

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HULU, LLC,
Petitioner,

v.

CHINOOK LICENSING DE, LLC,
Patent Owner.

Case IPR2015-00625
Patent 7,047,482 B1

Before WILLIAM V. SAINDON, JAMES P. CALVE, and
TRENTON A. WARD, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Petitioner requested an *inter partes* review of all claims (1–20) of U.S. Patent No. 7,047,482 B1 (Ex. 1001, “the ’482 patent”). Paper 1 (“Pet.”). We entered a Decision granting review on two of the three grounds Petitioner raised. *Compare* Paper 8, 4 (“Dec. on Inst.” or “Decision”) (listing those grounds raised by Petitioner) *with id.* at 14 (listing those claims and grounds that were included in the trial). Petitioner requests a rehearing of the denied ground. Paper 9 (“Req. Reh’g” or “Request”). Having considered Petitioner’s Request, we decline to modify our Decision.

A. Summary of Prior Decision

In our Decision, we determined that Petitioner had failed to show a reasonable likelihood that any claims of the ’482 patent were unpatentable over the proposed combination of Rucker (Ex. 1006) and Sheth (Ex. 1003). Dec. on Inst. 12–14. We found Petitioner’s assertion that, in the proposed combination, “*Sheth’s* autonomous agents then search the Web” insufficiently supported by factual evidence. *Id.* at 13. In particular, we noted that Sheth did not describe the capability of searching the Web but rather just newsgroups. *Id.* As background, we noted that Rucker also does not teach autonomous agents searching the Web. *See id.* at 11 (“Rucker [operates] without deriving semantic value from the contents of the URLs in the folders.”).

B. Applicable Standard of Review

An *inter partes* review may be instituted if it is determined that there is a “reasonable likelihood that the petitioner would prevail.” 35 U.S.C. § 314(a). When rehearing a decision on institution, the Board reviews the

decision for an abuse of discretion. 37 C.F.R. § 42.71(c). In pertinent part, 37 C.F.R. § 42.71(d) states:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

C. Analysis

Petitioner alleges that we made two errors in our Decision: (1) “to conclude that [the proposed combination] would allegedly have been inoperable”; and (2) for “refus[ing] to consider background references that expressly disclose the Web-searching technology the Decision found to be lacking.” Req. Reh’g 1–2. We address these two in turn.

1. Inoperability

Our Decision did not make any findings regarding the inoperability of the proposed combination. Instead, we simply pointed out the logical shortcomings of Petitioner’s ground. Petitioner described the proposed combination in its Petition as one where “*Sheth’s* autonomous agents then search the Web.” Pet. 41. Petitioner further stated that, “[u]nlike Ground 1, this combination searches the web instead of newsgroups.” *Id.* at 51.

As we pointed out in the Decision, however, *Sheth* contained no such teaching. Dec. on Inst. 13. Although Petitioner asserts that “*Rucker* teaches the use of search engines for discovering new pages” (Pet. 51, citing Ex. 1006, 3), this disclosure is directed to manual searching, outside of any recommendation system. Ex. 1006, 3 (“users must first arrive at sites or

pages by some other means [besides the recommendation system], such as a search service”); *see also id.* at 2 (“[t]he [recommendation] system does not derive any semantic value from the contents of the URLs”). That Web searching was known, in general, does not speak to Web searching by autonomous agents, a teaching that we determined in the Decision was not provided by Sheth. Dec. on Inst. 13.

In this light, our Decision was not commenting on the operability of the proposed combination, or whether one aspect of Sheth was incorporated into Rucker or not, but rather the fact that Petitioner’s articulated reason for combining the references relied on Sheth to teach searching the Web, but Sheth did not teach searching the Web. Dec. on Inst. 13. Regardless of whether the claims require such a feature or not, Petitioner’s theory for unpatentability was underpinned by a false premise. *See id.*

2. Background References

Petitioner alleges we did not consider properly certain “background references.” Req Reh’g 8–13. Petitioner here essentially asks us to review the evidence it brings and to put together our own explanation for how the cited references render obvious the claimed subject matter. This misunderstands the standard for institution of *inter partes* review, which requires *Petitioner* to articulate with specificity a ground that demonstrates a reasonable likelihood of success. *See* 37 C.F.R. §42.104(b). The standard is not for Petitioner to simply bring forward evidence and allege that the evidence demonstrates a reasonable likelihood of success in some unspecified way. The *particular theory and explanation* that Petitioner articulates in its Petition is critical. *See id.* § 42.104(b)(4).

As we explained in the Decision and reiterated above, the particular theory articulated by Petitioner was deficient in the Rucker/Sheth ground. *See* Dec. on Inst. 13. Petitioner argues that we should have considered the background references to fill in the gaps of Petitioner's theory. *See* Req Reh'g 9 ("The Petition raised several evidentiary sources showing that the allegedly missing background technology of Web searching was known and used in the art"). Even if references such as Moukas (Ex. 1012, not listed in any ground) filled in this gap, *arguendo*, it would not cure the 37 C.F.R. § 42.104(b) requirements for a petition because Petitioner did not assert a ground involving Moukas. It is one thing to use extrinsic evidence to explain the level of ordinary skill in the art; it is quite another to use that evidence as a significant component of the proposed obvious combination, as it would have been here, where the autonomous agent of Sheth would, under Petitioner's theory, need to be modified to include Web-searching capabilities. Again, the Petitioner must articulate fully the theory of unpatentability in the petition, not just present evidence.

Petitioner cites to *Randall Mfg. v. Rea*, 733 F.3d 1355 (Fed. Cir. 2013) in its Request in an attempt to show that we should go beyond the particular theory articulated by Petitioner and insert our own ground. Req Reh'g 11–13. *Randall* is inapplicable here. In *Randall*, the Federal Circuit vacated and remanded the Board's reversal of the examiner's rejection in an *inter partes* reexamination for "fail[ing] to account for critical background information [regarding the knowledge and perspective of a skilled artisan] that could easily explain why an ordinary skilled artisan would have been motivated to combine or modify the cited references." *Randall*, 733 F.3d at 1362. The background information here (e.g., Moukas), in contrast, would

not have been used to bolster a rationale for combination as was done in *Randall*, but rather to lend a particular structure (e.g., algorithm) to the combination. We decline in this case to institute based on a theory not clearly articulated in the Petition.¹

D. Conclusion

Having reviewed Petitioner's Request, we are not persuaded we abused our authority by denying review of the '482 patent as unpatentable over Rucker and Sheth.

II. ORDER

It is hereby ORDERED that Petitioner's Request for Rehearing is *denied*.

¹ We take no position as to whether we would have been permitted to do so.

IPR2015-00625
Patent 7,047,482 B1

PETITIONER:

Eliot Williams
Eliot.williams@bakerbotts.com

Harper Batts
Harper.batts@bakerbotts.com

PATENT OWNER:

Eugenio J. Torres-Oyola
etorres@ferraiuoli.com

Victor M. Rodriguez-Reyes
vrodriguezreyes@ferraiuoli.com