

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EMNOS USA CORP.,
Petitioner,

v.

DUNNHUMBY LIMITED,
Patent Owner.

Case CBM2015-00162
Patent 8,214,246 B2

Before PATRICK R. SCANLON, JENNIFER MEYER CHAGNON, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

GOODSON, *Administrative Patent Judge*.

DECISION

Denying Institution of Covered Business Method Patent Review
37 C.F.R. § 42.208

I. INTRODUCTION

Petitioner emnos USA Corp. filed a Petition (Paper 2, “Pet.”) requesting covered business method patent review of claims 1–9, 11–14, 16–19, 21, 23–32, 34, 35, 37–45, 51–56, 58, 60, 62–67, and 69–73 of U.S. Patent No. 8,214,246 B2 (Ex. 1001, “the ’246 patent”). Patent Owner dunnhumby Limited filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 324. Pursuant to 35 U.S.C. § 324(a), the Director may not authorize a covered business method patent review unless the information in the petition, if unrebutted, “would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” As explained below, we do not institute a covered business method patent review because the Petition does not establish that the ’246 patent qualifies as a covered business method patent.

A. *The ’246 Patent*

The ’246 patent describes a method for retailers to perform analysis on transaction data, such as retail sales and consumer data, from a remote location using an internet connected computer. Ex. 1001, 1:6–9, 1:32–36. According to the ’246 patent, in the retail sector, “[d]emand for products and the prices that consumers are willing to pay for them are continuously changing.” *Id.* at 1:12–13. The detailed knowledge of market conditions that is necessary to excel in the retail market “can best be obtained from a sophisticated analysis of retail sales data.” *Id.* at 1:19–20. The ’246 patent seeks to fill a need for retailers to access and perform individualized analysis

on large compilations of data from retail transactions with minimal delay.
Id. at 1:24–28.

Figure 1, which is reproduced below, is a schematic representation of the system according to one embodiment. *Id.* at 6:20–22.

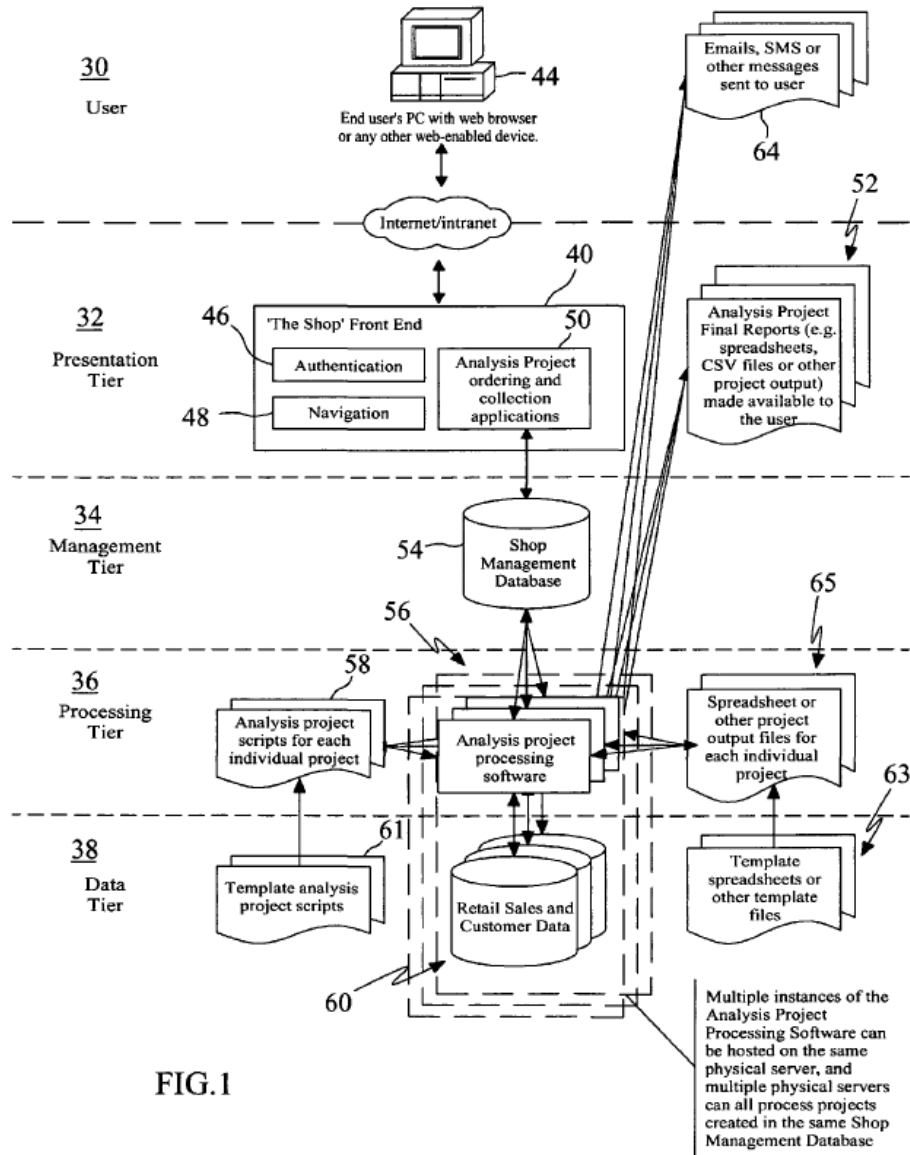


FIG.1

As shown in Figure 1, the system is segmented into several tiers. User tier 30 includes the components through which the user accesses the web-based service, which is provided by web server 40 in presentation tier 32. *Id.* at 8:31–33. Web server 40 provides authentication functions 46

to identify the user and navigation functions 48 to control navigation through project ordering. *Id.* at 8:42–48. Management database 54 in management tier 34 stores input data and parameters selected by the user in setting up the analysis projects. *Id.* at 8:56–59. The '246 patent includes the following description of processing tier 36 and data tier 38:

In the Processing Tier 36, the analysis project processing software 56 constructs executable analysis project scripts 58, which are executed on subsets of the retail sales, consumer and other data resident in a database 60. . . . [T]he executable analysis project scripts 58 are constructed from appropriate script templates 61 obtained from the Data Tier 38, where the script templates 61 are loaded with the input data, parameters and other selections input by the user.

Id. at 9:29–37.

In operation, a user logs into web server 40 from a remote location via computer 44, enters the parameters for the desired analysis project, and submits the project for processing. *Id.* at 10:29–33. The project is then processed at management, processing, and data tiers 34, 36, and 38. *Id.* at 10:34–36. Specifically, “the project is encoded in a way that incorporates the user-selected parameters into an executable script written in an appropriate commercially available scripting language.” *Id.* at 11:52–55.

Analysis project processing software 56 retrieves the user-selected parameters from shop management database 54 and “begins creating the analysis project script 58 for the particular analysis by inserting those parameters into a new script file template 61.” *Id.* at 12:3–5. After the analysis project script is executed, data returned by analysis project processing software 56 is inserted into interactive spreadsheet template file 63 to generate interactive project 65. *Id.* at 10:36–40, 12:48–52.

Claim 1, reproduced below, is illustrative of the challenged claims for the purposes of this Decision:

1. A method for performing a transaction-related analysis, comprising the steps of:

providing one or more computerized databases that include at least one of transaction and consumer data for one or more establishments, the at least one of transaction and consumer data including one or more transaction records associating at least a product identification code with a consumer identification code;

formulating an analysis project request via a user interface that is operatively coupled to a computer system having access to the database; and

generating, by the computer system, an analysis project on the at least one of transaction and consumer data in response to receiving the analysis project request;

wherein the step of formulating the analysis project request includes the steps of, selecting, via the user interface, the analysis project from a predefined list of available analysis projects;

obtaining, by the computer system a template of executable database analysis scripts based, at least in part, upon the selected analysis project;

selecting, via the user interface, one or more analysis parameters associated with the analysis project; and

loading, by the computer system, the selected one or more analysis parameters with the template of executable database analysis scripts to construct an executable analysis project script to be executed against on the at least one of transaction and consumer data in the generating step;

wherein the step of selecting, via the user interface, one or more analysis parameters associated with the analysis project includes the step of selecting one or more products from a list of available products;

wherein the step of selecting, via the user interface, one or more analysis parameters associated with the analysis project includes the step of selecting a time frame in which to limit the

analysis of the at least one of transaction and consumer data;
and

wherein the method further includes the step of
executing, by the computer system, the executable analysis
project script on the at least one of transaction and consumer
data to produce result data.

Id. at 17:8–49.

B. Asserted Challenge

Petitioner challenges claims 1–9, 11–14, 16–19, 21, 23–32, 34, 35, 37–45, 51–56, 58, 60, 62–67, and 69–73 as invalid under 35 U.S.C. § 103 over Anderson¹ in view of Oracle Pro*C² and MicroStrategy DSS³. Pet. 17, 31–79.

C. Related Proceedings

The '246 patent has been asserted against Petitioner in *dunnhumby USA, LLC v. emnos USA Corp.*, Case No. 1:13-cv-00399 (N.D. Ill.) (“Parallel District Court Case”). Pet. 5–6; Paper 5, 1; Ex. 1002.

Before filing the Petition in this proceeding, Petitioner filed another petition for covered business method patent review of the '246 patent. *emnos USA Corp. v. dunnhumby Limited*, Case CBM2015-00116 (Paper 2) (“the '116 CBM Petition”). The '116 CBM Petition challenged the same claims of the '246 patent as the Petition in this proceeding, but the challenge in the '116 CBM Petition was based on 35 U.S.C. § 101. *Id.* at 18. On November 10, 2015, we issued a Decision Denying Institution, in which we

¹ Anderson et al., U.S. Patent No. 5,974,396, issued Oct. 29, 1999 (Ex. 1026).

² SYED MUJEEB AHMED ET AL., ORACLE CORP., PRO*C/C++ PRECOMPILER PROGRAMMER'S GUIDE, RELEASE 9.2 (2002) (Ex. 1041).

³ Archived pages from the website of MicroStrategy, Inc. relating to DSS Agent, as collected in Exhibit 1043.

determined that the '116 CBM Petition did not establish that the '246 patent qualifies as a “covered business method patent” under § 18(d)(1) of the AIA⁴. *emnos USA Corp. v. dunnhumby Limited*, Case CBM2015-00116, slip op. at 13 (PTAB Nov. 10, 2015) (Paper 8) (“the '116 CBM Decision”). Specifically, we determined that Petitioner’s showing on the technological invention portion of the test for covered business method patent eligibility was insufficient. *Id.* at 7–13.

II. ANALYSIS

A petition for covered business method patent review must set forth the petitioner’s grounds for standing, including “demonstrat[ing] that the patent for which review is sought is a covered business method patent.” 37 C.F.R. § 42.304(a). A “covered business method patent” is “a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term *does not include patents for technological inventions.*” AIA § 18(d)(1) (emphasis added); *see* 37 C.F.R. § 42.301(a).

Section III.D. of the Petition presents Petitioner’s arguments and evidence concerning the technological invention portion of the test for covered business method patent eligibility. *See id.* at 11–16. Petitioner sets forth the same content as the corresponding section of the '116 CBM Petition. *Compare* Pet. 11–16, *with* '116 CBM Petition 13–18. These sections of the petitions also rely on the same evidence, including the same Declaration of Dr. Padhraic Smyth dated May 1, 2015. *See* Ex. 1004. Thus,

⁴ Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”).

for the same reasons as discussed in the '116 CBM Decision, Petitioner's showing on the technological invention portion of the test for covered business method patent eligibility is insufficient.

To recapitulate those reasons, the first consideration in determining whether a patent is for a technological invention is “whether the claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art.” 37 C.F.R. § 42.301(b). Petitioner argues that the claims of the '246 patent do not recite a technological feature that is novel and unobvious because “the closest [independent claims 1, 29, and 62] come to reciting anything technological are the words ‘computer,’ ‘database,’ and ‘database analysis scripts.’” Pet. 14. But Petitioner addresses only certain elements of the claims and fails to assess any of the claims as a whole. *See, e.g., E*Trade*, Case CBM2014-00123, slip op. at 7–9 (Paper 15); *Bloomberg L.P. v. Quest Licensing Corp.*, Case CBM2014-00205, slip op. at 9 (PTAB Apr. 7, 2015) (Paper 16); *Apple, Inc. v. ContentGuard Holdings, Inc.*, Case CBM2015-00046, slip op. at 10 (PTAB June 3, 2015) (Paper 12). By focusing only on the portions of the claims reciting computers, databases, and database analysis scripts, Petitioner failed to address the subject matter of any claim in the '246 patent as a whole.

Particularly lacking in Petitioner's analysis of this first consideration is any discussion of the novelty or nonobviousness of the script template limitations,⁵ a focal point throughout the prosecution of the '246 patent. *See*

⁵ Claim 1 recites that the computer system obtains “a template of executable database analysis scripts” and loads “the selected one or more analysis parameters with the template of executable database analysis scripts to construct an executable analysis project script.” Ex. 1001, 17:26–34. The

generally emnos USA Corp. v. dunnhumby Limited, Case CBM2015-00116, slip op. at 9–11 (PTAB Nov. 10, 2015) (Paper 8) (summarizing the role of the script template limitations in the prosecution history of the '246 patent); Ex. 1005,⁶ 6–18 (detailing the prosecution history of the '246 patent).

Despite the central role of the script template limitations during prosecution of the '246 patent, Section III.D. of the Petition does not provide any explanation as to why those limitations were known or obvious as technological features. The Petition asserts that it was known to use scripts to run database queries, *see* Pet. 15, but does not address the novelty or obviousness of loading or feeding user-selected parameters into a script template to construct an executable script. The Smyth Declaration of May 1, 2015 addresses the script template limitations, but is insufficient to show that these limitations were known or obvious in view of the prior art because Dr. Smyth states only that SQL prepared statements were known, without explaining why (or even asserting that) the script template claim limitations encompass such SQL prepared statements. *See* Ex. 1004 ¶ 26.

We note that a later section of the Petition, Section VIII.B., does address the script template limitations as part of the obviousness case against

other two independent claims include similar limitations. Claim 29 recites that the computer system feeds “the obtained parameters into a template of executable database analysis scripts, which corresponds to the analysis project selection, to produce an executable job file.” *Id.* at 19:59–62. Claim 62 recites that the computerized system includes “a plurality of analysis project script executable code templates,” and that the computer system is configured to feed “the obtained parameters into a selected one of the plurality of analysis project script templates to produce an executable job file.” *Id.* at 21:60–22:8.

⁶ Exhibit 1005 is the claim construction order in the Parallel District Court Case, which includes a thorough recounting of the prosecution history of the '246 patent.

the challenged claims and argues that these limitations are taught by Oracle Pro*C. See Pet. 32–34. However, Section III.D. of the Petition, which purports to set out Petitioner’s arguments and evidence concerning the technological invention portion of the test for covered business method patent eligibility, does not discuss Oracle Pro*C, or even cross-reference the evidence or arguments of Section VIII.B. See Pet. 11–16. Other panels of the Board have found arguments presented as part of a petitioner’s obviousness case to be insufficient to carry the petitioner’s burden on the technological invention inquiry. See *Motorola Mobility, LLC v. Intellectual Ventures I, LLC*, Case CBM2014-00084, slip op. at 4–5 (PTAB Sept. 23, 2014) (Paper 21) (denying request for rehearing of decision denying institution because “[t]he only portion of the Petition addressing whether a claim as a whole recites a technological feature was addressed in our Decision. The portion of the Petition that Petitioner contends the Board overlooked or misapprehended addresses only whether the challenged claims are novel and unobvious over the prior art, and does not address whether the claimed subject matter as a whole recites a technological feature.”) (internal citations omitted); see also *Bloomberg L.P. v. Quest Licensing Corp.*, Case CBM2014-00205, slip op. at 7, 9 (PTAB June 17, 2015) (Paper 18) (denying request for rehearing of decision denying institution because petitioner did not carry burden on technological invention inquiry, and finding unpersuasive petitioner’s arguments that focused on portions of the petition other than the section addressing the technological invention inquiry).

Moreover, even considering the arguments in Section VIII.B. of the Petition, the Petition’s showing on the technological invention inquiry

remains deficient. The Petition relies on the Oracle Pro*C reference as disclosing the script template limitations of the independent claims, but as Patent Owner points out, the Petition does not present evidence establishing that Oracle Pro*C qualifies as a prior art printed publication. *See* Pet. 32–34; Prelim. Resp. 50–53. Petitioner asserts that Oracle Pro*C “was published in 2002” but does not point to any specific evidence of its publication or public availability in 2002. *Id.* at 33. If Petitioner’s assertion is based on the “March 2002” statement that appears on the cover of the Oracle Pro*C reference, that statement is hearsay, and Petitioner does not argue that any hearsay exception or exclusion applies. *See* Ex. 1041, 1; *see also ServiceNow, Inc. v. Hewlett-Packard Co.*, Case IPR2015-00716, slip op. at 16 (PTAB Aug. 26, 2015) (Paper 13) (“To the extent that Petitioner relies on the date on the face of each exhibit and the indications of availability of these references for download . . . for the truth of that information, and considering that Petitioner has not established that any hearsay exception or exclusion applies, we agree [that the statements are inadmissible hearsay].”).

Petitioner also argues, with citation to the testimony of Dr. Smyth, that Oracle Pro*C is a reference used by programmers who develop applications in Oracle database environments. Pet. 33 (citing Ex. 1030 ¶ 57). However, neither the Petition nor Dr. Smyth explains how or when the specific Programmer’s Guide, Release 9.2 that Petitioner relies on as the Oracle Pro*C reference (Ex. 1041) was made available to skilled artisans. Because the Petition does not establish that Oracle Pro*C qualifies as prior art, Section VIII.B. of the Petition does not remedy the deficient showing in Section III.D. of the Petition on the first consideration of the technological

invention inquiry, which asks whether “the claimed subject matter as a whole recites a technological feature that is novel and unobvious over ***the prior art***.” 37 C.F.R. § 42.301(b).

Regarding the second consideration in determining whether a patent is for a technological invention, the Petition provides merely one short paragraph of discussion, arguing that the problem addressed by the ’246 patent is not technical but “instead involves non-technical sales and marketing issues such as effectiveness of product promotions and launches in the marketplace.” Pet. 16 (citing Ex. 1001, 7:24–43). Patent Owner counters that the prosecution history shows that the problem solved by the ’246 patent was technical in nature: “how can non-technical users who do not have knowledge of the database structure and/or of the database scripting languages construct . . . complex database queries . . . ?” Prelim. Resp. 38. According to Patent Owner, the solution to that problem, which involved combining user-selected parameters into script templates to produce an executable project script, was also technical. *Id.* at 38–39.

Petitioner’s arguments under the second prong are not persuasive. In our view, there are both technical and non-technical (e.g., business) aspects to the problem that is solved in the ’246 patent. The technical problem of enabling retailers untrained in database queries to quickly and easily analyze information in databases is addressed in furtherance of the business objective of keeping up with the fast-paced retail market. Petitioner’s arguments under the second prong do not address the technical aspects of the problem being solved, and fail to explain why the solution is not technical.

In view of the foregoing, having considered both prongs of the test for a technological invention, and consistent with our determination in the ’116

CBM Decision, we conclude that Petitioner has failed to carry its burden to show that the '246 patent is not a patent for a technological invention.

III. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition does not establish that the '246 patent qualifies as a “covered business method patent” under § 18(d)(1) of the AIA. Therefore, we do not institute a covered business method patent review as to any of the challenged claims.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied as to all challenged claims of the '246 patent.

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