

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VICTORIA'S SECRET STORES LLC,
Petitioner,

v.

ANDRA GROUP, LP,
Patent Owner.

IPR2020-00853
Patent 8,078,498 B2

Before LINDA E. HORNER, JAMES A. WORTH, and ERIC C. JESCHKE,
Administrative Patent Judges.

JESCHKE, *Administrative Patent Judge.*

DECISION

Denying Petitioner's Request on Rehearing of Decision
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(c), (d)

I. BACKGROUND

Victoria's Secret Stores, LLC ("Petitioner") filed a Petition to institute an *inter partes* review of claims 1, 2, 5–8, and 11 (the "challenged claims") of U.S. Patent No. 8,078,498 B2 (Ex. 1001, "the '498 patent"). Paper 1 ("Pet."). Andra Group, LP filed a Patent Owner's Preliminary Response. Paper 10. We denied institution, determining that the Petition did not show a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims in any of the three asserted grounds of unpatentability. *See* Paper 12 ("Decision on Institution" or "Dec."). Petitioner timely filed a Request on Rehearing, requesting "partial reconsideration" as to one of the three asserted grounds, in which Petitioner asserted that the challenged claims would have been obvious based on VS Webpages (Ex. 1031). Paper 13 ("Request on Rehearing" or "Req. Reh'g."), at 1; *see also* Pet. 40, 51–67 (discussing this ground). For the reasons below, Petitioner's Request on Rehearing is *denied*.

II. DISCUSSION

A. *Standard of Review*

A party requesting rehearing bears the burden of showing that the decision should be modified. *See* 37 C.F.R. § 42.71(d) (2019). A request on rehearing "must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed" in the briefing. *Id.* When reconsidering a decision on institution, we review for an abuse of discretion. *See* 37 C.F.R. § 42.71(c).

*B. Petitioner's Arguments on Rehearing as to the Asserted
Obviousness of Claims 1, 2, 5–8, and 11 Based on VS Webpages*

In the Request on Rehearing, Petitioner presents three issues allegedly misapprehended or overlooked in relation to the asserted ground based on VS Webpages. *See* Req. Reh'g 4–12. We address each in turn below.

First, Petitioner argues that VS Webpages is analogous art to the '498 patent. *See* Req. Reh'g 5–6. Petitioner asserts that, in the Decision on Institution, “the Board d[id] not consider (and in fact d[id] not mention at all) Petitioner's argument and evidence related to the VS Webpages being analogous art to the '498 [p]atent.” *Id.* at 6.

The fact that the Decision on Institution did not discuss whether VS Webpages is analogous art to the '498 patent does not show that we “misapprehended or overlooked” an argument or evidence. *See* 37 C.F.R. § 42.71(d). An assessment of whether relied-upon art is analogous is a threshold inquiry in an obviousness analysis. *See Johns Manville Corp. v. Knauf Insulation, Inc.*, IPR2018-00827, Paper 9 at 10–11 (PTAB Oct. 16, 2018) (Decision Denying Institution) (informative) (“Analogous art is merely a threshold inquiry as to whether a reference can be considered in an obviousness analysis. Demonstrating that a reference is analogous art or relevant to the field of endeavor of the challenged patent is not sufficient to establish that one of ordinary skill would have had reason to combine its teachings with other prior art in the manner set forth in the claim.”). Here, we did not address analogousness because we determined that *other issues* were dispositive as to the asserted ground at issue. Specifically, as discussed below, Petitioner had not shown a reasonable likelihood in prevailing with its position that human beings fall within the scope of the term “article” (or “articles”) in the challenged claims. *See* Dec. 13–18.

Second, Petitioner contends that “the Petition demonstrated, and the Decision does not discuss, the complete lack of meaningful difference between the ’498 Patent and the VS Webpages, a key factor for the obviousness analysis under *Graham* [*v. John Deere Co.*, 383 U.S. 1 (1966)].” Req. Reh’g 6; *see also id.* at 6–10 (section titled “The Board Failed to Consider the Lack of Meaningful Difference Between the VS Webpages and the ’498 Patent”). According to Petitioner, “there is total overlap between the technical disclosures of the ’498 Patent and those of the VS Webpages.” *Id.* at 6 (citing Pet. 51–67; Weadock Decl. ¶¶ 114–137). Petitioner contends that “[t]he Petition directly addressed the issue of whether [one of ordinary skill in the art] would consider the challenged claims obvious in view of the VS webpages, *even if* ‘article’ is construed to exclude humans as the Board has here.” *Id.* at 7–8 (citing Pet. 57–60, 65–67; Weadock Decl. ¶¶ 123–128, 135–137). More specifically, Petitioner argues that the Petition (1) demonstrates that “the differing content of the images respectively displayed does not alter image file type, size, dimension, ability to be displayed in the ‘master display field’ or any other aspect affecting technical function,” (2) “demonstrates that the VS Webpages includes multiple thumbnails of a particular model from different perspective views,” and (3) “makes clear that [one of ordinary skill in the art] would know how, and be motivated, to adopt the teachings of the VS Webpages and apply them to a set of thumbnail images that ‘are unremarkably generated from various “view” shots of a particular article such that a user is shown multiple views of a single item.’” Req. Reh’g 8 (citing: for (1) Pet. 58–60, 65–67; Weadock Decl. ¶¶ 125, 128, 135–137; for

(2) Pet. 57–60, 63–65; Weadock Decl. ¶¶ 123–128, 133–135; for (3) Pet. 66–67; Weadock Decl. ¶ 137).

We disagree with Petitioner’s characterization of the arguments presented in the Petition. In the Decision on Institution, we expressly stated that, even in the context of Petitioner’s *alternative* position—involving modifying certain images displayed by VS Webpages—“Petitioner continues to rely on human beings as the ‘article[s].’” Dec. 15 n.9 (citing Pet. 58–59 (discussing the alternative reliance on Vertex as to clause D), 60 (discussing clause E)). The aspects of the Petition cited in Petitioner’s Request on Rehearing continue to support this statement.

In the discussion of element D in claims 1 and 7, and element F.i in claim 11, Petitioner summarizes the relevant claim language as requiring “the display of different perspective views of the same article.” Pet. 57 (citing Weadock Decl. ¶ 123). To address those elements, Petitioner *first* took the position that the “HTML code . . . shows that the VS Webpages disclose at least two perspective views of the same model (i.e., the same ‘article’), in that each of the thumbnails for some of the models show a photograph of that model from a different angle or perspective.” Pet. 58. Then, Petitioner states the *alternative* position that “[e]ven if the VS Webpages did not expressly disclose that each thumbnail image displayed is a different perspective view of the same article, implementing these elements in the system described by the VS Webpages would not require any additional experimentation or alteration of the underlying webpage architecture.” *Id.* According to Petitioner, “[t]he only change required would be to alter the images chosen for display such that the thumbnails

displayed embody different views of a single article, particularly as taught by the *Vertex* article.” *Id.* (citing Weadock Decl. ¶ 125).

Considering this discussion, as well as the other portions of the Petition summarized above (*see* Req. Reh’g 8) as a whole, Petitioner consistently took two *alternative* positions: (1) the images of the models in VS Webpages already satisfy the requirements recited in the claims and (2) in the alternative, the images in VS Webpages could be modified to *other* images of *a single model* that satisfy the requirements recited in the claims. *See, e.g.*, Pet. 58, 60, 66. For the alternative position, Petitioner ambiguously states that the images could be modified to “different views of a single *article*” (Pet. 58 (emphasis added)), but, as discussed in the Decision on Institution, Petitioner does not take the position that the images of the “article” would be of anything other than a human being. *See, e.g.*, Pet. 60 (stating, in the alternative with respect to element E in claims 1 and 7 and element F.ii in claim 11, that one of ordinary skill in the art “would merely need to replace the currently displayed images with images representing front, rear, side, or isometric views of a *particular article*” (emphasis added)), 66 (stating that one of ordinary skill in the art “would be applying the known technique of providing multiple thumbnail images for selection and ultimate display on a master display field, and applying that same technique to a set of thumbnail images which are unremarkably generated from various ‘view’ shots of a *particular article* such that a user is shown multiple views of a single item” (emphasis added)); *see also* Dec. 15 n.9 (“Even in the context of the *alternative* reliance on other prior art (such as *Vertex*) for this asserted ground, to modify VS Webpages with ‘different

views of a single article’ (Pet. 58), Petitioner continues to rely on human beings as the ‘article[s].’”).

Here, Petitioner did not previously argue—as asserted in the Request on Rehearing—that the challenged claims would have been obvious in view of the VS webpages “*even if*” the scope of term “article” did not include humans. Req. Reh’g 7–8. Accordingly, we could not have misapprehended or overlooked that issue.

Third, Petitioner argues that the Decision on Institution “errs as a matter of law because it assigns patentable weight to the subject of an image, which has no bearing on any alleged technical innovation.” Req. Reh’g 10. According to Petitioner, “[t]his violates the printed matter doctrine, is an erroneous interpretation of the law, and therefore is grounds for rehearing.” *Id.* (citing *Gose v. United States Postal Service*, 451 F.3d 831, 836 (Fed. Cir. 2006)). Petitioner argues that “because it is merely printed matter, the subject matter of the claimed image cannot provide a basis for distinguishing the challenged claims over the prior art.” *Id.* at 11; *see also id.* at 10–11 (arguing that “the only reason cited . . . for denying institution based on Ground 1 is that the images shown are of people, rather than, apparently, images of inanimate objects” (citing Dec. 15–18)).

A petitioner for *inter partes* review “has the 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) (citing 35 U.S.C. § 312(a)(3)). The statute “makes the petition the centerpiece of the proceeding both before and after institution.” *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1355, 1358 (2018). The determination as to the ground at issue was not due to the Board assigning patentable weight to the

subject of the recited “image[s],” but rather, was due to Petitioner’s failure to meet its burden to identify how the challenged claims are to be construed and then show a reasonable likelihood of prevailing in demonstrating that at least one of the challenged claims, *when construed as proposed*, is unpatentable. *See* 37 C.F.R. § 42.104(b)(2), (3).

Petitioner’s current argument—that the claim language addressing the subject matter of the recited “image[s]” is not entitled to patentable weight under the printed matter doctrine—was not presented in the Petition. Instead, Petitioner affirmatively proposed constructions for many of the claim terms describing the subject matter of the “image[s]”: “perspective view” (Pet. 33–34); “front,” “side,” and “rear” views (Pet. 34–35); “isometric” view (Pet. 35); and “article” (Pet. 40). For example, Petitioner stated that the parties “agree that the term ‘article’ should be construed to mean any ‘item’ of any type or class.” *Id.* at 40. Petitioner did not propose, even in the alternative, that any of this claim language (including “article”) was not entitled to patentable weight under the printed matter doctrine. *See generally* Pet. Because this issue was not presented in the Petition, we could not have misapprehended or overlooked it.

C. Asserted Obviousness of Claims 1, 2, 5–8, and 11 Based on Rao and Vertex & Asserted Obviousness of Claims 1, 2, 5–8, and 11 Based on Smith and Salas

In the Decision on Institution, we determined that the Petition did not show a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims in the other two asserted grounds presented in the Petition: the asserted obviousness of claims 1, 2, 5–8, and 11 based on (1) Rao and Vertex and (2) Smith and Salas. *See* Dec. 18–39. In the Request on Rehearing, Petitioner does not address these grounds.

D. Conclusion

For the reasons above, Petitioner has not shown that we misapprehended or overlooking any arguments or evidence in determining that the Petition did not show a reasonable likelihood of prevailing with respect to at least one of the challenged claims in any of the three asserted grounds of unpatentability.

III. ORDER

For the reasons above, it is:

ORDERED that Petitioner's Request on Rehearing is *denied*.

IPR2020-00853
Patent 8,078,498 B2

FOR PETITIONER:

Richard W. Miller (lead counsel)
Lynn E. Rzonca
Brian S.S. Auerbach
BALLARD SPAHR LLP
millerrw@ballardspahr.com
rzoncal@ballardspahr.com
auerbachb@ballardspahr.com

FOR PATENT OWNER:

Ryan Loveless (lead counsel)
Brett Mangrum
James Etheridge
Brian Koide
Jeffrey Huang
Jeffrey A. Stephens
ETHERIDGE LAW GROUP
ryan@etheridgelaw.com
brett@etheridgelaw.com
jim@etheridgelaw.com
brian@etheridgelaw.com
jeff@etheridgelaw.com
jstephens@etheridgelaw.com