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# Rackspace Hosting, Inc. v. Rotatable Technologies LLC: Final Written Decision and Denied Motion to Amend IPR2013-00248

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*Takeaway: Patent Owner cannot meet its burden of showing that proposed amended or substitute claims are patentable over the prior art by presenting only attorney arguments, and not evidence.*

In its Final Written Decision, the Board ordered that Petitioner had proved by a preponderance of the evidence that claims 1-4, 6-9, 11-14, 16, and 18 of the '978 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Martinez and Capps; and that claims 5, 10, 15, and 17 of the '978 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Martinez, Capps, and Adobe. The Board denied Patent Owner's Contingent Motion to Amend, finding that Patent Owner had not proved by a preponderance of the evidence that proposed substitute claims 19-22 are patentable.

Petitioner had filed a Petition requesting inter partes review of claims 1-18 of the '978 patent, for which the Board then instituted trial. Of these, claims 1, 9, and 18 are independent claims.

The '978 patent relates to a graphical user interface (GUI) for selectively rotating windows on a computer display. In particular, the '978 patent includes a computer display that provides selective rotation of a window in such a way as to facilitate human interfacing. By clicking and holding a button, the user may choose any window orientation or the user's choices may be limited to preselected orientations.

The Board began its substantive analysis by focusing on claim construction of recited terms such as computer display window, display portion (of the computer display window), toggling the window between two preselected orientations, means for [selectively] rotating the window about a rotation point at the discretion of the user, means for determining a rotation point, means for rotating the window by predetermined increments, means for toggling the window between two preselected orientations, and means for returning the window to a zero degree orientation. The Board then turned to its obviousness analysis.

As a first position, Petitioner relied on Declarations by its expert Dr. Turnbull to assert that claims 1-4, 6-9, 11-14, 16, and 18 are unpatentable under 35 U.S.C. § 103(a) as obvious over Martinez and Capps; and that claims 5, 10, 15, and 17 of the '978 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Martinez, Capps, and Adobe.. Martinez teaches a system for maintaining a window level despite changes in attitude of the laptop on which the window is displayed. Capps

discloses a system in which a user may rotate an image of a screen of a computer. Adobe teaches rotation of an object displayed by a computer.

Patent Owner asserted that the combination of these references did not disclose or suggest various respective claim terms. The Board did not agree with Patent Owner. Among other things, the Board found that Patent Owner had improperly attacked the references individually; that Patent Owner has proposed a construction that improperly imported a limitation from the specification; and that Patent Owner had not correctly characterized the prior art. The Board did not substantively address a number of other proposed grounds for the unpatentability of these claims in view of the aforementioned obviousness conclusions based on Martinez and Capps (taken alone or in combination with Adobe).

The Board denied Patent Owner's Contingent Motion to Amend, for a number of reasons. First, the Board noted that "[w]hile Patent Owner does cite to Dr. Turnbull's Declaration to establish the level of education and experience to be considered one of ordinary skill, such a citation, by itself, denotes nothing without further specific testimony concerning the specific features set forth in the proposed claim. Instead, Patent Owner only presents arguments, not evidence, focusing only on the disclosures of Martinez and Horvitz. Accordingly, Patent Owner has not met the burden it undertook by putting forth proposed amended claims." Second, the Board was not persuaded that Patent Owner had shown by a preponderance of the evidence that proposed substituted claims 19-22 were patentable over the combination of Martinez and Capps.

**Rackspace Hosting, Inc. v. Rotatable Technologies LLC, IPR2013-00248**
Paper 32: Final Written Decision
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Patent 6,326,978
Before: Michael P. Tierney, Michael W. Kim, and Miriam L. Quinn
Written by: Kim
Related Proceeding: Rotatable Tech., LLC v. Petroleum Geo-Services, Inc., Case No. 2:13-cv-00177 (E.D. Tex.)



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