

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EXPEDIA, INC.; HOMEAWAY.COM, INC.; HOTELS.COM L.P.;
HOTWIRE, INC.; AND ORBITZ, LLC,
Petitioners,

v.

INTERNATIONAL BUSINESS MACHINES CORP.,
Patent Owner.

Case IPR2018-01743
Patent 7,072,849 B1

Before MICHAEL W. KIM, CHRISTOPHER M. KAISER, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

Decision on Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Expedia, Inc., Homeaway.com, Inc., Hotels.com L.P., Hotwire, Inc., and, Orbitz, LLC (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–25 of U.S. Patent 7,072,849 B1 (Ex. 1002, “the ’849 Patent”). Paper 2 (“Pet.”). International Business Machines Corp. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). On March 19, 2019, we issued a Decision Denying Institution of *Inter Partes* Review. Paper 8 (“Decision”). On May 1, 2019, Petitioner filed a Request for Rehearing. Paper 11 (“Req.”).¹

II. PRINCIPLES OF LAW

A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

37 C.F.R. § 42.71(d). “When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c).

III. ANALYSIS

Petitioner contends that the Board “overlooked intrinsic evidence and imposed unclaimed requirements on the ‘application . . . that include interactive services’ limitation.” Req. 4. Specifically, Petitioner asserts that the Board’s denial of institution was based on a construction of the above claim limitations to require “that the mechanism for interacting with the application itself be received from the network,” but that a previous Board

¹ On May 6, 2019, the Board granted a Motion for Requesting Acceptance of Submission of a Request for Rehearing. See Paper 13.

decision on the '849 Patent determined that “nothing in the claims requires that the mechanism for interacting with the application itself be received from the network.” Req. 5–6 (citing Ex. 1004, 136, 145, 150–151, 153, 157, 160). Petitioner asserts that had we relied on the Board’s previous construction, trial would have been instituted.

Petitioner has the burden of identifying “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); *see also* Dec. 11 (citing statute). Petitioner also has the burden to “specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d).

The Request does not identify any express claim construction in the Petition for the limitation of “application . . . that include interactive services.” *See generally* Req. Our own review of the Petition results in the same. *See generally* Pet. Pages 12–17 of the Petition provide constructions for several terms, including “application,” but not for the entirety of the limitation identified above. Indeed, Petitioner relied on the Board’s previous decisions for both explicit and implicit constructions of other claim limitations. *See* Pet. 13–15, 86, 93, 96, 104 (citing Ex. 1004, 40–41, 137–138, 146–147, 151–152, 157–158, 161, 171). Noticeably absent, however, is the same for “application . . . that include interactive services.” We could not have misapprehended or overlooked a claim construction that was not made.

Even if we delve somewhat into the cited portion of the Board’s previous decision, however, we remain unpersuaded. Specifically, while Petitioner’s quotation of the Decision is correct, the Decision later states: “We agree that the body of claim 4 does not require applications with interactive services, but ‘interactive services’ must be one kind of application that can be requested.” Ex. 1004, 136. So, while our analysis may have been altered somewhat, we are unpersuaded that Petitioner has met its burden of showing that maintaining the same result, denial of institution on this basis, would have been an abuse of discretion.

Petitioner also contends that “the Board misapprehended how the applications retrieved from the network do provide interactive services.” Req. 7. Petitioner argues the “users could interact with the applications by navigating to different pages of summaries, such as by using the cursor in the left margin of the application.” Req. 8 (citing Pet. 51). In the Decision, we analyzed expressly the command window of Figure 2-3 of BCIS. Dec. 14–15. We determined that whether the command menu was also received was not explained with sufficient particularity. Dec. 14–15, n.2. Nothing Petitioner cites or argues persuades us otherwise.

III. CONCLUSION

Petitioner’s Request for Rehearing is *denied*.

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