

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

ALEX IS THE BEST, LLC,
Patent Owner.

Case IPR2017-02058
Patent 8,581,991 B1

Before DANIEL N. FISHMAN, MINN CHUNG, and
JESSICA C. KAISER, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner, Google LLC (“Petitioner”), filed a Request for Rehearing (Paper 11, “Request” or “Req. Reh’g”) of the Decision (Paper 10, “Dec.”), in which, based on the information presented in the Petition (Paper 2, “Pet.”), we denied institution of an *inter partes* review of claims 1–3, 10–14, and 21 (the “challenged claims”) of U.S. Patent No. 8,581,991 B1 (Ex. 1001, “the ’991 patent”). In its Request, Petitioner contends that our Decision overlooked or misapprehended certain teachings of Inoue (Ex. 1005) and Kusaka (Ex. 1009) about a “website archive and review [center] (WSARC)” or an “account associated with an Internet direct device” recited in independent claims 1 and 13. See Req. Reh’g 3–4. The Request also asserts that the Decision overlooked certain “background” discussion by Petitioner’s declarant, Dr. Madiseti. *Id.* at 2. For the reasons stated below, Petitioner’s Request for Rehearing is *denied*.

II. STANDARD OF REVIEW

“The burden of showing a decision should be modified lies with the party challenging the decision,” and the challenging party “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed” in a paper of record. 37 C.F.R. § 42.71(d). Because Petitioner seeks rehearing of our Decision denying institution of trial based on the Petition, it must show an abuse of discretion. See 37 C.F.R. § 42.71(c) (“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.”). An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a

clear error of judgment.” *PPG Indus., Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988).

III. ANALYSIS

A. Arguments in the Request Regarding Inoue

We first address Petitioner’s contention that our Decision overlooked certain teachings in Inoue about the claimed “WSARC.” Req. Reh’g 3. In the Decision, we found that, although the Petition appears to map Inoue’s file server to the claimed “WSARC” by mentioning “WSARC (Inoue’s file server)” (Dec. 16–17 (citing Pet. 17)), aside from that single mention, the Petition does not discuss the term “WSARC” or “website archive and review center” in relation to Inoue, and does not explain adequately why Inoue’s file server teaches or suggests the “WSARC” recited in the claims (*id.* at 17, 19 (citing Pet. 15–18)). Thus, based on the record presented, we determined that simply stating “a WSARC (Inoue’s file server)” in the Petition without any elaboration does not satisfy Petitioner’s burden required for institution of a review in this case (*id.* at 19–20 (citations omitted)).

In its Request, Petitioner does *not* argue that we misapprehended or overlooked Petitioner’s arguments or explanations presented in the Petition. Nor does the Request assert that the Decision applied incorrect standards for Petitioner’s burden required for institution of an *inter partes* review. Instead, the Request focuses on additional discussion of Inoue’s disclosures. In the Request, Petitioner contends that the Decision overlooked “the broader context of Inoue’s disclosure regarding the file server” (Req. Reh’g 6) and presents a lengthy discussion of Figures 3 and 13 of Inoue and their

associated description, arguing that Inoue’s file server discloses the claimed “WSARC” (*id.* at 6–8).

Much of the Request’s discussion of Inoue, however, appears to be new arguments that were not presented initially in the Petition. Although the Request cites pages 12–21 of the Petition generally, it does not specifically identify where the arguments in the Request were presented in the Petition. *See* Req. Reh’g 6–8. For example, the Request does not identify, nor do we discern, where in the Petition the following arguments were made: “Inoue’s file server 100 performs all the functions of the WSARC recited in the challenged claims” (*id.* at 7); Inoue describes the “web-related function” performed by Inoue’s file server (*id.* at 7–8); and Inoue teaches “[s]etting up file server 100’s user interface as a website” because “Figure 13’s user interface . . . depicts a web page” (*id.* at 8). Nor does the Request point to any testimony in the Declaration of Dr. Madisetti (Ex. 1010) on claims 1 and 13 that discusses these arguments. *See* Ex. 1010 ¶¶ 426–436, 443–446.

The Request also asserts that Figure 13 of Inoue shows a web page because “as Dr. Madisetti explained in the *background* for his opinions, a website is a common means of sharing images among a variety of devices connected to the Internet.” Req. Reh’g 8 (emphasis added) (citing Ex. 1010 ¶¶ 67, 70, 72–73, 82). Again, Petitioner does not identify, nor do we discern, where in the Petition this argument was presented. Nor does Petitioner identify where in the Petition paragraphs 67, 70, 72–73, and 82 of Dr. Madisetti’s Declaration were cited or discussed.

Plainly, we could not have misapprehended or overlooked arguments or evidence that were not presented or developed in the Petition.

To the extent Petitioner argues that we nonetheless should have credited Dr. Madisetti's testimony in the "background" paragraphs, we are not persuaded for the reasons explained in what follows. First, we note that these "background" paragraphs were *not* cited or discussed in the Petition or in Dr. Madisetti's testimony on claims 1 and 13 submitted in support of Petitioner's contention that Inoue teaches a "WSARC" recited in the claims. *See* Pet. 12–21, 24–26; Ex. 1010 ¶¶ 426–436, 443–446. Second, Dr. Madisetti's Declaration spans over 490 pages and includes over 900 paragraphs. The voluminous nature of the Madisetti Declaration appears to be largely due to Petitioner's decision to prepare and submit a single Declaration for *all eight petitions* Petitioner filed in Cases IPR2017-02052, IPR2017-02053, IPR2017-02054, IPR2017-02055, IPR2017-02056, IPR2017-02057, IPR2017-02058, and IPR2017-02059. *See* Ex. 1010 ¶¶ 2–11. Further, within the single Madisetti Declaration, there exists only one "background" section (*see id.* at 25 n.4), titled "OVERVIEW OF THE STATE OF THE ART RELEVANT TO THE PATENTS-AT-ISSUE," that discusses what was purportedly known to a person of ordinary skill in the art before the filing date of any of the patents at issue in these eight petitions. In the "background" paragraphs cited in the Request, Dr. Madisetti does not discuss any specific challenged claim of any specific patent at issue in these eight proceedings. *See* Ex. 1010 ¶¶ 67, 70, 72–73, 82. Dr. Madisetti's discussion of claim 1 of the '991 patent in relation to Inoue appears about 200 pages later, separated by over 300 paragraphs from the "background" discussion. *See* Ex. 1010 ¶ 426.

By asserting that our Decision overlooked Dr. Madisetti's "background" discussion (*see* Req. Reh'g 2, 8), Petitioner apparently argues

that we should have credited Dr. Madisetti's testimony in paragraphs 67, 70, 72–73, and 82 of his Declaration that were not cited in the Petition or Dr. Madisetti's discussion of claims 1 and 13 of the '991 patent. But it is not reasonable for Petitioner to expect the Board to search through hundreds of pages of testimony from Dr. Madisetti and somehow match his unspecific "background" testimony *applicable to all eight petitions* with a specific limitation of a specific claim of the particular patent challenged in this case (among all of the claims of the patents at issue in these eight separate proceedings), to find support for Petitioner's contention that Inoue teaches a "WSARC" recited in claims 1 and 13 of the '991 patent. If Petitioner wanted for us to consider the "background" paragraphs in Dr. Madisetti's Declaration as supporting arguments presented and developed in the Petition, it should have provided citations in the Petition to these paragraphs with particularity, and explained their relevance to the claim limitation at issue. *Cf. DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999) ("A brief must make all arguments accessible to the judges, rather than ask them to play archeologist with the record.").

The Request also cites to paragraph 46 of the Madisetti Declaration as opining that a person of ordinary skill in the art would have understood that "[a] WSARC is nothing more than a remote server with databases to store or manage images that is accessible via the 'Internet' or a 'communication network' through well-known wired, wireless, cellular, or other communication means." Req. Reh'g 11 (citing Ex. 1010 ¶ 46). Again, the Request does not identify, nor do we discern, where in the Petition or Dr. Madisetti's discussion of claims 1 and 13 of the '991 patent paragraph 46 of his Declaration was cited or discussed.

Paragraph 46 of Dr. Madisetti's Declaration appears in the section titled "Similarities And Differences Among The Issued Claims," in which Dr. Madisetti discusses some of the similarities and differences among all of the claims challenged in the eight separate petitions filed by Petitioner. See Ex. 1010 ¶¶ 41–48. Similar to the "background" paragraphs discussed above, paragraph 46 is not cited in the Petition or in Dr. Madisetti's discussion of claims 1 and 13 of the '991 patent, which appears about 200 pages later, separated by nearly 400 paragraphs from paragraph 46. See Pet. 12–21, 24–26; Ex. 1010 ¶¶ 426–436, 443–446. For reasons similar to those discussed above, if Petitioner desired for us to consider paragraph 46 of Dr. Madisetti's Declaration as supporting arguments presented and developed in the Petition, it should have provided citations in the Petition to the paragraph with particularity, and explained its relevance to the claim limitation at issue.

At best, Petitioner's arguments in its Request for Rehearing attempt to remedy the deficiencies in the Petition our Decision identified, by supplementing the arguments in the Petition. A request for rehearing is not a supplemental petition. Nor is it an opportunity to present new arguments or evidence that could have been presented and developed in the first instance in the Petition.

As explained in the Decision (Dec. 19–20), it was Petitioner's burden "*from the onset to show with particularity why the patent it challenges is unpatentable.*" *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (emphases added) (citing 35 U.S.C. § 312(a)(3)); see *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) ("[T]he expedited nature of IPRs bring with it an *obligation* for

petitioners to make their case in their *petition to institute*.” (emphases added)). The record shows that, rather than overlooking any teachings of Inoue or any “background” discussion by Dr. Madisetti, the Decision simply considered the arguments and explanations of the evidence Petitioner presented in the four corners of the Petition, and properly determined that the Petition did not meet this burden required on Petitioner. Dec. 19–20.

B. Arguments in the Request Regarding Kusaka

We next turn to Petitioner’s assertion that our Decision overlooked certain teachings in Kusaka about an “account associated with an Internet direct device on a website archive and review (WSARC)” recited in independent claims 1 and 13. Req. Reh’g 9. In the Petition, Petitioner mapped the claimed “Internet direct device” and “WSARC” to the electronic camera and the *image server* of Kusaka, respectively (Pet. 56, 58), and asserted that “Kusaka discloses an *account on the WSARC (image server)* that is associated with the IDD [i.e., the electronic camera]” (Pet. 59 (emphasis added) (citing Ex. 1009 ¶¶ 3, 219–221)). In the Decision, we found that the Petition does not identify in the cited paragraphs of Kusaka any teaching of an “account” on Kusaka’s image servers that is associated with the electronic camera. Dec. 29.

In its Request, Petitioner contends that an “album” existing on Kusaka’s image server is the claimed “account.” Req. Reh’g 12 (“Kusaka describes storing images in *albums (accounts)* based upon an identification of a particular user of Kusaka’s system.” (emphasis added)). Petitioner, however, does not identify where in the Petition Petitioner mapped Kusaka’s album to the claimed “account.”

In the Decision, we determined that, even if we were to consider Kusaka’s description of the albums on the image server, the Petition does not show sufficiently that Kusaka teaches “an account associated with the Internet direct device” existing on a “WSARC” because Kusaka’s albums are associated with users, *not* with Kusaka’s camera (i.e., the claimed “Internet direct device”) as required by the claims. Dec. 30–31. As discussed in the Decision, in Kusaka, no camera identification information is sent to the image server. *Id.* Instead, only user identification information is transmitted to Kusaka’s image server. *Id.* (citing Ex. 1009 ¶¶ 3, 219–221).

In the Request, Petitioner argues that Kusaka’s album is associated with the camera because Kusaka describes that a camera can “retrieve image information from an album on *the image server*—i.e., the camera continues to be associated with the images contained in the album on the image server.” Req. Reh’g 13 (emphasis added) (citing Ex. 1009 ¶ 236); *see also* Pet. 58 (arguing that “[t]he images on the image server can later be managed, reviewed, or downloaded via the electronic camera” (citing Ex. 1009 ¶ 236)).

We are not persuaded by Petitioner’s argument. Paragraph 236 of Kusaka cited by Petitioner is reproduced below in its entirety.

[0236] In playback mode, the CPU 50 first reads the thumbnail image data stored in the memory card 77 and stores it temporarily in the frame memory 69, and displays the thumbnail image data on the left screen 21 by means of the screen control circuit 92. The CPU 50 next transmits the image identification information corresponding to the thumbnail image data selected by the user, the camera identification information and the user identification information by means of the wireless portable telephone circuit 72 through antenna 76 to the *gateway server* 160. Subsequently, the CPU 50 *receives the image file* corresponding to the image

identification information transmitted to the gateway server 160 *from the gateway server* 160 by means of the wireless portable telephone circuit 72, temporarily stores the image data contained in the image file in the frame memory 69, and displays the image data on the left screen 21 by means of the screen control circuit 92.

Ex. 1009 ¶ 236 (emphases added). As shown above, paragraph 236 of Kusaka describes that the camera in a playback mode receives a user-selected image from the “gateway server,” *not from the image server*. Thus, although paragraph 236 of Kusaka may suggest that the *gateway server* of Kusaka may associate the camera with the user information and the image files stored on the image server, there is no teaching or suggestion in paragraph 236 that *the albums* on Kusaka’s *image server* (which Petitioner maps to the claimed “WSARC”) are associated with Kusaka’s electronic camera. As discussed in the Decision, there is no disclosure in Kusaka of anything associated with a camera existing on the image server because no camera identification information is sent to the image server. Dec. 30–31.

In the Request, Petitioner asserts that the “user identification” transmitted to the image server of Kusaka is “associated with” the camera because the “user identification” “originated” from Kusaka’s electronic camera. Req. Reh’g 13. The Request does not identify, nor do we discern, where in the Petition this argument was made. Nor does the Request identify where in the Petition Petitioner proposed or explained its apparent construction of the term “associated with” underlying Petitioner’s argument. These arguments appear to be new arguments presented for the first time in Petitioner’s Request for Rehearing to remedy the deficiencies in the Petition that were identified in our Decision.

It was Petitioner's affirmative duty to explain how the challenged claims should be construed and how, as so construed, they are unpatentable. *See* 37 C.F.R. § 42.104(b)(3)–(4). Thus, if Petitioner intended to argue a claim construction of the term “associated with” such that, under its construction, information that “originated” from a camera is “associated with” the camera, such an analysis should have been made explicit in the Petition. A rehearing request is not a supplemental petition. Nor is it an opportunity to present new arguments or evidence that could have been presented and developed in the first instance in the Petition. Simply put, we could not have misapprehended or overlooked arguments or evidence that were not presented or developed in the Petition.

In the Request, Petitioner also asserts that Kusaka discloses a “WSARC” recited in the claims. Req. Reh'g 9–11. We need not address Petitioner's contention because, although much of the discussion in the Request appears to be new arguments presented for the first time in the Request, they would not have affected the outcome of the Decision denying institution in this case. As discussed above, the record shows that the Decision properly determined that the Petition does not demonstrate sufficiently Kusaka teaches “an account associated with the Internet direct device” existing on a “WSARC,” as recited in independent claims 1 and 13.

III. CONCLUSION

For the foregoing reasons, Petitioner has not demonstrated that we abused our discretion or that we misapprehended or overlooked any matter in our Decision denying institution of *inter partes* review of the challenged claims of the '991 patent. Petitioner, therefore, has not carried its burden of

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demonstrating that the Decision denying institution should be modified. *See* 37 C.F.R. § 42.71(d).

IV. ORDER

Accordingly, it is ORDERED that Petitioner's Request for Rehearing is DENIED.

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