

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OLD REPUBLIC GENERAL INSURANCE GROUP, INC.; OLD
REPUBLIC INSURANCE COMPANY; OLD REPUBLIC TITLE
INSURANCE GROUP, INC.; and OLD REPUBLIC NATIONAL TITLE
INSURANCE COMPANY,
Petitioner,

v.

OWNER¹ OF U.S. PATENT NO. 6,519,581 B1²,
Patent Owner.

Case IPR2015-01956
Patent 6,519,581 B1

Before MEREDITH C. PETRAVICK, BEVERLY M. BUNTING, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

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

¹ The Federal Circuit determined that Intellectual Ventures I LLC is not the owner of U.S. Patent No. 6,519,581 B1 (“the ’581 patent”) because of a defective assignment in the chain of title. *Intellectual Ventures I LLC v. Erie Indem. Co.*, Case No. 2016-1128, 2017 WL 900018, at *1–*5 (Fed. Cir. Mar. 7, 2017). At the Federal Circuit, there was no dispute that AllAdvantage.com was the last known assignee of the ’581 patent. *Id.* After its agent for service of process was notified, AllAdvantage.com did not make an appearance as patent owner in these proceedings. See Ex. 3003.

² The caption for this proceeding has been changed to remove Intellectual Ventures I LLC as the Patent Owner. See Paper 38.

I. INTRODUCTION

Old Republic General Insurance Group, Inc.; Old Republic Insurance Company; Old Republic Title Insurance Group, Inc.; and Old Republic National Title Insurance Company (collectively “Petitioner”) filed a Petition on September 28, 2015, requesting an *inter partes* review of claims 1–10 and 20–38 of U.S. Patent No. 6,519,581 B1 (Ex. 1001, “the ’581 patent”). (Paper 1, “Pet.”). Petitioner supports its challenge with a Declaration from Dr. Michael Mitzenmacher (Ex. 1003) and a Reply (Paper 27, “Reply”). On April 18, 2016, we instituted an *inter partes* review of claims 1–10 and 20–38 of the ’581 patent. Paper 20 (“Dec. on Inst.”). An oral hearing was held on December 19, 2016, and a transcript of the oral hearing is of record. Paper 35 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Decision is a final written decision under 35 U.S.C. § 318(a) as to the patentability of the challenged claims. For the reasons that follow, we determine Petitioner has shown by a preponderance of the evidence that claims 1–10 and 20–38 of the ’581 patent are unpatentable.

A. *Related Proceedings*

Petitioner indicates that the ’581 patent is involved in the following United States District Court proceedings:

- *Intellectual Ventures I LLC v. Old Republic General Insurance Group, Inc.*, No. 2:14-cv-01130 (W.D. Pa.);
- *Intellectual Ventures I LLC v. Highmark, Inc.*, No. 2:14-cv-01131 (W.D. Pa.); and
- *Intellectual Ventures I LLC v. Erie Indemnity Co.*, No. 1:14-cv-00220 (W.D. Pa.).

Pet. 2. In these above-referenced cases, the district court dismissed Intellectual Ventures I LLC's ("IV") patent infringement claims based on the '581 patent for lack of standing. Ex. 1017, 24. IV appealed the district court's decision to the United States Court of Appeals for the Federal Circuit. *See Intellectual Ventures I LLC v. Erie Indem. Co.*, Case Nos. 2016-1128, -1129, -1132, 2017 WL 900018, at *1 (Fed. Cir. Mar. 7, 2017). On March 18, 2016, in email correspondence to the Board, Petitioner indicated that IV settled its matter with Highmark, Inc. Further, in Petitioner's updated mandatory notices, we are informed that the Federal Circuit issued a decision on March 7, 2017 in IV's consolidated Appeal Nos. 2016-1128, -1129, and -1132, affirming the district court's dismissal of IV's patent infringement suit against Petitioner based on a lack of standing. Paper 37, 1; *see Intellectual Ventures I LLC*, 2017 WL 900018, at *1–*5.

The '581 patent is also the subject of another *inter partes* review petition filed by Petitioner in IPR2015-01957.

B. Intellectual Ventures I LLC

During the course of this proceeding, IV has participated as the purported Patent Owner of the '581 patent. *See* Dec. on Inst. 3–6. IV has maintained that it is the patent owner of the '581 patent through a series of assignments including an assignment between AllAdvantage.com and Alset, Inc. ("the Alset Agreement"). *Id.* As discussed in greater detail in our Order (Paper 38) filed concurrently herewith, on March 7, 2017, the Federal Circuit affirmed a district court's dismissal of IV's patent infringement claims for lack of standing. In doing so, the Federal Circuit determined that the Alset Agreement did not convey any rights to the '581 patent. *Intellectual Ventures I LLC*, 2017 WL 900018, at *1–*5. IV has maintained

that it was entitled to ownership rights arising from a series of assignments after the Alset Agreement. *See* Ex. 1017, 5–24. However, because the Federal Circuit has determined that the Alset Agreement did not convey any rights to the '581 patent to Alset, Inc., we are not persuaded that IV received any ownership rights to the '581 patent from subsequent assignments. *See* Paper 38, 4–5; *see also* 37 C.F.R. § 3.54 (“[w]hen necessary, the Office will determine what effect a document has, including whether a party has the authority to take an action in a matter pending before the Office.”).

Accordingly, for the purposes of this Final Written Decision, we do not consider IV to be the Patent Owner of the '581 patent, and further do not consider the filings, arguments, and evidence submitted by IV in this record as the Patent Owner for this proceeding. Additionally, as discussed in greater detail in our Order, an agent for service of process for AllAdvantage.com was provided notice of this proceeding. Paper 38, 7–9. However, AllAdvantage.com has not made an appearance as Patent Owner in this proceeding, and has declined to participate in this *inter partes* review. Therefore, we proceed to Final Written Decision without a substitute Patent Owner.

C. The '581 Patent

The '581 patent is directed to systems and methods for collecting information about a computer system or user. Ex. 1001, Abstract. Figure 1 of the '581 patent is reproduced below.

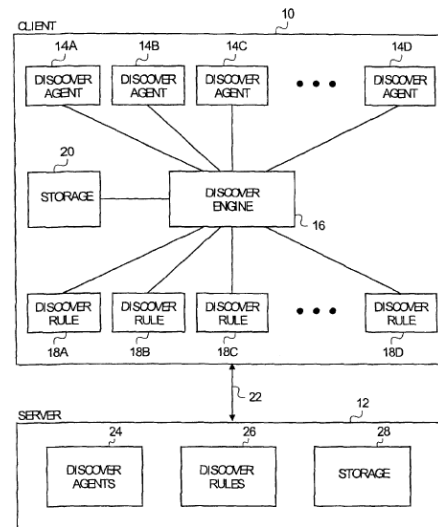


FIG. 1

Figure 1 shows client 10 coupled to server 12 via communication link 22, such as a local area network (LAN), a wide area network (WAN), or the Internet. Ex. 1001, 4:8–9, 5:19–25. As shown, client 10 may include one or more discovery agents 14a–d that are coupled to discovery engine 16. *Id.* at 4:10–14. Each of discovery agents 14a–d collects client and/or user information (e.g., hardware and software configurations of client 10 and the user’s interests), and communicates this information to discovery engine 16. *Id.* at 4:16–25. Discovery engine 16 receives information collected by one or more discovery agents 14a–d and uses the received data to execute one or more discovery rules 18a–d. *Id.* at 4:39–42. The discovery rules determine what, if any, action is to be taken based on the collected data. *Id.* at 3:17–18. Discovery rules may be a series of Boolean operations, mathematical equations, or other comparisons or evaluations of the collected data. *Id.* at 3:18–21. Discovery agents are separate programs from the discovery rules and there is no particular relationship between the discovery agents and the discovery rules. *Id.* at 3:22–25.

Figure 1 further shows server 12 as including discovery agents 24 and discovery rules 26. Ex. 1001, 5:25–26. Server 12 may store various discovery agents 24 and discovery rules 26 for transmission to one or more clients, which are then activated or executed by the discovery engine contained in the client. *Id.* at 5:30–33. Storage device 28 in server 12 can be used to store various information regarding the clients coupled to the server and the various discovery rules and discovery agents already installed on each client. *Id.* at 5:34–37.

The result of a particular discovery rule may store the received data, invoke another discovery rule, or combine the received data with previously stored data (e.g., performing data averaging). *Id.* at 4:50–53. The result may trigger one or more activities or events, or generate a warning to the user, e.g., that the available disk space or available memory on the user device falls below a particular threshold. *Id.* at 4:63–67.

D. Illustrative Claim

Of the challenged claims, claims 1, 20, and 29 are independent. Claim 1, reproduced below, is illustrative of the subject matter of the '581 patent:

1. A method of collecting information, the method comprising:
 - transmitting a discovery rule across a communication link to a computer system, wherein the discovery rule is to be applied to data about the computer system or a user to generate information, and wherein the data is collected by a discovery agent located in the computer system, and
 - receiving the information from the computer system.

E. Asserted Grounds of Unpatentability

We instituted an *inter partes* review of claims 1–10 and 20–38 on the following grounds of unpatentability under 35 U.S.C. § 103 (Dec. on Inst. 36):

Reference(s)	Basis	Claim(s) Challenged
Graf ³ and Desai ⁴	§ 103	1, 8–10, 29, and 36–38
Graf, Desai, and Wahlquist ⁵	§ 103	2–7, 20–28 and 30–35

II. ANALYSIS

A. Claim Construction

We construe claim terms of an unexpired patent according to their broadest reasonable interpretation in light of the patent specification. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016). Under the broadest reasonable interpretation standard, we assign claim terms their ordinary and customary meaning, as understood by one of ordinary skill in the art, in the context of the entire patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). “We have recognized ‘only two exceptions to this general rule: 1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution.’” *Unwired Planet, LLC v. Apple Inc.*, 829 F.3d 1353, 1358 (Fed. Cir. 2016) (citing *Thorner v. Sony Comput.*

³ U.S. Patent No. 5,619,656, issued Apr. 8, 1997 (Ex. 1005, “Graf”).

⁴ U.S. Patent No. 5,781,703, issued July 14, 1998 (Ex. 1006, “Desai”).

⁵ U.S. Patent No. 5,367,667, issued Nov. 22, 1994 (Ex. 1007, “Wahlquist”).

Entm't Am. LLC, 669 F.3d 1362, 1365 (Fed. Cir. 2012). Any special definition for a claim term must be set forth in the Specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

We determine that the following claim terms require explicit construction for purposes of this Final Written Decision. *See, e.g., Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) (“[C]laim terms need only be construed ‘to the extent necessary to resolve the controversy.’”) (citation omitted).

1. Discovery Agent (claims 1, 20, and 29)

For the purposes of the Decision on Institution, we adopted Petitioner’s proposed construction and construed the term “discovery agent” as “code that collects data.” Dec. on Inst. 10–12. In its Petition, Petitioner submits that one of ordinary skill in the art would understand the claim term “discovery agent” to mean “code that collects data.” Pet. 9.

Based on our review of the Specification of the ’581 patent, Petitioner’s arguments are persuasive. As Petitioner discerns, its proposed construction is consistent with the ’581 patent, which discloses that discovery agents are “implemented using individual programs or code sequences” and “[d]iscovery agents 14a-14d collect information about the client or the user of client 10.” Pet. 10 (citing Ex. 1001, 1:65–66, 3:7–10, 4:16–20; Ex. 1003 ¶¶ 79–80).

We note that the ’581 patent further discloses that the “discovery agents themselves have no intelligence regarding how to interpret or act on the collected data.” Ex. 1001, 3:10–12. Considering this description in the context of the ’581 patent as a whole, we do not consider this statement to

ascribe a special definition of “discovery agent” or a disavowal of claim scope. First, the literal language of the claims themselves does not expressly provide for individual programs or code, and the absence of intelligence. *See* Ex. 1001, Claims 1 and 29. Second, the ’581 patent, itself, states that the disclosed embodiments are not intended to limit the scope of the invention. Ex. 1001, 2:35–38, 2:64–3:1, 10:56–64. For example, the ’581 patent states, in the lines preceding lines 10 through 12 of column 3, that “those of ordinary skill in the art will appreciate that the invention may be practiced without these specific details.” Ex. 1001, 2:66–3:1. Additionally, the ’581 patent indicates that

it will be understood by those of ordinary skill in the art that the particular embodiments shown and described are for purposes of illustration only and are not intended to limit the scope of the invention. Those of ordinary skill in the art will recognize that the invention may be embodied in other specific forms without departing from its spirit or essential characteristics. References to details of particular embodiments are not intended to limit the scope of the claims.

Ex. 1001, 10:56–64.

Accordingly, for the purposes of this Decision, we construe the term “discovery agent” as “code that collects data.”

2. Other Claim Terms

Petitioner proposes additional constructions for “discovery rule” and “passively collects.” Pet. 8–11. On this record and for purposes of our Final Written Decision, we determine that no other claim terms need explicit construction. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy and only to the extent necessary to resolve the controversy.”).

B. Claims 1, 8–10, 29, and 36–38 — Asserted Obviousness over Graf (Ex. 1005) and Desai (Ex. 1006)

1. Summary of Graf (Ex. 1005)

Graf describes automated management of a group of computers and associated hardware and software. Ex. 1005, 10–13, Abstract (“The system and method of this invention automatically manages a group of computers by automatically gathering data, storing the data, analyzing the stored data to identify specified conditions, and initiating automated actions to respond to the detected conditions.”). Figure 1 of Graf is reproduced below.

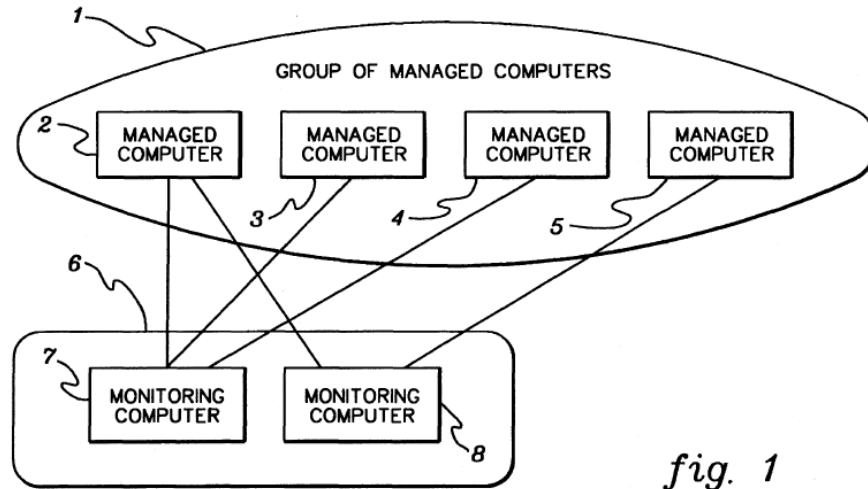


Figure 1 shows a group of managed computers 1 and a group of monitoring computers 6. *Id.* at 4:14–16, 27. The group of managed computers 2 includes computers 2–5 that may include CPU 9, disks 14, communications interface 16, and SYSTEMWatch AI-L client 13. *Id.* at 4:16–21. Data is gathered from and stored on a managed computer. *Id.* at 4:22–24. Graf teaches that a managed computer may send data to a monitoring computer 8,

shown in Figure 1 as part of the group of monitoring computers 6. *Id.* at 4:23–26.

Graf further teaches that the group of monitoring computers 6 includes computers that may have a CPU, memory, disks, communications interface, and SYSTEMWatch AI-L console 21. *Id.* at 4:27–31. Graf further provides that a monitoring computer may request data from a managed computer, and data that is received by the monitoring computer from the managed computer is stored on the monitoring computer. *Id.* at 4:33–39. Graf also teaches that a monitoring computer can receive data from several managed computers, and the monitoring computer can perform post-processing on data received from several managed computers and/or perform additional data gathering itself, in which case the data is stored on the monitoring computer. *Id.* at 4:39–45.

Additionally, Graf discloses that the SYSTEMWatch AI-L client provides a means for the computer to automatically detect and respond to problems. *Id.* at 4:61–64. Graf provides that the SYSTEMWatch AI-L client also accepts and responds to commands issued by a SYSTEMWatch console. *Id.* at 4:64–67. Graf adds that a computer is a managed computer if it runs the SYSTEMWatch AI-L client, and a computer is a monitoring computer if it runs the SYSTEMWatch AI-L console. *Id.* at 4:61–63, 5:1–3. Graf further teaches that the SYSTEMWatch AI-L client is tasked with managing a computer and providing notification of management actions to the SYSTEMWatch AI-L console. *Id.* at 5:39–41. Graf provides that the SYSTEMWatch AI-L client is bifurcated into a “core layer” for detecting and responding to problems, and an “application layer” that configures the client to operate in a useful manner. *Id.* at 5:45–49. The core layer includes

a database for storing gathered data, intermediate results, and other information. *Id.* at 5:65–67. The core layer further includes an expert system that is used for problem detection and action initiation. *Id.* at 7:53–54.

Graf further discloses that the expert system is a forward chaining rule based expert system using a rule specificity algorithm. *Id.* at 7:55–56. When SYSTEMWatch AI-L client, 13, is started, the expert system contains no rules. *Id.* at 7:56–57. Rules are declared and incorporated into the core layer. Rules support both the IF-THEN rules as well as IF-THEN-ELSE rules. *Id.* at 7:58–60. The rules used in SYSTEMWatch AI-L permit assignments and function calls within the condition of the rule. *Id.* at 7:60–62.

2. Summary of Desai (Ex. 1006)

Desai discloses a network monitoring system that includes an intelligent remote agent for collecting performance data on the agent's associated computer. Ex. 1006, Abstract. Figure 1 of Desai is reproduced below.

FIG. 1

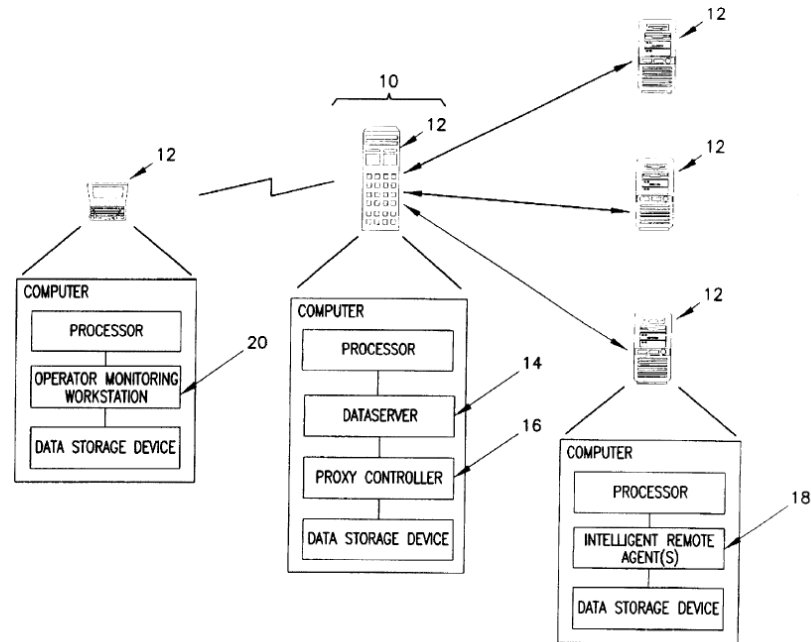


Figure 1 shows network monitoring system 10 that includes a plurality of interconnected computer systems 12. *Id.* at 2:45–52. Referring to Figure 1, Desai teaches that Intelligent Remote Agents 18 communicate with Proxy Controller 16, and through it to Data Server 14, for the collection of performance data from the computer systems 12. *Id.* at 3:66–4:2. Intelligent Remote Agent 18 receives commands from Proxy Controller 16 associated with Data Server 14, and in response to such commands, Intelligent Remote Agent 18 initiates data collection operations on its respective computer system 12 and then returns the collected data to Proxy Controller 16 for forwarding to Data Server 14. *Id.* at 4:5–11.

Desai further teaches that there are two ways to collect performance data from Intelligent Remote Agents 18: (1) transmitting commands for a situation monitoring request to a particular Intelligent Remote Agent 18 on a particular computer system 12; or (2) transmitting commands for a report request to a particular Intelligent Remote Agent 18 on a particular computer

system 12. Ex. 1006, 5:66–6:5. In both cases, the commands are transmitted from the Proxy Controller 16 to the Intelligent Remote Agent 18 and the response is returned by the Intelligent Remote Agent 18 to the Proxy Controller 16 and Data Server 14. *Id.* at 6:5–9.

Desai adds that Data Server 14 may include predefined automatically initiated situation monitoring requests that are transmitted to Proxy Controller 16 upon initialization of Data Server 14 and Proxy Controller 18. Ex. 1006, 6:10–13. Proxy Controller 16 analyzes the situation monitoring request extracts predicates and sampling intervals or event occurrences therefrom and generates one or more command sequences for Intelligent Remote Agents 18. *Id.* at 6:13–17. The predicates, which are analogous to SQL predicates, indicate the specific items of performance data to be collected. *Id.* at 6:18–19. The sampling intervals, which are analogous to timers, indicate the specific time periods for collecting the items of performance data. *Id.* at 6:19–22. The event occurrences, which are analogous to interrupts, indicate the specific event indication or occurrence that triggers the collection of performance data. *Id.* at 6:22–24. The command sequences are then transmitted to the specified Intelligent Remote Agents 18. *Id.* at 6:24–26.

Intelligent Remote Agent 18 collects the desired data at the specified sampling interval or event occurrence and determines whether the collected data satisfies any of the situation predicates. Ex. 1006, 6:43–46. Any collected data that satisfies the situation predicates is returned to Proxy Controller 16 and is then transmitted to Data Server 14 for storage. *Id.* at 6:46–48.

3. *Analysis*

Petitioner challenges claims 1, 8–10, 29, and 36–38 under 35 U.S.C. § 103 based on Graf and Desai. Pet. 45–49. For this challenge, Petitioner relies on unpatentability arguments it presents earlier in its Petition based on Graf alone pursuant to 35 U.S.C. §§ 102 and 103. *See id.* We have considered the arguments and evidence presented, and are persuaded that Petitioner has shown by a preponderance of the evidence that claims 1, 8–10, 29, and 36–38 are unpatentable over Graf and Desai.

a. Claims 1 and 29

With respect to claims 1 and 29, we discuss independent claim 1 below, which also is illustrative of the subject matter claimed in independent claim 29.

Claim 1 is directed to a method of collecting information that includes the step of “transmitting a discovery rule across a communication link to a computer system.”

For this limitation, Petitioner asserts that Graf discloses a “communication link to a computer system,” as recited in claim 1, because a group of managed computers are shown linked to a group of monitoring computers over a network. Pet. 18 (citing Ex. 1005, Fig. 1). Petitioner further asserts that Graf describes the use of a “modem using a telecommunications network” as an example of a communication means between all the computers on the network. *Id.* (citing Ex. 1005 at 4:54–57). Petitioner further relies on the testimony of its declarant, Dr. Mitzenmacher, which provides that computers communicating over a computer network or via a modem necessarily employ a “communication link” in order to carry out the communication. Pet. 18 (citing Ex. 1003 ¶ 116).

Petitioner further asserts Graf discloses a “discovery rule” because Graf describes a rule based expert system in the core layer of the SYSTEMWatch AI-L client that contains several rules, including an “EXCEPT” rule used to perform problem detection and action initiation based on data collected by the “DATA2” and “DATA” rules. Pet. 16–17 (citing Ex. 1005, 7:52–61, 8:40–54, 53:7–13).

Additionally, Petitioner argues that Desai teaches “transmitting a discovery rule across a communication link to a computer system,” because Desai’s remote agents receive commands to collect performance data, which include “predicates” against which the collected data is to be tested. Pet. 46; Ex. 1006, 6:17–19, 43:46. Petitioner asserts that Desai’s predicates are “discovery rules” that are transmitted to a user computer system across Desai’s computer network. Pet. 46 (citing Ex. 1006, 2:2–57, 5:65–6:9–46; and Fig. 1).

Petitioner further argues that it would have been obvious to one of ordinary skill in the art to “combine the rule-transmission functionality of Desai with the system of Graf in order to install the rule files disclosed in Graf onto the managed computers to ‘respond to additional problems.’” Pet. 47 (citing Ex. 1005 at 12:9–11). Petitioner asserts that a skilled artisan “would have been motivated to employ such a combination given the efficiency that such a method would have provided to the Graf system administrator in installing the rule files on remote managed computers.” *Id.* at 47 (citing Ex. 1005, 4:21–22). Petitioner adds that Desai teaches “the transmission of discovery rules over computer or telecommunications networks, for the purpose of monitoring a remote computer, was known (see, e.g., Ex. 1006 at 1:23–27), so to employ such functionality in Graf

would have been the use of a known technique for its ordinary purpose, achieving a predictable result [with a reasonable expectation of success]. Ex. 1003 at ¶ 130.” *Id.* at 47 (citing Ex. 1006 at 2:2–11, 2:45–57, 5:65–6:9).

Petitioner’s arguments and evidence discussed above are persuasive. As Petitioner observes, Graf teaches that the SYSTEMWatch AI-L includes a communication mechanism in the core layer that is based on mailboxes. Ex. 1005, 10:28–31. Graf further provides that the mailboxes allow a SYSTEMWatch AI-L client and a SYSTEMWatch AI-L console to deliver and receive messages/files from one another. *Id.* at 10:33–36. Graf also discloses that the communication mechanism can operate a communication daemon through which messages between modules are passed. *Id.* at 10:40–47. Graf does not disclose explicitly that a discovery rule is transmitted over the communication mechanism. *See* Pet. 46 (“To the extent one might argue that this claim element is not disclosed or suggested by Graf, the claim as a whole would still have been obvious because Desai does disclose this functionality and its combination with Graf would have been obvious.”). Nonetheless, we agree with Petitioner that Graf contemplated that its described system would manage “1 to several thousand” computers, (Ex. 1005, 4:21–22), and that in doing so “additional problems” would arise, requiring a system administrator to “add additional modules to detect, analyze, and respond to additional problems,” (*id.* at 12:9–12).

With this in mind, we are further persuaded that Petitioner has offered sufficient articulated reasoning with rational underpinnings to support the conclusion of obviousness. In particular, we find persuasive Petitioner’s explanation that a skilled artisan would have considered it more efficient to utilize Graf’s existing communication mechanism to deliver rules or files,

especially in light of Desai's teaching that rules in the form of commands and predicates are transmitted to remote agents. *See* Pet. 47. For example, referring to Figure 1, Desai teaches Data Server 14 collects and stores performance data from one or more computer systems 12 in network 10. Ex. 1006, 3:13–14. Desai further provides that in operation,

Data Server 14 may include predefined, automatically-initiated, situation monitoring requests that are transmitted to the Proxy Controller 18 upon initialization of Data Server 14 and the Proxy Controller 16. The Proxy Controller 16 analyzes the situation monitoring request, extracts predicates and sampling intervals or event occurrences therefrom, and generates one or more command sequences for the Intelligent Remote Agents 18. . . . *The command sequences are then transmitted to the specified Intelligent Remote Agents 18.*

Ex. 1006, 6:10–26 (emphasis added). Desai further teaches that the “Intelligent Remote Agents receive commands instructing them to collect performance data on the Agent's associated computer system ‘wherein the commands comprise predicates for filtering the performance data.’” Ex. 1006, 2:6–10. Thus, we are persuaded that Petitioner has met its burden of showing, through Petitioner's submitted explanations and evidence, that Graf and Desai teach “transmitting a discovery rule across a communication link to a computer system” as recited in claim 1.

Claim 1 further includes the limitation: “wherein the discovery rule is to be applied to data about the computer system or a user to generate information.” Petitioner argues Graf teaches this limitation because (1) DATA2 rules generate information using the raw data gathered by the DATA rules; and (2) EXCEPT rules apply their conditions to collected data

to determine what, if any, action should be taken. Pet. 17, 21–22 (citing Ex. 1005, 8:39–47, 53:7–13).

Petitioner’s arguments and evidence are persuasive. In particular, we note Graf discloses that a DATA state is assigned to rules which gather raw data from the computer system; a DATA2 state is assigned to rules that perform computations based on data collected by the rules in the DATA state; and the EXCEPT state is assigned to rules that perform problem detection and action initiation. Ex. 1001, 8:30–57. This disclosure is consistent with Petitioner’s position that Graf’s DATA2 or EXCEPT state rules teach or suggest discovery rules that are applied to data about the computer system to generate information. See Pet. 21 (“The DATA2 rules of Graf generate information about a given computer system by computing intermediate data using the raw data gathered by the lower level DATA rules [, and] ‘EXCEPT’ discovery rules are also applied to the DATA or DATA2 generated information to generate additional information about the managed computer, such as an alert.”) (citing Ex. 1005, 8:39–47, 8:52–54).

Additionally, Claim 1 also requires “wherein the data is collected by a discovery agent located in the computer system.”

For this limitation, Petitioner argues that the SYSTEMWatch AI-L client program is a “discovery agent” because Graf describes it as a separate program that collects data and runs on a managed computer. Pet. 22–23 (citing Ex. 1005, 3:15–25, 4:33–36, 4:58–63, 5:38–41, 5:65–67, and 10:64–67). As an example of data collection, Petitioner refers to Graf’s teaching that the SYSTEMWatch AI-L client includes a DATA rule that causes the client to collect data. *Id.* at 23 (citing Ex. 1005, 8:30–58).

Petitioner's argument is consistent with Graf's distinction between a SYSTEMWatch AI-L client and a SYSTEMWatch AI-L console, whereby the SYSTEMWatch AI-L client is run on a managed computer to provide the managed computer with a means to automatically detect and respond to problems. Ex. 1005, 4:58–67. Further, Graf teaches that the core layer of the SYSTEMWatch AI-L client contains an “expert system” with DATA state rules that “gather raw data from the computer system.” Ex. 1005, 7:52–54, 8:29–31. Thus, we are persuaded that Petitioner has explained sufficiently how Graf discloses this limitation.

Claim 1 further recites the step of “receiving the information from the computer system.” Petitioner asserts that Graf teaches that the monitoring computer receives the generated information sent to it by the managed computers. Pet. 23 (citing Ex. 1005, 4:37–45).

We agree with Petitioner's argument above because Graf provides that “[a] monitoring computer can also explicitly request data from a managed computer. Data which is received by a monitoring computer from a managed computer is stored on the monitoring computer.” Ex. 1005, 4:36–39.

Accordingly, we determine that Petitioner has shown by a preponderance of the evidence that claim 1 of the '581 patent is unpatentable over Graf and Desai. We also have reviewed Petitioner's analysis and supporting evidence with respect to independent claim 29, which rely largely on Petitioner's arguments presented for claim 1. Pet. 31–32, 46–48. For the same reasons discussed above, we are persuaded Petitioner has shown by a preponderance of the evidence that claim 29 of the '581 patent is unpatentable over Graf and Desai.

b. Claims 8–10 and 36–38

Petitioner further asserts that claims 8 and 36 of the '581 patent are unpatentable over Graf and Desai. Claim 8 depends from independent claim 1, and claim 36 depends from independent claim 29. Claims 8 and 36 both recite “wherein the discovery agent is activated to collect the data when the discovery rule requires the data.” For these limitations, Petitioner relies on Graf’s disclosure of “schedule” and “processUpdate2” rules as “discovery rules” that require the SYSTEMWatch AI-L client to collect data. Pet. 28–29 (citing Ex. 1005, Table 28–29).

These arguments are persuasive. Graf’s Table 29 contains the DATA state “processUpdate2” rule that has the condition: “If the system load is above the load, or if there are processes being scheduled in a % CPU window.” Ex. 1005, Table 29. If the condition for the “processUpdate2” rule is met, the “getProcessInfo” routine is called, which “[w]alks through the kernel process table to get process information about each process on the system, and stores the same into the SYSTEMWatch AI-L database.” *Id.* at Tables 28–29.

Additionally, Petitioner challenges the patentability of claims 9 and 37, which depend from claim 1 and 29 respectively. Claims 9 and 37 both recite “wherein the discovery agent is activated to collect the data according to a schedule.” For these limitations, Petitioner asserts that Graf describes an “event” program that allows the SYSTEMWatch AI-L “to execute functions either at specified times or periodically.” Pet. 30 (citing Ex. 1005, 15:34–39). Petitioner further asserts that the event program includes an “addEvent” routine that takes as input a function name, a time period, and an optional repetition factor. Pet. 30 (citing Ex. 1005, Table 8). Petitioner

reasons that this event program causes the SYSTEMWatch AI-L client to execute an identified function “according to a schedule,” and that function could include collection of data (e.g., `getProcessInfo`). Pet. 30 (citing Ex. 1005, Table 28; Ex. 1003 ¶ 213).

We agree with Petitioner’s arguments and evidence as these are consistent with our understanding of Graf’s disclosure. In particular, Graf teaches the “`addEvent`” program “schedules SYSTEMWatch AI-L to execute the function named at a time equal to the present time plus the time period. If the optional repetition factor is given, the function is scheduled that many times, each time differing from the previous event time by the time period.” Ex. 1005, Table 8. Graf further teaches functions/routines that collect data such as “`getSysLoad`,” which “[g]ets the system load average over the last minute, 5 minutes, and 15 minutes and store the same in the SYSTEMWatch AI-L database.” *Id.* at Table 28. With regard to this disclosure, we credit the testimony of Dr. Mitzenmacher, who testifies that one of ordinary skill in the art would understand that “Graf’s event program could be used with Graf’s data collection functions” because Graf discloses various functions/routines that cause the SYSTEMWatch AI-L client to collect data. Ex. 1003 ¶ 213 (citing Ex. 1005, Table 28 (“`unscheduleProc`,” “`schedCheckProc`,” “`schedPrcoess`,” “`getProcessInfo`,” “`getSysLoad`,” “`computeCPUPerc1`” and “`computeCPUPerc2`” functions)). In this regard, Dr. Mitzenmacher’s testimony comports with the disclosure in Graf, which teaches routines/functions that collect data, and an event program that executes a scheduled function. *See id.* (citing Ex. 1005, Tables 8, 28).

Petitioner also challenges the patentability of claims 10 and 38, which depend from claim 1 and 29 respectively. Claims 10 and 38 both recite

“wherein the discovery agent passively collects the data.” Petitioner asserts that Graf describes that the SYSTEMWatch AI-L client automatically collects data upon system initialization, and, when an event program is triggered periodically to collect data. Pet. 30–31 (citing Ex. 1005, 15:34–39, 53:7–14; Ex. 1003 ¶¶ 216–217).

We agree with Petitioner’s position. As discussed above, Graf “addEvent” program schedules the SYSTEMWatch AI-L to execute a named function, which we are persuaded, includes the “getSysLoad” function that “[g]ets the system load average over the last minute, 5 minutes, and 15 minutes and store the same in the SYSTEMWatch AI-L database.” Ex. 1005, Table 28.

Accordingly, we are persuaded that Petitioner has shown by a preponderance of the evidence that claims 8–10 and 36–38 are unpatentable over Graf and Desai.

C. Claims 2–7, 20–28, and 30–35 — Asserted Obviousness over Graf, Desai, and Wahlquist (Ex. 1007)

1. Summary of Wahlquist (Ex. 1007)

Wahlquist discloses a system for performing computer diagnostic tests on personal computers. Ex. 1007, 1:7–11. In Wahlquist, a user calls the customer service help desk and the call is routed to a customer service representative, who then selects various diagnostic tests from a menu to be run on the user’s computer. *Id.* at 2:8–19. The representative can specify the number of times each test is to be performed, as well as the name of log files to be created when running the tests. *Id.* at 2:19–22. The test selection information is used to build a high-level instruction or script file. The script file is associated with the case file by a database manager application. *Id.* at

2:22–25. The help desk representative then instructs the user, upon completion of the telephone call, to insert a diagnostic disk, supplied to the user upon purchase of the computer, into the computer and initiate a program that places the user computer's modem in an auto answer mode. The help desk representative then terminates the call. *Id.* at 2:25–31.

The representative then submits the case and script files to the database manager, which creates a service job. *Id.* at 2:32–34. The database manager then schedules the job to be acted on by a communications link manager application. *Id.* at 2:34–35. The link manager application dials the user's modem number, which is in the case file, and establishes communications with the user's system. *Id.* at 2:36–38. The link manager then downloads the case and script files to the user's computer. The user computer then terminates communications with the link manager. *Id.* at 2:38–41.

The diagnostic program running on the user's computer then initiates execution of the script file. *Id.* at 2:42–43. The script file instructs the computer to execute selected test files resident on the user's diagnostic disk. *Id.* at 2:43–45. The script file also specifies the creation of various log files that record the results of the tests. *Id.* at 2:45–47. Upon completion of all of the test programs specified in the script file, the diagnostic program will cause the user's computer to reset. *Id.* at 2:47–49. Following reset, the diagnostic program will instruct the user's computer to dial the link manager task using the modem number provided in the case file. *Id.* at 2:50–52. Upon establishment of communications, the user's computer transmits the case, script and newly created log files to the link manager. *Id.* at 2:59–60. The representative may then call up the case, script and data files and

examine the results of the diagnostic tests to determine the nature of the user computer's problem. *Id.* at 3:1–3.

2. Analysis

Petitioner challenges claims 2–7, 20–28, and 30–35 under 35 U.S.C. § 103 based on Graf, Desai, and Wahlquist. Pet. 49–60. For this challenge, Petitioner relies on unpatentability arguments it presents earlier in its Petition based on Graf alone and in combination with Desai. *See id.* We have considered the arguments and evidence presented, and are persuaded that Petitioner has shown by a preponderance of the evidence that claims 2–7, 20–28, and 30–35 are unpatentable over Graf, Desai, and Wahlquist.

a. Claims 2 and 30

Claim 2 depends from claim 1 and further requires the step of “receiving a user request prior to transmitting the discovery rule and wherein the transmitting the discovery rule is without requiring action by the user.” Claim 30 depends from claim 29, and recites “further including additional sequences of executable instructions, which when executed by the processor further cause the system to *receive a user request prior to transmitting the discovery rule and wherein the transmitting the discovery rule is without requiring action by the user.*” Emphasis added.

For these limitations, Petitioner argues that Wahlquist describes a system that includes the assistance of a help desk representative who may receive a user request regarding a user's computer, and that in response to the user's request, the help desk representative creates a script file that is sent automatically to the user's computer when a connection is established between the server and the user's computer. Pet. 50 (citing Ex. 1007, 2:8–23, 2:32–40, 5:37–6:3). Petitioner further asserts that once the script file is

on the user's computer, diagnostic tests are run, which generates diagnostic log files that can be sent back to the representative. Pet. 50–51 (citing Ex. 1007, 2:59–68).

Petitioner argues that it would have been obvious to “combine the semi-automatic help desk functionality of Wahlquist (in order to transmit and receive discovery rules in response to user requests) with the automated system of Graf in order to provide another mechanism (beyond the automated approach of Graf) to respond to user problems and concerns.” Pet. 51. Petitioner reasons that Graf “recognizes this motivation by its disclosure of semi-automatic functionality by which the system administrator can send commands to the managed computers (Ex. 1005 at 54:43-56:51), and by its disclosure of functionality assigning an ‘owner’ to a problem so that it might be resolved ‘manually’. Ex. 1005 at 21:37-44.” *Id.* Furthermore, Petitioner argues that a skilled artisan would have combined Wahlquist's automatic transmission of diagnostic log file with Graf's system as an additional automatic operation for Graf's system. Pet. 53.

We find persuasive Petitioner's reasoning that it would have been obvious to combine Wahlquist's semi-automatic help desk functionality with the automated system of Graf in order to provide another mechanism in Graf for responding to user problems and concerns. Although Graf teaches a system and method for *automatically* managing a group of computers (Ex. 1005, Abstract), Graf nevertheless describes embodiments that include the assistance of a system administrator as part of the described system. For example, Graf teaches “if the system administrator wanted to add additional modules to detect, analyze, and respond to additional problems, he need only . . . modify the application layer to read his program(s) before the

SYSTEMWatch AI-L client reads the ruleinit program.” Ex. 1005, 12:9–16. Further, Graf teaches that when a problem is detected by the SYSTEMWatch AI-L and the SYSTEMWatch AI-L client “*is not configured to automatically* respond to a problem, the system administrator can use the SYSTEMWatch AI-L console to command a particular SYSTEMWatch AI-L client to perform an action in response to a detected problem.” Ex. 1005, 49:41–50:35 (emphasis added). For example, as Petitioner points out (Pet. 51 (citing Ex. 1005, 54:43–56:51)), Graf describes semi-automatic functionality where the system administrator may use the SYSTEMWatch AI-L send facility to

tell a SYSTEMWatch AI-L client to initiate a specific action, specifying the SYSTEMWatch AI-L client and optional parameters implicitly by referencing an alert reference number:

syntax: send act <action name> <alert reference number>

example: send act fsrecom 2

will cause the SYSTEMWatch AI-L client which posted the alert which the local console has assigned reference number 2 to initiate a fsrecom action on the file system which developed the problem that cause that SYSTEMWatch AI-L client to post the alert.

Ex. 1005, 55:15–28. Thus, we find that Petitioner has offered sufficient articulated reasoning with rational underpinnings to support the conclusion of obviousness based on this asserted combination. In particular, we agree with Petitioner’s position that Graf also discloses semi-automatic operability, and that this disclosure “itself motivates the use of semiautomatic help desk functionality, such as that of Wahlquist, in the system of Graf.” Pet. 52 (citing Ex. 1003 ¶ 162).

Moreover, we are credit Dr. Mitzenmacher’s testimony that

one of ordinary skill in the art would have been motivated by Graf's disclosure that the SYSTEMWatch AI-L system is to perform "automatic actions based on the identified computer conditions." Ex. 1005 at 3:15-25. Incorporation of the Wahlquist teaching to download the script file or test programs automatically without requiring action by the user would have yielded predictable and desirable results across the two systems. Ex. 1003 ¶ 171. Dr. Mitzenmacher's testimony is consistent with Graf's disclosure of the SYSTEMWatch AI-L client that relies primarily on automated actions. Ex. 1005, 3:5-25.

Accordingly, we determine that Petitioner has shown by a preponderance of the evidence that claims 2 and 30 are unpatentable over Graf, Desai, and Wahlquist.

b. Claim 20

Claim 20 is directed to a method of collecting information that includes the steps of "receiving a user request regarding the computer system" and "providing the user with a response to the user request."

For these limitations, Petitioner relies on the arguments presented for claim 2, discussed above. Pet. 59-60. For the same reasons discussed above, we are persuaded by Petitioner's position that the proposed teachings of Graf, Desai, and Wahlquist satisfy these limitations.

Additionally, claim 20 requires the steps of:

transmitting a discovery rule across a communication link to a computer system, wherein the discovery rule is to be applied to data about the computer system or a user to generate information, and wherein the data is collected by a discovery agent located in the computer system when the discovery agent is actuated and without requiring action by the user; [and]

receiving the information from the computer system.

For these limitations, Petitioner relies on arguments discussed above for similar limitations recited in claims 1 and 29 (e.g., “discovery agent” and “transmitting” step) based on the combination of Graf and Desai. *See* Pet. 46–48, 59–60; *see also* Prelim. Resp. 25–27. For the same reasons discussed above for claims 1 and 29, we are persuaded that Petitioner’s rationale for combining the teachings of Graf and Desai suffices as an articulated reasoning with a rational underpinning to justify the legal conclusion of obviousness. In particular, Petitioner argues, and we agree, that a skilled artisan would have considered it more efficient to utilize Graf’s existing communication mechanism to deliver rules or files, especially in light of Desai’s teaching that rules in the form of commands and predicates are transmitted to remote agents. *See* Pet. 47.

Accordingly, we have considered the arguments and evidence presented, and are persuaded that Petitioner has shown by a preponderance of the evidence that claim 20 is unpatentable over the combination of Graf, Desai, and Wahlquist.

*a. Claims 3, 21, and 31*⁶

With respect to dependent claims 3, 21, and 31, these claims additionally require “wherein the user request is for assistance regarding the computer system.” Ex. 1001, 11:11–12, 12:11–12, 12:50–52. Petitioner argues that Wahlquist discloses a user request for assistance with a managed computer system, and that it would have been obvious to combine this

⁶ We note that the Petition does not present an analysis for grounds based on Graf alone or on Graf and Desai for its challenge to claims 3, 21, and 31. However, the Petition addresses these claims under the ground based on Graf, Desai, and Wahlquist. Pet. 53.

feature disclosed in Wahlquist with the Graf system. Pet. 53–54 (citing Ex. 1007, 2:5–16; Ex. 1003 ¶ 175). Petitioner relies on arguments and evidence presented with respect to claims 2 and 30, which recite a similar limitation: “receiving ‘a user request prior to transmitting the discovery rule.’” Pet. 50–53. For the same reasons discussed with regard to claims 2 and 30, we find persuasive Petitioner’s position that one of ordinary skill in the art would have combined Wahlquist’s semi-automatic help desk functionality with Graf’s system to provide “another mechanism (beyond the automated approach of Graf) to respond to user problems and concerns”). *See supra* Sect. II. C(2)(a); *see also* Pet. 51. Thus, we determine that Petitioner has shown by a preponderance of the evidence that claims 3, 21, and 31 are unpatentable over Graf, Desai, and Wahlquist.

b. Claims 4, 23, and 32

Claims 4, 23, and 32 require “wherein the transmitting of the discovery rule is from a remote individual receiving the user request.” Petitioner relies on Wahlquist’s disclosure of a help desk representative who sends the script file (and, possibly test programs) to the user’s computer after receiving the user request. Pet. 54 (citing Ex. 1007, 2:8–40; 55:66–6:3). For these claims, Petitioner’s position is persuasive. Wahlquist describes a “method for performing *remote* diagnostics on a personal computer system in which the user calls a help desk representative.” Ex. 1007, Abstract (emphasis added). Further, in one embodiment, Wahlquist provides that “the preferred embodiment permits the help desk representative R to perform remote batch diagnostic tests on the user computer.” *Id.* at 10:23–25. Thus, we determine that Petitioner has shown by a preponderance of the evidence that claims 4, 23, and 32 are unpatentable over Graf, Desai, and

Wahlquist.

c. Claims 5, 22, and 33

Claims 5 and 22 recite “providing assistance to the user regarding the computer system after receiving the information.” Similarly, claim 33 requires executable instruction that “cause the system to provide assistance to the user regarding the computer system after receiving the information.” For these limitations, we agree with Petitioner that Wahlquist discloses performing diagnostic tests on a user’s computer with script files and test programs, the results of which are sent back to a help desk representative who provides assistance to the user regarding the user’s computer. Pet. 54–55 (citing Ex. 1007, 2:41–47, 2:59–68, 3:1–9, 5:66–6:3; and Ex. 1003 ¶ 188). Accordingly, we are persuaded that Petitioner has shown by a preponderance of the evidence that claims 5, 22, and 33 are unpatentable over Graf, Desai, and Wahlquist.

d. Claims 6, 24, and 34

Below we discuss claim 6, which is illustrative of similar limitations recited in claims 24 and 34.

Claim 6 depends from claim 1, and further recites “wherein the discovery rule is transmitted automatically when the computer system establishes a connection with a server.”

Petitioner argues that Wahlquist discloses a script file (i.e., discovery rule) that is sent to the customer support system for automatic transmission to a user’s computer. Pet. 55. Petitioner adds that, in Wahlquist, the user’s computer establishes a connection with the customer support system when it accepts a call and identifies itself to a link manager computer. *Id.* Further, Petitioner asserts that one of ordinary skill in the art would have been

motivated to employ the “automatic transmission” functionality of Wahlquist in Graf’s system because “Graf is directed to the use of automatic operations, so a person of skill would have been motivated to [add] additional automatic operations previously used in analogous systems.” Pet. 56 (citing Ex. 1003 ¶ 199).

Looking to the reference, Wahlquist discloses that in response to a user request (Ex. 1007 at 2:8–16), the help desk representative creates a script file (*id.* at 2:17–23) and submits the script file (*id.* at 5:66–6:3) to the customer support system for automatic transmission to the user’s computer (*id.* at 2:32–40). Further, Wahlquist teaches that the user’s computer downloads the script file from a database manager computer through a link manager computer after the user’s computer establishes a connection with the link manager computer and verifies itself using an identification code. *Id.* at Ex. 1007, 5:37–66. Moreover, Dr. Mitzenmacher testified that

a person of ordinary skill would have been motivated by the disclosure of Graf to incorporate the [Wahlquist] teaching to transmit the script file automatically when the user’s computer system establishes a connection in order to gain the benefit of such automatic functionality. Moreover, to employ such functionality in the system of Graf would have been only the use of a known technique, already used to improve the system of [Wahlquist], for its known purposes. And that use would have achieved merely the predictable result of efficiently transmitting the new discovery rule to the managed computer.

Ex. 1003 ¶ 199. We credit Dr. Mitzenmacher’s testimony because it is consistent with Graf’s description of the automatic operation of the SYSTEMWatch AI-L “which automatically manages at least one computer.” Ex. 1005, 3:19–20.

Accordingly, we determine that Petitioner has shown by a

preponderance of the evidence that claims 6, 24, and 34 are unpatentable over the combination of Graf, Desai, and Wahlquist.

e. Claims 7, 25, and 35

Below we discuss claim 7, which is illustrative of similar limitations recited in claims 25 and 35.

Claim 7 depends from claim 1, and further recites “transmitting the discovery agent across the communication link to the computer system and the discovery agent and discovery rule are separate code sequences.”

Petitioner argues that Graf discloses the SYSTEMWatch AI-L client program causes the client computer to read the file containing rules, which Petitioner argues a person of skill would understand to mean that the SYSTEMWatch AI-L client program and the files were not the same code sequence. Pet. 38 (citing Ex. 1005, 11:13–16; Ex. 1003 ¶ 202). Petitioner acknowledges that Graf does not explicitly disclose transmission of the discovery agent across the communication link to the computer system, but that Wahlquist discloses the transmission of executable script files and test files, and that transmission of executable code in Graf such as a “discovery agent” would have yielded predictable results based on Wahlquist’s disclosure and improved efficiency of Graf’s system. Pet. 39–40.

We find for the reasons stated in the Petition that the asserted combination of the disclosure in Wahlquist and Graf regarding the transmission of executable files and code satisfies the limitation of “transmitting the discovery agent across the communication link to the computer system and the discovery agent and discovery rule are separate code sequences.” First, we credit Dr. Mitzenmacher’s testimony that “Graf consistently describes and depicts the client program as separate from the

rules or the files containing the rules.” Ex. 1003 ¶ 202. This testimony is consistent with Graf’s teaching that (1) the SYSTEMWatch AI-L client is distinct from the managed computer and SYSTEMWatch AI-L console; and (2) the SYSTEMWatch AI-L client reads rule files that are described separate from the client. Ex. 1005, 4:58–63, 12:19–51:64. Second, we find persuasive, Dr. Mitzenmacher’s testimony that

[m]odifying Graf to transmit the SYSTEMWatch AI-L client (i.e., the “discovery agent”) across the disclosed Graf computer network would have been motivated by the need to add the SYSTEMWatch AI-L client to a new managed computer, especially where Graf discloses that its compute[r] network can comprise “several thousand” managed computers. Ex. 1005 at 4:20-22. In light of such disclosure, a person of ordinary skill in the art would have been motivated, reading Wahlquist, to combine the transmission of the SYSTEMWatch AI-L client to accommodate such a large system and to more efficiently manage such a system, which is the point of Graf.

Such a solution would have been the application of a known technique (transmission of executable code, such as a “discovery agent,” to a client computer) that yielded predictable results (execution of the client program on the client computer).

Ex. 1003 ¶ 206. Here, Dr. Mitzenmacher’s testimony is also consistent with the disclosure in Graf (see Ex. 1005, 4:20–22).

Accordingly, we are persuaded that Petitioner has demonstrated by a preponderance of the evidence that claims 7, 25, and 35 of the ’581 patent are unpatentable over Graf, Desai, and Wahlquist.

f. Claims 26–28

Claim 26 depends from claim 20 and recites “wherein the discovery agent is activated to collect the data when the discovery rule requires the data.” This limitation mirrors that recited in claims 8 and 36, which is

discussed above with respect to Petitioner's ground based on Graf and Desai. For the same reasons discussed above (*see supra* Section II.B.3.b), with respect to claims 8 and 36, Petitioner's arguments are persuasive.

Claim 27 depends from claim 20 and further recites "wherein the discovery agent is activated to collect the data according to a schedule." We addressed this same limitation in our discussion of claims 9 and 37 above. For the same reasons discussed with respect to claims 9 and 37, Petitioner's arguments are persuasive.

Claim 28 depends from claim 20 and further recites "wherein the discovery agent passively collects the data." We addressed this limitation in our discussion of claims 10 and 38 above. For the same reasons discussed with respect to claims 10 and 38, Petitioner's arguments are persuasive.

III. CONCLUSION

For all of the foregoing reasons, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 1–10 and 20–38 are unpatentable under 35 U.S.C. § 103(a).

IV. ORDER

For the reasons given, it is hereby

ORDERED that claims 1–10 and 20–38 are held unpatentable; and

FURTHER ORDERED that because this is a Final Written Decision, 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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