

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DIRECTV, LLC,
Petitioner,

v.

QURIO HOLDINGS, INC.,
Patent Owner.

Case IPR2015-02006
Patent 8,102,863 B1

Before BARBARA A. BENOIT, KERRY BEGLEY, and
JASON J. CHUNG, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a), 37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner, DIRECTV, LLC, filed a Petition to institute an *inter partes* review of claims 1, 2, 4, 10–12, 17, and 18¹ (“the challenged claims”) of U.S. Patent No. 8,102,863 B1 (“the ’863 patent”). Paper 2 (“Pet.”). Patent Owner, Qurio Holdings, Inc., filed a Preliminary Response pursuant to 35 U.S.C. § 313. Paper 5 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). Upon consideration of the Petition and the Preliminary Response, and for the reasons explained below, we determine that the information presented does not show a reasonable likelihood that Petitioner would prevail with respect to claims 1, 2, 4, 10–12, 17, and 18. *See* 35 U.S.C. § 314(a). Accordingly, we deny institution of an *inter partes* review of these claims.

¹ In the introduction, the Petition includes claims 1, 2, 4, 10–12, 17, and 18 in its request for *inter partes* review. Pet. 1. The Petition, however, includes claims 20 and 21 in the heading of the asserted grounds that apply Taesombut, Ducharme, and Wijting, *see id.* at 29, but does not feature any discussion of these claims in its analysis, *see id.* at 29–42. In addition, the Petition includes claims 20 and 21 in the heading of the asserted grounds that apply DPR2325, CableHome 1.1, Srivastava, and Safadi, *see id.* at 42, but does not feature any discussion of these claims in its analysis, *see id.* at 42–60. Thus, we do not understand claims 20 and 21 to be challenged in the Petition. Even if we were to consider them to be challenged claims, we would conclude that Petitioner has not shown a reasonable likelihood of establishing them to be unpatentable, because the Petition does not address these claims and the deficiencies in Petitioner’s showing regarding independent claim 17, from which these claims depend, applies to these claims.

A. Related Matters

The '863 patent is involved in the following proceedings: *Qurio Holdings, Inc. v. DIRECTV*, Case No. 3:15-cv-01986-HSG (N.D. Cal.); *Qurio Holdings, Inc. v. DISH Network L.L.C.*, Case No. 3:15-cv-00930-HSG (N.D. Cal.); *Qurio Holdings, Inc. v. Comcast Cable Communications, L.L.C.*, Case No. 2:15-cv-03334 (E.D. Pa); *DIRECTV, LLC v. Qurio Holdings, Inc.*, (IPR2015-02006); *DISH Network, L.L.C. v. Qurio Holdings, Inc.*, (IPR2016-00005); Application Serial No. 14/512,750. Paper 4, 2–3.

B. The Asserted Grounds

Petitioner identifies the following as asserted grounds of unpatentability:

References	Basis	Challenged Claims
Taesombut (Ex. 1010) ² , Ducharme (Ex. 1011) ³ , and Wijting (Ex. 1012) ⁴	§ 103(a) ⁵	1, 2, 4, 10–12, 17, and 18
CableHome 1.1 (Ex. 1013) ⁶ , DPR2325 (Ex. 1014) ⁷ , Srivastava (Ex. 1015) ⁸ , and Safadi (Ex. 1016) ⁹	§ 103(a)	1, 2, 4, 10–12, 17, and 18

C. The '863 Patent

The '863 patent is directed to “[a] gateway interconnecting a high speed Wide Area Network (WAN) and a lower speed Wireless Local Area Network (WLAN).” Ex. 1001, Abs. Figure 1 is reproduced below.

² Nut Taesombut et al., *A Secure Multimedia System in Emerging Wireless Home Networks*, in COMMUNICATIONS AND MULTIMEDIA SECURITY, PROCEEDINGS OF THE 7TH IFIP-TC6 TC11 INTERNATIONAL CONFERENCE, CMS 2003 76 (2003).

³ WO 2003/094510 A1, published Nov. 13, 2003.

⁴ Carl Wijting & Ramjee Prasad, *A Generic Framework for Cross-Layer Optimisation in Wireless Personal Area Networks*, 29 WIRELESS PERS. COMM. 135 (2004).

⁵ The relevant sections of the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, took effect on March 16, 2013. Because the application from which the '863 patent issued was filed before that date, our citations to Title 35 are to its pre-AIA version.

⁶ CABLEHOME 1.1 SPECIFICATION, CH-SP-CH1.1-I04-040409 (2004).

⁷ WebSTAR™ DPR2320™ and DPR2325™ Cable Modem Gateway User’s Guide (2005).

⁸ Vineet Srivastava & Mehul Motani, *Cross-Layer Design: A Survey and the Road Ahead*, IEEE COMM. MAG., Dec. 2005, at 112.

⁹ U.S. Patent Application Publication No. 2003/0126086, published July 3, 2003.

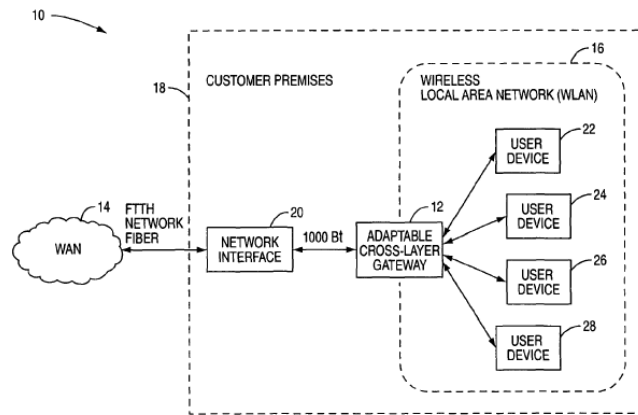


FIG. 1

Figure 1 illustrates adaptable cross-layer gateway 12, which “offloads data to data caches in order to take advantage of the high data rate provided by the high speed WAN 14.” *Id.* at 2:48–50. The ’863 patent also explains that “using cross-layering techniques, the gateway 12 improves the performance of the WLAN 16 in order to take further advantage of the high speed WAN 14.” *Id.* at 2:50–53.

In addition, the ’863 patent describes Digital Rights Management (“DRM”) rules “may include rules for identifying incoming content to be encoded as a security feature to prevent unauthorized viewing of the specified content by, for example, children within the WLAN 16.” *Id.* at 4:11–14.

The ’863 patent also describes a file format conversion “may convert the content from a first file format to a second file format having reduced bandwidth requirements, reduce the quality of content, or both.” *Id.* at 4:62–65. The ’863 patent discusses an example of this conversion is “Motion Pictures Experts Group (MPEG) Layer 2 (MPEG-2) video file to a MPEG Layer 4 (MPEG-4) video file, thereby reducing the bandwidth required to transfer the video file over the WLAN 16.” *Id.* at 4:65–5:3.

D. The Challenged Claims

Petitioner challenges claims 1, 2, 4, 10–12, 17, and 18. Pet. 1. Claims 1 and 17 are independent. Claim 1 is illustrative and reproduced below:

1. A gateway interconnecting a Wide Area Network (WAN) to a lower speed Wireless Local Area Network (WLAN) comprising:
 - an adaptable cross-layer offload engine;
 - a data cache associated with the offload engine;
 - a network interface communicatively coupling the offload engine to the WAN and providing a first data rate; and
 - a wireless interface associated with the offload engine and adapted to communicate with a plurality of user devices within the WLAN, the wireless interface providing a second data rate that is less than the first data rate of the network interface;
- wherein the offload engine is adapted to:
 - receive incoming data from the WAN via the network interface at the first data rate;
 - store the incoming data in the data cache; and
 - transmit the incoming data from the data cache to a corresponding one of the plurality of user devices in the WLAN via the wireless interface at the second data rate;
- further wherein the gateway further comprises:
 - a rule check engine adapted to inspect the incoming data from the WAN based upon at least one rule prior to transmitting the incoming data to the corresponding one of the plurality of user devices in the WLAN, the at least one rule comprises at least one Digital Rights Management (DRM) rule and the rule check engine operates to identify data to be processed by a DRM function and initiate the DRM function for the identified data; and

the DRM function initiated by the rule check engine based on the at least one DRM rule, the DRM function being adapted to encode the identified data such that encoded data is transmitted to the corresponding one of the plurality of user devices within the WLAN, and provide license keys for decoding the encoded data to desired ones of the plurality of user devices having permission to consume the encoded data.

II. ANALYSIS

A. *Claim Construction*

Petitioner and Patent Owner propose constructions for several claim terms. Pet. 13–17; Prelim. Resp. 10–25. On this record, we need not assess the parties’ proposed constructions because they are not necessary to resolve the dispositive issues discussed below.

B. *Obviousness of Claims 1, 2, 4, 10–12, 17, and 18 in View of Taesombut, Ducharme, and Wijting*

1. *Failure to Perform Graham Analysis*

A patent claim is unpatentable as obvious under 35 U.S.C. § 103(a) if “the differences between” the claimed subject matter and the prior art “are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The legal conclusion of obviousness is resolved on the basis of underlying factual determinations, including: (1) “the scope and content of the prior art,” (2) “differences between the prior art and the claims at issue,” (3) “the level of ordinary skill in the pertinent art,” and (4) any “secondary considerations,” or objective indicia,

of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). These underlying factual determinations “must be considered by the trier of fact” in an obviousness analysis. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

Here, the Petition fails to identify sufficiently the differences between independent claim 1 (and independent claim 17 as similarly recited) of the ’863 patent and the asserted prior art references, Taesombut, Ducharme, and Wijting. Pet. 31–39, 42. Rather than address these differences, the Petition creates a combination of Taesombut, Ducharme, and Wijting—based on six assertions to combine Taesombut, Ducharme, and Wijting. *Id.* at 31–39, 42. First, the Petition asserts that a person of ordinary skill in the art would have combined Ducharme and Taesombut “as a possible implementation of some of the techniques taught in Taesombut,” then would have applied Wijting’s cross-layer optimization techniques to the Taesombut and Ducharme combination “to improve the wireless delivery of video to clients over WLAN networks.” *Id.* at 31–32 (citing Decl. of Dr. Tal Lavian, Ex. 1005 ¶¶ 164–175). Second, the Petition asserts that a person of ordinary skill in the art would have combined Taesombut, Ducharme, and Wijting “because of their overlapping technical teachings with respect to this [preamble] limitation.” *Id.* at 33–34 (citing Ex. 1005 ¶¶ 185–198). Third, the Petition contends that “because Taesombut and Ducharme describe delivery of video data over a WLAN, one of skill would be motivated to apply Wijting’s cross-layer performance enhancing proxy to similarly improve delivery of video over wireless channels of varying quality.” *Id.* at 35 (citing Ex. 1005 ¶¶ 164–175). Fourth, the Petition argues that a person of ordinary skill in the art would have combined Taesombut, Ducharme, and Wijting “because

of their overlapping technical teachings on this [Element 1B]¹⁰ limitation.” *Id.* at 36 (citing Ex. 1005 ¶¶ 199–217). Fifth, the Petition argues that “[i]t would be obvious to combine the EMMs of Ducharme with the DRM rules of Taesombut, as both are examples of rules or messages for processing digital rights or content permissions in the gateway to facilitate security.” *Id.* at 38 (citing Ex. 1005 ¶¶ 164–175). Sixth, the Petition contends that “Ducharme, Taesombut, and Wijting contain similar technical teachings which support the combination.” *Id.* at 39 (citing Ex. 1005 ¶¶ 164–175).

As noted above, the Petition argues in conclusory fashion, that the combination of Taesombut, Ducharme, and Wijting meets each of the limitations of the claims. *Id.* at 31–39, 42. This analysis—which compares the challenged claims to the combination of Taesombut, Ducharme, and Wijting as well as the knowledge of one of ordinary skill in the art—obscures any comparison of the individual prior art references to the claim limitations. In particular, it does not explain with any particularity which claim limitations are absent from Taesombut, Ducharme, and Wijting. *Id.* at 33–39, 42. Therefore, the Petition fails to perform an adequate *Graham* analysis, as required for an obviousness determination.

To the extent the Dr. Lavian Declaration provides additional arguments and explanation not mentioned in the Petition, we need not and do not consider this testimony because the cited portions of Dr. Lavian’s Declaration relied upon by Petitioner to support its reasons to combine Taesombut, Ducharme, and Wijting spans a lengthy thirty-four pages and

¹⁰ All references to the letters associated with the claim numbers refer to the nomenclature inserted by Petitioner, according to the chart submitted as Exhibit 1032.

sixty-three paragraphs (i.e., Pet. 31–39 (citing Ex. 1005 ¶¶ 164–175, 185–217, 262–279)).

The Petition’s practice of citing multiple pages of the Dr. Lavian Declaration to support conclusory statements and to expand its thin analysis violates our rules in two respects. First, this practice amounts to incorporation by reference—which is impermissible under our rules. *See* 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated by reference from one document into another document.”); *Cisco Sys., Inc. v. C-Cation Techs., LLC*, Case IPR2014-00454, slip op. at 7–10 (PTAB Aug. 29, 2014) (Paper 12) (informative). This incorporation by reference from the Declaration into the Petition “serves to circumvent the page limits imposed on petitions for *inter partes* review, while imposing on our time by asking us to sift through over 2[5]0 pages of Dr. [Lavian’s] Declaration . . . to locate the specific [relevant] arguments” and supporting evidence. *Cisco Sys., Inc.*, IPR2014-00454, at 10 (Paper 12). We will not consider arguments and information that are not presented and developed in the Petition, and instead are incorporated by reference to the Dr. Lavian Declaration. Second, the Petition’s consistent citations to large portions of the Dr. Lavian Declaration runs afoul of the particularity and specificity required of supporting evidence under our governing statute and rules. *See* 35 U.S.C. § 312(a)(3); 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(4)–(5).

Further, the cited portions of Dr. Lavian’s Declaration relied upon by Petitioner to support its reasons to combine Taesombut, Ducharme, and Wijting provide the same conclusory reasons to combine Taesombut, Ducharme, and Wijting as the Petition. We, therefore, are not persuaded that Dr. Lavian’s testimony remedies Petitioner’s reasons to combine

Taesombut, Ducharme, and Wijting because Dr. Lavian's testimony relies on conclusory statements. *See* 37 C.F.R. § 42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight."); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 294 (Fed. Cir. 1985) (stating a lack of objective support for an expert opinion "may render the testimony of little probative value in [a patentability] determination").

Accordingly, we determine that the Petition does not show a reasonable likelihood that Petitioner would prevail in showing that claims 1, 2, 4, 10–12, 17, and 18 of the '863 patent would have been obvious over Taesombut, Ducharme, and Wijting. *See Apple Inc. v. SmartFlash LLC*, Case CBM2015-00029, slip op. at 16–18 (PTAB May 28, 2015) (Paper 11) (denying institution of an asserted obviousness ground based on Petitioner's failure to explain adequately any differences between the asserted prior art and the claimed invention); *Liberty Mut. Ins. Co. v. Progressive Casualty Ins. Co.*, Case CBM2012-00003, slip op. at 3 (PTAB Oct. 25, 2012) (Paper 7) (representative) ("A petitioner who does not state the differences between a challenged claim and the prior art, and relies instead on the Patent Owner and the Board to determine those differences . . . risks having the corresponding ground of obviousness not included for trial for failing to adequately state a claim for relief.").

2. *Lack of Rationale to Combine and Improper Hindsight*

We deny institution of the asserted ground based on Taesombut, Ducharme, and Wijting for an additional, independent reason. Specifically, we determine that the obviousness analysis proposed in the Petition does not

provide sufficiently articulated reasoning, with rational underpinning, to combine Taesombut, Ducharme, and Wijting to reach the invention recited in the challenged claims and, instead, is driven by conclusory reasons to combine the references and improper hindsight.

As explained *supra* in Part II.B.1., Petitioner improperly makes six conclusory assertions when attempting to combine Taesombut, Ducharme, and Wijting. In addition, The Supreme Court has explained that an obviousness analysis should “determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418. Similarly, the Federal Circuit has made clear that an obviousness determination “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); *see KSR*, 550 U.S. at 418 (quoting *Kahn*, 441 F.3d at 988). An obviousness analysis, however, must “avoid hindsight reconstruction by using the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.” *In re NTP, Inc.*, 654 F.3d 1279, 1299 (Fed. Cir. 2011).

We find the six rationales to combine proffered in the Petition for the proposed modifications to be conclusory and superficial for the reasons explained *supra* in Part II.B.1. In all six of the aforementioned examples, the Petition notes, in conclusory fashion, that overlapping technical teachings is a reason to combine the references. *Id.* at 33–39. Yet the Petition does not provide a persuasive reason to combine Taesombut, Ducharme, and Wijting beyond overlapping technologies. These proposed

modifications are supported by little to no reasoning to support a determination that it would have been obvious to combine the elements as proposed in the Petition.

As discussed *supra* in Part II.B.1., we are not persuaded that Dr. Lavian's testimony remedies Petitioner's reasons to combine Taesombut, Ducharme, and Wijting because Dr. Lavian's testimony relies on conclusory statements.

Moreover, when the many proposed changes are considered together, the Petition lacks adequate reasoning, with rational underpinning, to show sufficiently that a person of ordinary skill would have combined the teachings of Taesombut, Ducharme, and Wijting and the knowledge in the art to reach the combination of Taesombut, Ducharme, and Wijting, which the Petition alleges would satisfy each limitation of the challenged claims. In other words, we are not persuaded that the Petition sufficiently explains why a person of ordinary skill would simultaneously make all of the many particular proposed changes and implementation choices to combine Taesombut, Ducharme, Wijting, and allegedly known techniques.

Rather, given the extent of the proposed modifications as well as the thin reasoning proffered for each modification, we conclude that the Petition improperly "reli[es] upon *ex post* reasoning" and impermissible hindsight reconstruction to piece together the combination of Taesombut, Ducharme, and Wijting in a manner meant to resemble the '863 patent claims. *See KSR*, 550 U.S. at 421. The Petition strains to make numerous distinct modifications, picking and choosing aspects of Taesombut, Ducharme, and Wijting to arrive at the combination of Taesombut, Ducharme, and Wijting. *See Pet.* 31–39. "This type of piecemeal analysis is precisely the kind of

hindsight that [we] must not engage in.” *NTP*, 654 F.3d at 1299 (“Care must be taken to avoid hindsight reconstruction by using the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.”); *see also ATD Corp.*, 159 F.3d at 546 (“Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.”).

In sum, we are not persuaded that the Petition shows sufficiently why one of ordinary skill in the art—without improper hindsight—would have combined Taesombut, Ducharme, and Wijting to reach the invention recited in claims 1, 2, 4, 10–12, 17, and 18 of the ’863 patent. Therefore, we determine that the Petition does not establish a reasonable likelihood that Petitioner would prevail in showing that any of the challenged claims would have been obvious over Taesombut, Ducharme, and Wijting.

3. *Non-Compliance with 35 U.S.C. § 312(a)(3) and 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(4)–(5)*

Under 35 U.S.C. § 312(a)(3), a petition for *inter partes* review “may be considered only if . . . *the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.*” 35 U.S.C. § 312(a)(3) (emphases added). Our rules further address the showing required in a petition. In particular, 37 C.F.R. § 42.104(b)(4) provides that “[t]he petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon,” 37 C.F.R. § 42.104(b)(4) (emphasis added), and

37 C.F.R. § 42.104(b)(5) adds that the Petition must “*identify[] specific portions of the evidence* that support the challenge,” 37 C.F.R.

§ 42.104(b)(5) (emphasis added). Similarly, 37 C.F.R. § 42.22(a)(2) states that a petition “*must include . . . [a] full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence.*” 37 C.F.R. § 42.22(a)(2) (emphases added). For the reasons discussed below, the Petition fails to comply with each of these requirements in addressing the asserted ground based on Taesombut, Ducharme, and Wijting.

The entire Petition is riddled with improper mappings of Taesombut, Ducharme, Wijting, and the Dr. Lavian Declaration to the challenged claims. For example, for Element 1[E], the Petition merely states “[s]ee Elements 1[A] and 1[C]” even though Element 1[E] recites different limitations than Elements 1[A] and 1[C]. Pet. 37. In addition, for Element 1[F], the Petition merely states “[s]ee Element 1[A]” even though Element 1[F] recites different limitations than Element 1[A]. *Id.* Further, for Element 1[G], the Petition merely states “[s]ee Preamble of Claim 1 and Element 1[D]” even though Element 1[G] recites different limitations than the Preamble of Claim 1 and Element 1[D]. *Id.*

In sum, the Petition’s conclusory analysis with supporting citations to an incomprehensible web of internal cross-references to the Petition and the imprecise citations to the Dr. Lavian Declaration leaves us “to play archeologist with the record.” *Cisco Sys., Inc. v. C-Cation Techs., LLC*, Case IPR2014-00454, slip op. at 10 (Paper 12) (informative). Based on the deficiencies addressed above, the Petition fails: (1) to specify sufficiently where the limitations of claims 1, 2, 4, 10–12, 17, and 18 of the ’863 patent

are taught or suggested by Taesombut, Ducharme, Wijting, and (2) to provide a sufficiently detailed explanation of the significance of the citations to these references and the Dr. Lavian Declaration—as required under 35 U.S.C. § 312(a)(3), 37 C.F.R. § 42.22(a)(2), and 37 C.F.R. § 42.104(b)(4)–(5). We, therefore, deny institution of the asserted ground of obviousness over Taesombut, Ducharme, and Wijting.

C. Obviousness of Claims 1, 2, 4, 10–12, 17, and 18 in View of DPR2325, CableHome 1.1, Srivastava, and Safadi

1. Failure to Perform Graham Analysis

The *Graham* factors are discussed *supra* in Part II.B.1. In this case, the Petition fails to identify sufficiently the differences between independent claim 1 (and independent claim 17 as similarly recited) of the '863 patent and the asserted prior art references, DPR2325, CableHome 1.1, Srivastava, and Safadi. Pet. 42–57, 59–60. Rather than address these differences, the Petition creates a combination of DPR2325, CableHome 1.1, Srivastava, and Safadi system—based on three assertions to combine DPR2325, CableHome 1.1, Srivastava, and Safadi. *Id.* at 43–48, 50–51. First, the Petition asserts that a person of ordinary skill in the art would have combined DPR2325 and CableHome 1.1 because both have “overlapping technical disclosure,” then would have applied Safadi and Srivastava to the DPR2325 and CableHome 1.1 combination for additional reasons. *Id.* at 43–47 (citing Ex. 1005 ¶¶ 370–382). Second, the Petition asserts that “[t]he overlapping technical teachings of DPR2325, Cable[Home] 1.1, and Safadi support their combination.” *Id.* at 48 (citing Ex. 1005 ¶¶ 473–485). Third, the Petition contends that a person of ordinary skill in the art would

have combined DPR2325 and CableHome 1.1 because both “disclose[] a residential gateway,” then would have applied Srivastava because “this overlapping teaching supports the combination.” *Id.* at 50–51 (citing Ex. 1005 ¶¶ 394–418).

As noted above, the Petition argues in conclusory fashion, that the combination of DPR2325, CableHome 1.1, Srivastava, and Safadi meets each of the limitations of the claims. Pet. 43–48, 50–51. This analysis—which compares the challenged claims to the combination of DPR2325, CableHome 1.1, Srivastava, and Safadi as well as the knowledge of one of ordinary skill in the art—obscures any comparison of the individual prior art references to the claim limitations. In particular, it does not explain with any particularity which claim limitations are absent from DPR2325, CableHome 1.1, Srivastava, and Safadi. *Id.* at 43–51. Therefore, the Petition fails to perform an adequate *Graham* analysis, as required for an obviousness determination.

To the extent the Dr. Lavian Declaration provides additional arguments and explanation not mentioned in the Petition, we need not and do not consider this testimony because the cited portions of Dr. Lavian’s Declaration relied upon by Petitioner to support its reasons to combine DPR2325, CableHome 1.1, Srivastava, and Safadi spans a lengthy twenty-seven pages and fifty-one paragraphs (i.e., Pet. 43–51 (citing Ex. 1005 ¶¶ 370–382, 394–418, 473–485)). As explained *supra* in Part II.B.1., the Petition’s practice of citing a large amount of pages from Dr. Lavian’s Declaration is an improper incorporation by reference and runs afoul of the particularity and specificity required of supporting evidence under our governing statute and rules. Further, the cited portions of

Dr. Lavian's Declaration relied upon by Petitioner to support its reasons to combine DPR2325, CableHome 1.1, Srivastava, and Safadi provide the same conclusory reasons to combine DPR2325, CableHome 1.1, Srivastava, and Safadi as the Petition. Ex. 1005 ¶¶ 370–382, 394–418, 473–485. We, therefore, are not persuaded that Dr. Lavian's testimony remedies Petitioner's reasons to combine DPR2325, CableHome 1.1, Srivastava, and Safadi because Dr. Lavian's testimony relies on conclusory statements. See 37 C.F.R. § 42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight."); *Ashland Oil, Inc.*, 776 F.2d at 294 (stating a lack of objective support for an expert opinion "may render the testimony of little probative value in [a patentability] determination").

Accordingly, we determine that the Petition does not show a reasonable likelihood that Petitioner would prevail in showing that claims 1, 2, 4, 10–12, 17, and 18 of the '863 patent would have been obvious over DPR2325, CableHome 1.1, Srivastava, and Safadi. See *Apple Inc.*, CBM2015-00029, at 16–18 (Paper 11) (denying institution of an asserted obviousness ground based on Petitioner's failure to explain adequately any differences between the asserted prior art and the claimed invention); *Liberty Mut. Ins. Co.*, CBM2012-00003, at 3 (Paper 7) ("A petitioner who does not state the differences between a challenged claim and the prior art, and relies instead on the Patent Owner and the Board to determine those differences . . . risks having the corresponding ground of obviousness not included for trial for failing to adequately state a claim for relief.").

2. *Lack of Rationale to Combine and Improper Hindsight*

We deny institution of the asserted ground based on DPR2325, CableHome 1.1, Srivastava, and Safadi for an additional, independent reason. Specifically, we determine that the obviousness analysis proposed in the Petition does not provide sufficiently articulated reasoning, with rational underpinning, to combine DPR2325, CableHome 1.1, Srivastava, and Safadi to reach the invention recited in the challenged claims and, instead, is driven by conclusory reasons to combine the references and improper hindsight.

As explained *supra* in Part II.C.1., Petitioner improperly makes three conclusory assertions when attempting to combine DPR2325, CableHome 1.1, Safadi, and Srivastava. In addition, we find the three rationales to combine proffered in the Petition for the proposed modifications to be conclusory and superficial for the reasons explained *supra* in Part II.C.1. In all three of the aforementioned examples, the Petition notes, in conclusory fashion, that overlapping technical teachings is a reason to combine the references. *Id.* at 43–51. Yet the Petition does not provide a persuasive reason to combine DPR2325, CableHome 1.1, Srivastava, and Safadi beyond overlapping technologies. These proposed modifications are supported by little to no reasoning to support a determination that it would have been obvious to combine the elements as proposed in the Petition.

As discussed *supra* in Part II.C.1., we are not persuaded that Dr. Lavian’s testimony remedies Petitioner’s reasons to combine DPR2325, CableHome 1.1, Srivastava, and Safadi because Dr. Lavian’s testimony relies on conclusory statements.

Moreover, when the many proposed changes are considered together, the Petition lacks adequate reasoning, with rational underpinning, to show

sufficiently that a person of ordinary skill would have combined the teachings of DPR2325, CableHome 1.1, Srivastava, and Safadi and the knowledge in the art to reach the combination of DPR2325, CableHome 1.1, Srivastava, and Safadi, which the Petition alleges would satisfy each limitation of the challenged claims. In other words, we are not persuaded that the Petition sufficiently explains why a person of ordinary skill would simultaneously make all of the many particular proposed changes and implementation choices to combine DPR2325, CableHome 1.1, Srivastava, Safadi, and allegedly known techniques.

Rather, given the extent of the proposed modifications as well as the thin reasoning proffered for each modification, we conclude that the Petition improperly “reli[es] upon *ex post* reasoning” and impermissible hindsight reconstruction to piece together the combination of DPR2325, CableHome 1.1, Srivastava, and Safadi in a manner meant to resemble the ’863 patent claims. *See KSR*, 550 U.S. at 421. The Petition strains to make numerous distinct modifications, picking and choosing aspects of DPR2325, CableHome 1.1, Srivastava, and Safadi to arrive at the combination of DPR2325, CableHome 1.1, Srivastava, and Safadi. *See* Pet. 43–51. “This type of piecemeal analysis is precisely the kind of hindsight that [we] must not engage in.” *NTP*, 654 F.3d at 1299 (“Care must be taken to avoid hindsight reconstruction by using the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.”); *see also ATD Corp.*, 159 F.3d at 546 (“Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.”).

In sum, we are not persuaded that the Petition shows sufficiently why one of ordinary skill in the art—without improper hindsight—would have combined DPR2325, CableHome 1.1, Srivastava, and Safadi to reach the invention recited in claims 1, 2, 4, 10–12, 17, and 18 of the ’863 patent. Therefore, we determine that the Petition does not establish a reasonable likelihood that Petitioner would prevail in showing that any of the challenged claims would have been obvious over DPR2325, CableHome 1.1, Srivastava, and Safadi.

3. *Non-Compliance with 35 U.S.C. § 312(a)(3) and 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(4)–(5)*

The Petition is riddled with improper mappings of DPR2325, CableHome 1.1, Srivastava, and Safadi to the challenged claims, and citations to broad sections of the record, including the Dr. Lavian Declaration. For example, the Petition cites to a lengthy sixty-nine pages of Ducharme, which is Exhibit 1011, to teach “gateway security features” in the DPR2325, CableHome 1.1, Srivastava, and Safadi combination even though Ducharme is not applied in this asserted ground. Pet. 43 (citing Ex. 1011, 175–243). In addition, for Element 1[C], the Petition cites to Exhibit 1029, which is an article by Clifford R. Holliday that is not part of the asserted DPR2325, CableHome 1.1, Srivastava, and Safadi combination. Further, for Element 1[E], the Petition merely states “[s]ee Elements 1[A] and 1[C]” even though Element 1[E] recites different limitations than Elements 1[A] and 1[C]. Pet. 54. Moreover, for Element 1[F], the Petition merely states “[s]ee Element 1[A]” even though Element 1[F] recites different limitations than Element 1[A]. *Id.*

In sum, the Petition’s conclusory analysis with supporting citations to an incomprehensible web of internal cross-references to the Petition, and imprecise citations to the Dr. Lavian Declaration and other sections of the record leaves us “to play archeologist with the record.” *Cisco Sys., Inc.*, IPR2014-00454, slip op. at 10 (Paper 12) (informative). Based on the deficiencies addressed above, the Petition fails: (1) to specify sufficiently where the limitations of claims 1, 2, 4, 10–12, 17, and 18 of the ’863 patent are taught or suggested by DPR2325, CableHome 1.1, Srivastava, and Safadi, and (2) to provide a sufficiently detailed explanation of the significance of the citations to these references and the Dr. Lavian Declaration—as required under 35 U.S.C. § 312(a)(3), 37 C.F.R. § 42.22(a)(2), and 37 C.F.R. § 42.104(b)(4)–(5). We, therefore, deny institution of the asserted ground of obviousness over DPR2325, CableHome 1.1, Srivastava, and Safadi.

III. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition does not establish that there is a reasonable likelihood that Petitioner would prevail in showing the unpatentability of claims 1, 2, 4, 10–12, 17, and 18 of the ’863 patent.

IV. ORDER

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 314, the Petition is *denied* as to all challenged claims and no trial is instituted.

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