

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YAHOO! INC.,
Petitioner,

v.

INTENT IQ, INC.,
Patent Owner.

Case IPR2017-01299
Patent 8,677,398 B2

Before KRISTEN L. DROESCH, STACEY G. WHITE, and
MINN CHUNG, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Yahoo! Inc. (“Petitioner”) filed a Petition (Paper 7, “Pet.”) for *inter partes* review of claims 13–17 and 19–26 of U.S. Patent No. 8,677,398 B2 (Ex. 1001, “the ’398 Patent”). See 35 U.S.C. §§ 311–312. Intent IQ, Inc. (“Patent Owner”) timely filed a Preliminary Response. Paper 8. On October 31, 2017, we denied institution of *inter partes* review. Paper 9 (“Decision” or “Dec.”). Petitioner filed a Request for Rehearing of our Decision. Paper 10 (“Req. Reh’g”).

II. STANDARD OF REVIEW

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. See 37 C.F.R. § 42.71(c). An abuse of discretion may arise if the decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if an unreasonable judgment is made in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). The burden of showing that the decision should be modified is on Petitioner, the party challenging the decision. See 37 C.F.R. § 42.71(d). In addition, “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” *Id.*

III. ANALYSIS

Petitioner requests rehearing of the portion of the Decision denying institution of Petitioner’s challenges to claims 13–17, 19–23, and 26 as unpatentable over Banga and Zito, and claims 24 and 25 as unpatentable

over Banga, Zito, and Julia. See Req. Reh’g 1–2; Pet. 44–50. Petitioner first contends, “the Board misapprehended Banga’s disclosures by not recognizing (as expressly set forth in the Petition) that it disclosed the claimed ‘second device that is indicated . . . by an electronic identifier.’” Req. Reh’g 1; see *id.* at 6 (citing Dec. 15). Second, Petitioner argues, the Board misapprehended Banga’s disclosures by not recognizing that it disclosed the claimed ‘electronic association between the first and second device identifiers.’” *Id.*; see *id.* at 3 (citing Dec. 15).

As an initial matter, Petitioner mischaracterizes the Decision as addressing the claim limitation “a second device that is indicated . . . by an electronic identifier electronically associated with the first device identifier,” separate from addressing the limitation “wherein the electronic association between the first and second device identifiers is based on connection, . . . to a common local area network.” The Decision, however, repeatedly addressed the two limitations together. Specifically, with respect to the teachings of Banga alone, the Decision stated:

Petitioner’s arguments and evidence [] are insufficient to show that Banga discloses the following [] limitations of claim 13: (1) “*a second device that is indicated . . . by an electronic identifier;*” and (2) “*wherein the electronic association between the first and second device identifiers is based on connection, before the action, of each of the first and second devices, . . . to a common local area network.*”

Dec. 11 (emphases in original). With respect to the combined teachings of Banga and Zito, the Decision stated:

Petitioner’s arguments and supporting evidence do not sufficiently address how the combination of Banga and Zito teach or suggest “*a second device that is indicated . . . by an electronic identifier electronically associated with a first*

device identifier; wherein *the electronic association between the first and second device identifiers* is based on connection, before the action, of each of the first and second devices, . . . to a common local area network.”

Dec. 15 (emphases in original). Thus, Petitioner argues the limitations in isolation, when the Decision addresses the limitations together. Petitioner’s arguments addressing the two limitations in isolation also overlook the interrelationship between the limitations. The recitation “*a second device that is indicated . . . by an electronic identifier electronically associated with the first device identifier*” provides antecedent basis for the second device identifier recited in “the electronic association between the first and *second device identifiers*.” Similarly, “a second device that is indicated . . . by an electronic identifier *electronically associated* with the first device identifier” provides antecedent basis for “*the electronic association* between the first and second device identifiers”

In separately addressing the limitation, “a second device that is indicated . . . by an electronic identifier,” Petitioner asserts, “the Decision concluded that it was Petitioner’s position that the electronic identifier was the user profile.” Req. Reh’g 6. Petitioner argues, “The Board overlooked the express identification of the ‘second device identifier’ in the Petition, and the Board mistakenly stated that Petitioner’s argument . . . was that the second electronic identifier was the device ‘indicated at the time due to its association with a common user profile.’” *Id.* at 6–7 (quoting Dec. 10). Petitioner further contends, “the Petition stated that Banga expressly discloses electronic identifiers in the form of ‘device identifiers.’” *Id.* at 6 (quoting Pet. 22–23; citing Ex. 1004 ¶¶ 77–80); *see also id.* at 7 (stating same; citing Pet. 22–23; Ex. 1004 ¶¶ 30, 34, 46, 57).

Petitioner's arguments do not persuade us that, in rendering our Decision, we abused our discretion, or misapprehended or overlooked Petitioner's arguments and supporting evidence. Petitioner's arguments mischaracterize the Decision because Petitioner does not direct us to, and we cannot find, where the Decision states "the second electronic **identifier** was the device 'indicated at the time' due to its association with a common 'user profile.'" See Req. Reh'g 7 (emphasis added). Instead, the Decision directly quotes the Petition as follows: "Petitioner contends that '[t]he **device** to which the action is directed is indicated at the time due to its association with a common user profile' based on the access information of devices on an access point." Dec. 10 (quoting Pet. 23) (emphasis added). Petitioner's arguments further mischaracterize the Decision because the Decision acknowledges the following assertions from the Petition: (1) "Petitioner identifies Banga's description of a user profile as disclosing the claimed 'first electronic profile data,' and Banga's description of a first network access device that has a device identifier[] as disclosing the claimed 'an electronic identifier of a first device,'" and (2) "Petitioner also contends that 'Banga discloses that the user profile may comprise one or more device identifiers.'" *Id.* at 9 (quoting and citing Pet. 22); *see also id.* at 11–12 (also addressing Petitioner's assertions based on Banga's disclosure of a user profile comprising one or more device identifiers). Although Banga may disclose, teach, or suggest multiple network access devices associated with a user profile, and a user profile may comprise one or more device identifiers (see Pet. 22–23), as explained in the Decision, "Petitioner does not direct us to any description in Banga that discloses *an electronic identifier indicating a second device*, i.e., a second device identifier, **and** an electronic

association between a first device identifier and *second device identifier*.”

Dec. 12 (emphases added).

In separately addressing the limitation “wherein the electronic association between the first and second device identifiers is based on connection, . . . of each of the first and second devices, . . . to a common local area network,” Petitioner contends, “the Board misinterpreted the ‘electronic association’ that is disclosed in Banga and identified in the Petition.” Req. Reh’g 3. Petitioner asserts, “the Petition repeatedly explains that multiple devices are associated with a common user profile via their unique device identifiers.” *Id.* In support of its arguments, Petitioner provides the following quoted excerpts from the Petition:

- (1) “Banga expressly discloses a ‘**user profile**’ (‘first electronic profile data’) **associated** with a first ‘network access device’ that has a ‘device identifier’ (‘electronic identifier of a first device’).;
- (2) “Banga expressly discloses a CR server which directs advertisements to all devices that are **associated** with the same ‘**user profile**.’”;
- (3) “Because the system of Banga includes numerous devices **associated** with a single **profile** . . . ”); and
- (4) “Banga discloses that multiple ‘network access devices’ are **associated** with the same **user profile** (i.e., that single **user profile** is generated for multiple devices and contains multiple ‘device identifiers’)”

Req. Reh’g 3–4 (quoting Pet. 22–23) (Petitioner’s emphases).

Petitioner’s arguments do not persuade us that, in rendering our Decision, we abused our discretion, or misapprehended or overlooked Petitioner’s arguments and supporting evidence. Petitioner’s arguments and supporting evidence in its Request for Rehearing, like in the Petition, address an association between first and second devices, but do not address an electronic association between first and second device identifiers. As

explained in the Decision, “Petitioner does not direct us to any description in Banga that discloses *an electronic identifier indicating a second device*, i.e., a second device identifier, **and** *an electronic association between a first device identifier and second device identifier.*” Dec. 12 (emphases added).

For all of the foregoing reasons, Petitioner has not demonstrated that we abused our discretion or that we misapprehended or overlooked any matter in rendering our Decision. Petitioner, therefore, has not carried its burden of demonstrating that our Decision denying the Petition should be modified. *See* 37 C.F.R. § 42.71(d).

IV. DECISION ON REHEARING

Accordingly, Petitioner’s request for rehearing is *denied*.

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