conveys that D+I’s role in such implementation was more tantamount to

perfection or reduction to practice of Mr. King’s conceived invention, rather than amounting to acts of conception with respect to claims 1–5, 7, and 9. Such perfection does not negate Mr. King’s claim of sole inventorship.<sup>7</sup> *See Trovan, Ltd. v. Sokymat SA*, 299 F.3d 1292, 1302 (Fed. Cir. 2002) (“An inventor may solicit the assistance of others when perfecting the invention without ‘losing’ any patent rights.”)

From the correspondence between Mr. King and D+I during the development of an operational parking meter, which uses terms such as “joint resolution,” “working “together,” and “our project,” DPT wishes us to infer that joint inventorship occurred, but DPT’s proffered evidence for such inference is generally vague and not dispositive of the joint inventorship inquiry. Moreover, any such inferences are in stark contrast to the direct testimony, given under penalty of perjury, by each of Mr. King (Ex. 2032) and Mr. Jones (Ex. 2020) that Mr. King is the sole inventor of claims 1–5, 7, and 9 of the ’310 patent. Furthermore, that D+I contributed features added by claims 8 and 10 does not necessitate a determination that D+I (or any person associated therewith) be considered a co-inventor of any of claims 1–5, 7, or 9. *See Narton Corp. v. Schukra U.S.A. Inc.*, 558 F.3d 1352, 1358 (Fed. Cir. 2009) (“It has not yet been determined whether Benson contributed to the invention of claim 1 (although he does not claim to be a co-inventor with respect to claims 5 and 6). If Benson did not make those inventions, he does not necessarily attain the status of co-inventor by providing the sole feature of a dependent claim.”)

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<sup>7</sup> As discussed below, there is no dispute that D+I did play a part in conceiving of the subject matter added by claims 8 and 10.

3. *Conclusion—claims 1–5, 7, and 9*

In light of the foregoing, and having considered the complete record before us, we are not persuaded that DPT has demonstrated adequately that the content of King '054 on which DPT relies in proposing that claims 1–5, 7, and 9 of the '310 patent is “by another.” In reaching that conclusion, we are mindful that DPT’s proposed ground necessarily relies on content of King '054 that the record suggests was the sole work of Mr. King. We agree with IPS that, given the particular circumstances here, Mr. King’s own contributions to King '054 are not available as prior art under 35 U.S.C. § 102(e) with respect to claims 1–5, 7, and 9 of the '310 patent in which Mr. King is the sole inventor. *See* PO Resp. 24. In other words, Mr. King’s individual contributions to King '054 are not work “by another” when it comes to Mr. King’s claims of the '310 patent. *See In re Land and Rogers*, 368 F.2d 866, 877 (C.C.P.A. 1966) (“There appears to be no dispute as to the law that A is not ‘another’ as to A”). We also are not persuaded that DPT has made a suitable case demonstrating that Mr. Jones conceived of the invention that is encompassed by those claims. Accordingly, we conclude that DPT has not met its burden to show, by a preponderance of the evidence, that claims 1–5, 7, and 9 are unpatentable under 35 U.S.C. § 102(e) based on King '054.

*B. Claims 8 and 10*

Claim 8 adds to claim 1 “wherein said front face and rear face converge upwardly.” Claim 10 adds to claim 9 “wherein said card slot slopes downwardly to be accessible via the front face surface of the intermediate panel, and the front face surface of the intermediate panel is downwardly facing.” With respect to claim 8, DPT points to King '054’s

Figures 3 and 5 as showing the added feature. Pet. 29. In connection with claim 10, DPT directs us to column 3, line 67 through col. 4, line 5, and Figures 1–7 of King '054. Although IPS generally contends that the referenced portions of King '054 do not show the added feature of claim 10 (PO Resp. 25), in reviewing those noted portions of King '054, we do not agree with IPS and are satisfied that each of the added features of claims 8 and 10 are disclosed therein for the reasons set forth in the Petition. In particular, as is evident from the noted portions of King '054, parking meter 32 includes a front face and rear face that converge upwardly, and card slot 22 slopes downwardly to be accessible via the front face surface of a downwardly facing intermediate panel, as required by claims 8 and 10.

The record before us paints a clearer picture of the inventive entity of claims 8 and 10 of the '310 patent. In that respect, and as noted above, there is no dispute between the parties that the named inventors of the '310 patent contributed to the invention that is set forth in claims 8 and 10. *See, e.g.*, PO Resp. 25 (“Dave King and David Jones agree that the features of claims 8 and 10] are the joint inventors of Dave King and the D+I inventors.”); *see also* Ex. 2020 ¶ 32 (“Murray, Hunter, Mather Hall, and [David Jones] made an inventive contribution only to claims 8 and 10.”). None of the D+I inventors were associated with King '054. Thus, it is clear that the inventive entity of claims 8 and 10 of the '310 patent is different than the entity that created the content of King '054 applied as anticipatory of claims 8 and 10.

Although IPS clearly recognizes that claims 8 and 10 are the product of joint invention by Mr. King and the D+I inventors, IPS, nevertheless, summarily concludes that we should determine that King '054 is not prior art against the claims 8 and 10 of the '310 patent. Pet. 26. Yet, IPS offers

no cogent explanation as to why that course of action is the correct one. The inventive entity of claims 8 and 10 of the '310 patent is unquestionably different than the inventive entity of all portions of King '054. In that respect, King '054 is clearly “by another” when it comes to claims 8 and 10. As such, after considering the record at hand, we are persuaded by DPT that claims 8 and 10 are considered appropriately as unpatentable under 35 U.S.C. § 102(e).

### *C. Motion to Exclude*

IPS seeks to exclude Exhibits 1003, 1006–1032, and 1036–1038. Paper 24, 1. The noted exhibits, although relied upon by DPT in its Petition, were presented as underlying support for grounds on which we did not institute trial. IPS’s purported basis for such exclusion is terse. IPS requests that the Board exclude those exhibits because their presence in the record allegedly “is unnecessary and could lead to confusion to the public or other tribunals reviewing this record.” *Id.* at 1–2. In support of the Motion, IPS cites to decisions in two prior *inter partes* reviews—*Microsoft Corp. v. Parallel Networks Licensing, LLC*, IPR2015-00483, Paper 81, 24 (2016), and *SK Innovation Co. Ltd. v. Celgard, LLC*, IPR2014-00680, Paper 57, 27 (2015). According to IPS, those cases stand for the proposition that “non-use” is sufficient basis for excluding evidence. *Id.*

At the outset, we observe that the circumstances of each of *Microsoft Corp.* and *SK Innovation* do not mirror that present in this proceeding. In each of those prior proceedings, the basis for exclusion of certain documents arose because the documents had not been cited in *any* paper of the proceedings. In this case, although we did not institute trial on the grounds associated with the pertinent exhibits, those exhibits were cited and relied

upon as a part of the Petition. Generally, the record of an *inter partes* review proceeding shall be made available to the public. 37 C.F.R. § 42.14.

Following that rule, documents relied upon by a petitioner in support of a ground of unpatentability, even if that ground proves unsuccessful, generally should be made available to the public. Indeed, maintaining the integrity of the public record weighs in favor of keeping underlying documents in the record that are part of the history of the proceeding.

Furthermore, we do not discern why simply the presence in the record of documents associated with an unsuccessful ground of a petition would lead to “confusion” to either the public or any reviewing tribunal, as urged by IPS. It does not follow that documents that were part of a ground which did not proceed to trial will somehow lead to confusion in any review of the Board’s determination as to the ground on which trial was instituted. Neither do we see why the pertinent exhibits create “unfair prejudice” to the detriment of IPS. Paper 26, 5. IPS does not explain adequately why it faces “prejudice” in maintaining documents of record that were cited in the Petition.

Moreover, we note that for the ground of unpatentability on which trial was instituted, the issue of conception was front and center. In considering the conception issue, it was necessary to take into account the level and knowledge of one of ordinary skill in the art. Many of the exhibits that IPS seeks to exclude were discussed in the Petition as a part of the assessment of the knowledge of a skilled artisan in the field of parking meters. *See, e.g.*, Pet. 8–14. That circumstance also weighs in favor of maintain the exhibits in the proceeding. To now exclude or remove those documents would render the record incomplete.

Accordingly, for the foregoing reasons, IPS's Motion to Exclude Exhibits 1003, 1006–1032, and 1036–1038 is *denied*.

### III. CONCLUSION

For the foregoing reasons, having considered the respective positions of DPT and IPS, we conclude that DPT has not shown by a preponderance of the evidence that claims 1–5, 7, and 9 are anticipated by King '054. We, however, conclude that DPT has made such a showing with respect to claims 8 and 10.<sup>8</sup>

### IV. ORDER

After due consideration of the record before us, it is:

ORDERED that claims 1–5, 7, and 9 are not held unpatentable based on DPT's proposed ground of anticipation by King '054 under 35 U.S.C. §102(e);

FUTHER ORDERED that claim 8 and 10 are held unpatentable as anticipated by King '054;

FURTHER ORDERED that IPS's Motion to Exclude Evidence (Paper 24) is *denied*; and

FURTHER ORDERED that, because this is a Final Written Decision, the parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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<sup>8</sup> We are cognizant that, at first glance, it is logically difficult to reconcile a simultaneous determination that while an independent claim is patentable, a claim dependent therefrom is not. Nevertheless, after reviewing the relevant facts and law, we determine that this outcome, while admittedly unusual, is correct for the reasons set forth herein.

IPR2016-00067  
Patent 7,854,310 B2

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