

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TENCENT TECHNOLOGY (SHENZHEN) CO. LTD.
Petitioner Application 16/354,371,
Petitioner,

v.

YOGESH RATHOD,
Respondent Patent 10,990,265,
Patent Owner.

DER2022-00002

Before JAMESON LEE, MICHAEL R. ZECHER, and JUSTIN T. ARBES,
Administrative Patent Judges.

ZECHER, *Administrative Patent Judge.*

DECISION
Denying Petitioner's Request for Rehearing of
Decision Denying Institution
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Petitioner, Tencent Technology (ShenZhen) Co. Ltd. (“Tencent”), filed a Request for Rehearing under 37 C.F.R. § 42.71(d). Paper 18 (“Req. Reh’g”). The Request for Rehearing seeks reconsideration of our Decision Denying Institution of Derivation Proceeding with respect to claims 1–18 of U.S. Patent No. 10,990,265 B2 (Ex. 1004, “the ’265 patent”) owned by Respondent, Mr. Yogesh Rathod, in which we determined that Tencent’s Petition does not address adequately the issue of conception of the invention allegedly disclosed to Mr. Rathod. Paper 17, 12–14 (“Decision” or “Dec.”).

In the Request for Rehearing, Tencent contends that we erred in denying the Petition because we misapprehended or overlooked the relative timing of the parties’ filing dates and, as a result, we imposed a universal requirement of independent corroboration for prior conception and we failed to consider that U.S. Patent Application No. 16/354,371 (Ex. 1001, “the ’371 application”), by itself, suffices as evidence of conception. Req. Reh’g 2, 12–15. More specifically, Tencent argues that, because the ’371 application was filed before U.S. Patent Application No. 17/001,803 (“the ’803 application”) that issued as the ’265 patent, Tencent may rely on the filing date of the ’371 application as evidence that Tencent conceived of the invention before Mr. Rathod and, given this theory of conception, Tencent need only demonstrate for purposes of institution that the ’265 patent and its three priority applications lack sufficient written description support for the allegedly disclosed invention. *Id.* at 4–12.

As we explain below, we have considered the arguments presented by Tencent in its Request for Rehearing. We take this opportunity to modify

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our Decision to address Tencent’s arguments directed to whether the ’265 patent and its three priority applications lack sufficient written description support for the allegedly disclosed invention. We, however, maintain our initial determination that Tencent did not make a sufficient showing for purposes of institution.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify specifically all matters we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *Id.* When rehearing a decision on a petition, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). “An abuse of discretion occurs if the decision (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.” *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 442 (Fed. Cir. 2015) (quoting *Abrutyn v. Giovannello*, 15 F.3d 1048, 1050–51 (Fed. Cir. 1994) (citation omitted)). With this in mind, we address Tencent’s arguments.

III. ANALYSIS

A. Conception

Tencent contends that we misapprehended or overlooked controlling case law that dictates Tencent may rely on the filing date of the ’371

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application as evidence of conception, particularly because Tencent filed the '371 application before the '803 application that issued as the '265 patent and Tencent disputes whether the '265 patent and its three priority applications provide sufficient written description support for the allegedly disclosed invention. Req. Reh'g 1, 4–12. To support its argument in this regard, Tencent directs us to the U.S. Court of Appeals for the Federal Circuit's decision in *Hyatt v. Boone*, 146 F.3d 1348 (Fed. Cir. 1998). Req. Reh'g 1–2, 6–7, 10, 12–13. The Federal Circuit in *Hyatt* held, in relevant part, that “[t]he filing of a patent application serves as conception and constructive reduction to practice of the subject matter described in the application.” *Hyatt*, 146 F.3d at 1352. “There is no need for proof or corroboration of the subject matter that is included in the application unless a date earlier than the filing date is sought to be established Thus[,] the inventor need not provide evidence of . . . conception . . . when relying on the content of the patent application.” *Id.*

Applying this holding to the circumstances presented here, Tencent asserts that the filing of the '371 application before the '803 application that issued as the '265 patent “plainly demonstrates prior conception.” Req. Reh'g 7, 10, 12. Tencent further asserts that it need not independently corroborate that the three named inventors of the '371 application conceived of the allegedly disclosed invention to antedate the effective filing date of the '265 patent because, according to Tencent, the effective filing date of the '265 patent is subsequent to the filing date of the '371 application. *Id.*

As an initial matter, we fail to see how we erred in applying the holding in *Hyatt* to the particular circumstances presented here, especially

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when Tencent did not present *Hyatt* as controlling case law in the Petition. *See, e.g., Click-To-Call Techs. LP v. Ingenio, Inc.*, No. 2022-1016, 2022 WL 3443656, at *7 (Fed. Cir. Aug. 17, 2022) (“We will not fault the district court for failing to apply a case that Click-to-Call did not even present to the district court.”). Nevertheless, we do not dispute that the aforementioned holding in *Hyatt* equally applies to a derivation proceeding, nor do we dispute that, under these particular circumstances, Tencent may rely on the filing date of the ’371 application as evidence of conception. Our initial concerns with Tencent’s Petition stemmed from the lack of clarity it provides on the issue of conception. *See* Dec. 12 (explaining that “[c]onception is the touchstone of inventorship”). As we explained in the Decision, “Tencent’s Petition is devoid of any explanation of the circumstances surrounding conception of the invention by the three named inventors of the ’371 application. . . . Indeed, the word ‘conception’ does not appear in Tencent’s Petition at all.” *Id.* at 13. Instead, Tencent leaves us—and Mr. Rathod—to speculate or assume its theory of conception because Tencent never squarely asserts that it is relying on the filing of the ’371 application, by itself, as evidence of conception. To be clear, it was Tencent’s complete silence in its Petition with respect to the issue of conception that initially led us to determine that Tencent’s showing of this essential element of a claim of derivation was deficient. *See id.*

We also do not agree with Tencent’s argument that we imposed a universal requirement of independent corroboration for prior conception to institute a derivation proceeding. *See* Req. Reh’g 2, 12–15. As we explain above, Tencent’s Petition does not address squarely the issue of conception,

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thereby leaving us—and Mr. Rathod—to speculate or assume how Tencent intended to satisfy this essential element of a claim of derivation. As we noted in the Decision, Tencent is “master of its complaint” and we are not at liberty to “raise, address, and decide . . . theories never presented by [Tencent].” Dec. 13–14 (quoting *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018); then *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016)). That is, the lack of explanation in Tencent’s Petition regarding its theory of conception led us to believe that Tencent intended to pursue a more traditional path for proving derivation (e.g., by providing corroborating evidence of prior conception and communication of that conception to the named inventor(s) of the respondent’s application) and, at the time of the Decision, it was not clear to us that Tencent was relying on the filing of the ’371 application, by itself, as evidence of conception.

B. Tencent’s Written Description Arguments

Now that we understand Tencent to argue that it is relying on the filing of the ’371 application, by itself, as evidence of conception, we must address whether Tencent has made a sufficient showing that the ’265 patent and its three priority applications lack sufficient written description support for the allegedly disclosed invention. This is because two of Mr. Rathod’s priority applications predate the filing of the ’371 application on March 15, 2019 (as well as Tencent’s own priority applications filed in 2016 and 2017). *See* Req. Reh’g 1 (arguing that “Tencent challenged Mr. Rathod’s right to claim priority to his earlier PCT application under 35 U.S.C. § 112, enabling Tencent to rely on the filing date of its ’371 application as substantial evidence of conception”), 2–3 (arguing that “Tencent identified

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Mr. Rathod’s ’803 application as the ‘earlier application’ to its ’371 application based on the ’803 application’s effective filing date of August 1, 2013 (*i.e.*, the filing date of PCT/IB2013/056314”), 6 (showing a timeline of the relevant applications), 9–12; Ex. 1001, 4;¹ Ex. 1004, code (60). If the ’265 patent and its three priority applications provide sufficient written description support for the invention, Tencent’s asserted conception as of March 15, 2019, would not be a *prior* conception. In *Hyatt*, the Federal Circuit stated that, “[w]hen a party . . . seeks the benefit of an earlier-filed United States patent application, the earlier application must meet the requirements of 35 U.S.C. § 120 and 35 U.S.C. § 112 ¶ 1.”² *Hyatt*, 146 F.3d at 1352 (footnote omitted). “The earlier application must contain a written description of the subject matter of the [invention], and must meet the enablement requirement.” *Id.* (*citing Fiers v. Revel*, 984 F.2d 1164, 1170 (Fed. Cir. 1993)).

This is not a situation where, prior to filing the Petition, Tencent did not have the benefit of Mr. Rathod’s positions as to how the ’265 patent provides sufficient written description support for the invention. As Tencent acknowledges in the Petition, Mr. Rathod provided Tencent with a document purportedly setting forth written description support in the ’265 patent for

¹ All references to page numbers in the prosecution history of the ’371 application refer to the page numbers inserted by Tencent in the bottom, right-hand corner of each page in Exhibit 1001.

² The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011) (“AIA”), amended 35 U.S.C. § 112, effective March 16, 2013. Because the ’371 application and the ’265 patent both have effective filing dates after March 16, 2013, the post-AIA version of § 112 applies.

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the invention on or about March 10, 2021, which is roughly eight months before Tencent filed the Petition in this proceeding on November 15, 2021. *See* Paper 2, 22 (“Pet.”) (citing Ex. 1006 (email correspondence from Mr. Rathod to Tencent dated March 10, 2021, that includes a written description support document); Ex. 1011 ¶ 3 (Declaration from Paul Lein, Tencent’s Senior Intellectual Property Counsel, testifying that he received Mr. Rathod’s written description support document on or about March 10, 2021)). In his written description support document, Mr. Rathod provides a detailed mapping of each claim of the ’265 patent to various disclosures in the specification of the ’803 application that issued as the ’265 patent. Ex. 1006, 29–37.³

In the Petition, Tencent focuses its arguments on the lack of written description support for independent claim 1 of the ’265 patent and, in particular, limitation 1(b). *See* Pet. 22–28. Limitation 1(b) of independent claim 1 recites, in relevant part:

b) executing, by the processing circuitry, a second application program in the running environment that is provided by the execution of the first application program, the execution of the second application program starting a program logic process and a first presentation process corresponding to a first view interface of the second application program, and the program logic process and the first presentation process respectively interfacing with the running environment that is provided by the execution of the first application program.

³ All references to the page numbers in Mr. Rathod’s email correspondence dated March 10, 2021, refer to the page numbers inserted by Tencent in the bottom, right-hand corner of each page in Exhibit 1006.

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Ex. 1004, 29:24–33. In his written description support document, Mr. Rathod cited to the following disclosures in the specification of the '803 application as purportedly setting forth written description support for limitation 1(b) of independent claim 1 of the '265 patent: paragraphs 8, 9, 19, 21, 22, 30, 42, 76, 80, 114, 120, 121, 123, 124, 127, 148–51, and Figure 6. Ex. 1006, 29. Tencent's arguments directed to the lack of written description support for limitation 1(b) of independent claim 1 of the '265 patent, however, only address Figure 6 and paragraphs 123 and 124 of the '803 application. *See* Pet. 25–27. According to Tencent, these cited disclosures “make[] no mention of the use of a second application program operating in the running environment that is provided by the execution of the first application program as . . . claim element [1(b)] requires.” *Id.* at 26.

We are not persuaded by Tencent's piecemeal written description analysis. Tencent's arguments only focus on Figure 6 and paragraphs 123 and 124 of the '803 application. By doing so, Tencent appears to ignore other highly relevant disclosures in the '803 application, such as paragraphs 19, 21, and 114. Paragraphs 19 and 21 each state an objective of the '803 application—namely, (1) “[a]nother significant objective of the present invention is to internet middleware for enabling user to access plurality features of plurality of web sites, applications, services, databases, networks, social networks and peer to peer networks for single user friendly interface”; and (2) “[a]nother significant objective of the present invention is to presenting to user various selected features, functions, web parts, user

actions of one or more web sites at central interface.” Ex. 1003, 40–41⁴ (paragraphs 19 and 21 of the ’803 application). In connection with Figure 2 of the ’803 application, paragraph 114 discloses that “[a]pplications 242 may further include browser 245,” which, in turn, “may include virtually any of a variety of client applications configured to receive and/or provide communications of web pages and other content over a network.” *Id.* at 61–62 (paragraph 114 of the ’803 application); *see also id.* at 53 (paragraph 83 of the ’803 application, which states “the client application may enable a user to interact with the browser application”). Together, paragraphs 19, 21, and 114 of the ’803 application are, at a minimum, highly relevant to whether Mr. Rathod was in possession of limitation 1(b) of independent claim 1 of the ’265 patent at the time of filing the ’803 application because these paragraphs disclose the use of a client application program operating in the running environment that is provided by the execution of the browser application program.

We understand Tencent to argue that the three applications in the priority chain of the ’265 patent, which consist of two divisional applications and one continuation application, include essentially the same disclosure as the ’803 application. *See* Ex. 1004, code (60); Pet. 30 (arguing that “the only substantive change in the ’265 patent from the three applications it claims priority to is the inclusion of a short description in the ‘Field of Invention’”). Assuming this to be true, Tencent’s arguments directed to the

⁴ All references to the page numbers in the prosecution history of the ’803 application refer to the page numbers inserted by Tencent in the bottom, right-hand corner of each page in Exhibit 1003.

lack of sufficient written description support for limitation 1(b) of independent claim 1 in the '265 patent equally apply to the three applications in the priority chain of the '265 patent. For the same reasons we discuss above in the context of the '803 application, those arguments would not be persuasive.

In summary, even when treating the filing of the '371 application, by itself, as evidence of conception, Tencent must make a sufficient showing for purposes of institution that the '265 patent and the three applications in the priority chain lack sufficient written description support for the allegedly disclosed invention. As we explain above, Tencent has not met this burden.

IV. CONCLUSION

For the foregoing reasons, Tencent may rely on the filing of the '371 application, by itself, as evidence of conception. Tencent, however, has not made a sufficient showing for purposes of institution that the '265 patent and the three applications in the priority chain lack sufficient written description support for the allegedly disclosed invention. As a result, Tencent has not demonstrated that we abused our discretion in not instituting a derivation proceeding.

V. ORDER

Accordingly, it is hereby:
ORDERED that Tencent's Request for Rehearing is *denied*; and
FURTHER ORDERED that a copy of this Decision be placed in the files of the '371 application and the '265 patent.

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For PETITIONER:

Erik B. Milch
Xianhua Kong
Thomas Blinka
COOLEY LLP
emilch@cooley.com
wendy.kong@cooley.com
tblinka@cooley.com

For PATENT OWNER:

Yogesh Rathod
rathodyogeshc@gmail.com