

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVERY DENNISON RFID COMPANY and AVERY DENNISON
RETAIL INFORMATION SERVICES LLC,
Petitioner,

v.

EVERYTHING LIMITED,
Patent Owner.

IPR2021-00865
Patent 9,582,595 B2

Before NEIL T. POWELL, ROBERT L. KINDER, and SHARON FENICK,
Administrative Patent Judges.

FENICK, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Avery Dennison RFID Company and Avery Dennison Retail Information Services LLC (“Petitioner”) filed a Petition (Paper 3, “Pet.”) requesting *inter partes* review of claims 1–26 (the “challenged claims”) of U.S. Patent No. 9,582,595 B2 (“the ’595 patent”). Patent Owner EVRYTHING Limited filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2021). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless the Director determines . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons that follow, we do not institute an *inter partes* review as to the challenged claims of the ’595 patent.

II. BACKGROUND

A. *Real Parties in Interest*

Petitioner identifies that Avery Dennison RFID Company and Avery Dennison Retail Information Services LLC are subsidiaries of Avery Dennison Corporation. Pet. 9. Patent Owner identifies only itself as a real party in interest. Paper 4 (Patent Owner’s Mandatory Notices), 1.

B. *Related Matters*

Petitioner identifies *Avery Dennison RFID Company et al. v EVRYTHING Limited*, filed contemporaneously with the Petition by Petitioner in the District of Massachusetts as a related matter. Pet. 9–10.

Patent Owner also identifies this case as a related matter, and provides the case number 1:21-cv-10719-LTS. Paper 4, 1.

C. The '595 Patent (Ex. 1001)

The '595 patent is titled “Computer-Implemented Object Information Service and Computer-Implemented Method for Obtaining Information about Objects From Same,” and generally relates to “using a client application to access an online identity associated with an individual product.” Ex. 1001, code (54), 1:36–38. Figure 1a, reproduced below, shows exemplary system/framework 100 according to one embodiment of the invention. *Id.* at 2:3–4, 2:17–19.

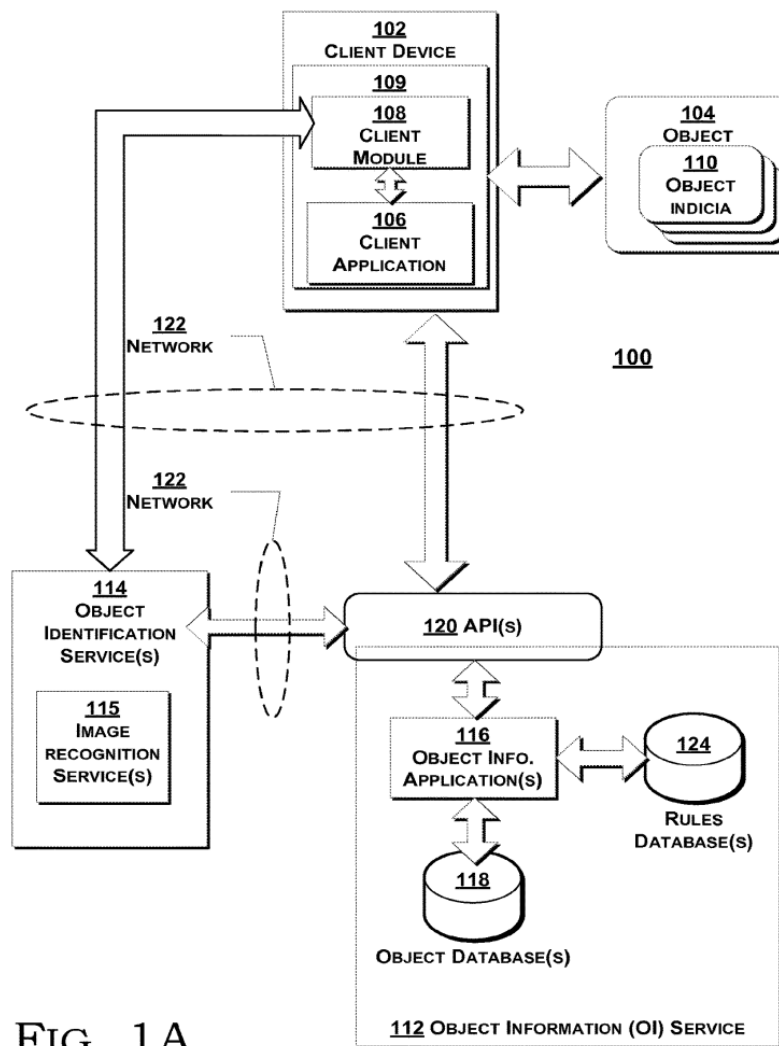


FIG. 1A

As seen in the embodiment of Figure 1A, in system/framework 100, client device 102 interacts with object 104, enabling client device to obtain/ascertain information about object 104, which may (among other things) be a physical item, a virtual item, a location, person, sound. *Id.* at 2:22–29, 2:34–37, 3:21–31. This interaction may be via a camera or other sensor on the client device 102. *Id.* at 2:29–33. Object 104 may include object indicia 110, which may be, for example, a serial number, Universal Product Code, radio frequency ID, or QR code. *Id.* at 1:52–55, 1:57, 3:32–47.

System/framework 100 additionally includes object information service 112, which generates, maintains, uses, and hosts information profiles that describe and store information about known objects. *Id.* at 3:55–62. Preferably, information about individual objects 104 is maintained in one or more object databases 118 of the object information service 112. *Id.* at :1–3. Each object 104 for which object information service 112 maintains information has a unique object identifier associated with it, and information about an object 104 within object information service 112 is preferably indexed on that unique object identifier, but could be indexed on other information or keys. *Id.* at 4:3–13, 4:19–22. API(s) 120 (Application Program Interface(s)) allow users to access the functionality of object information service 112. *Id.* at 1:44, 6:5–31. API requests allow creation and deletion of an object, and retrieval and updating of object information, in the object information service. *Id.* at 8:17–12:3.

System/framework 100 also includes object identification service 114 that is used to try to identify an object 104 and to provide the unique identifier for it. *Id.* at 4:49–60. Figure 3A, reproduced below, illustrates exemplary operation of system/framework 100. *Id.* 15:33–64.

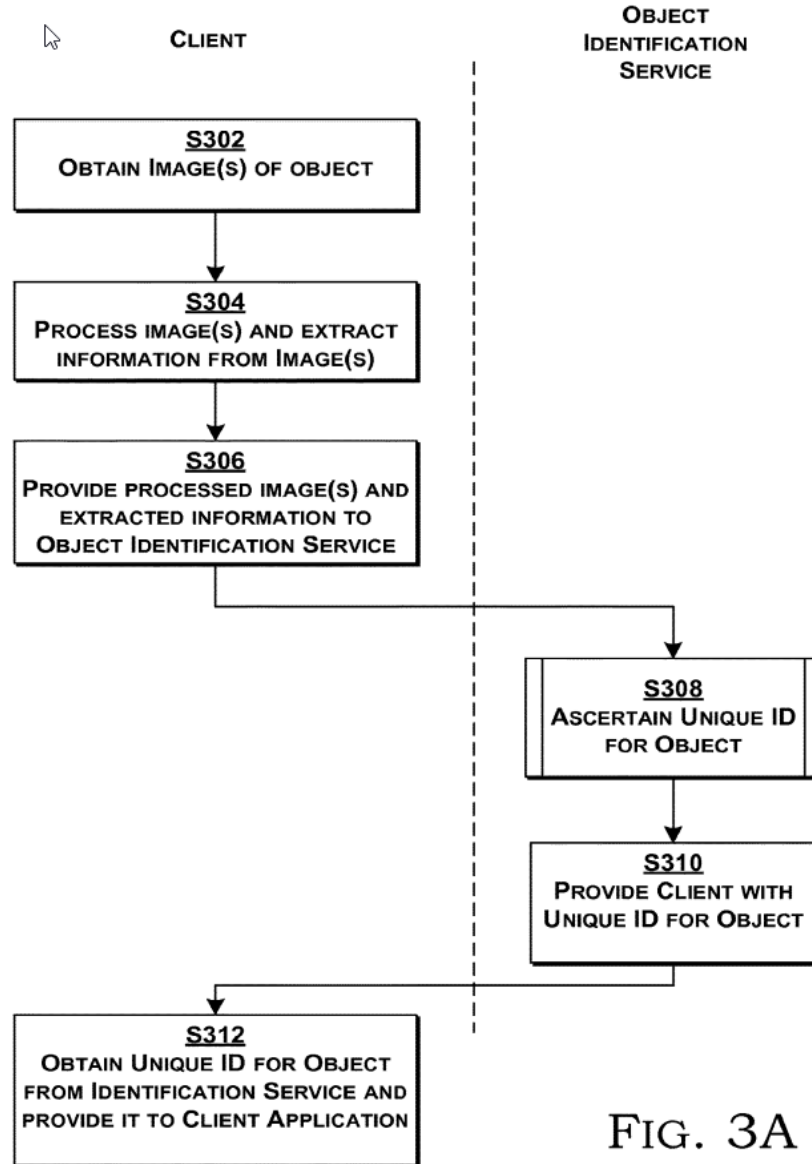


FIG. 3A

Figure 3A shows actions by a client and an object identification service by which the client can obtain the unique object identifier for an object. *Id.* at 15:38–64. As shown at block S302, the client obtains images of an object, possibly including object indicia. *Id.* at 15:41–44. The client then processes the images, extracts information from them, and provides some of this information to the object identification service, at blocks S304 and S306. *Id.* at 15:45–50. In block S308, the object identification service ascertains a unique object identifier for the object. *Id.* at 15:51–52. If the object

identification service does not know the unique object identifier for the object, it may provide information to the object information service in order to instantiate a new unique object identifier for the object. *Id.* at 15:51–52, 16:1–16, Fig. 3B. In blocks S310 and S312, the unique object identifier is returned from the object identification service to the client and the client provides a client application with that unique object identifier. *Id.* at 15:59–64.

The '595 patent describes two examples of use. In a first example, a user of a product may take a photo of a product with an indicium that is recognized in the photo. *Id.* at 16:57–63. A unique product identity for that object and user is then generated, and the user can then attach personalized multimedia content that can be shared. *Id.* at 16:63–67. In a second example, a user buys a bottle of wine with a scannable tag, and scans the bottle using a camera to take part in a contest. *Id.* at 17:1–7. The information on the tag allows the product to be verified as genuine and not yet entered in the contest, and the user can enter the contest. *Id.* at 17:7–10.

D. Illustrative Claims

Claim 1, reproduced below, is the only independent claim of the '595 patent and is representative.

1. A computer-implemented method, implemented by hardware in combination with software, operable on an object information service, said object information service comprising: (i) an object database, (ii) object information applications for maintaining and accessing information in said object database, and (iii) an Application Programming Interface (API) to said object information applications, said API being externally accessible, wherein said object data base maintains a persistent profile for each of a plurality of objects,

the method comprising:

- (a) obtaining, at a device, information about an object;
- (b) determining an identifier for the object from the information obtained in (a) by:
 - (b)(1) providing at least some of said information to an identification mechanism; and
 - (b)(2) obtaining an identifier for the object from an identification mechanism; and then
- (c) using the identifier and said API to add said object to said object information service, wherein the information service maintains a persistent online profile for the object in said object database, said profile being accessible at the information service using the identifier, and wherein the identifier for the object is unique within the information service; and then,
- (d) using the identifier and said API to access and store data about the object at said object information service.

Ex. 1001, 21:8–34.

E. Prior Art Relied Upon

Petitioner relies on the following references (Pet. 12):

Reference	Exhibit No.
Boncyk et al., US 2004/0208372 A1, pub. Oct. 21, 2004	Ex. 1007
Harris et al., US 2006/0200480 A1, pub. Sept. 7, 2006	Ex. 1012
Davis et al., US 2012/0208592 A1, pub. Aug. 16, 2012	Ex. 1014
Gentile et al., US 2013/0299569 A1, pub. Nov. 14, 2013	Ex. 1004
Mark Massé, <i>REST API Design Rulebook</i> (2012) (“Massé”)	Ex. 1008

The status of these references as prior art patent or printed publications is not currently contested by Patent Owner. *See* Prelim. Resp.

F. The Asserted Grounds of Unpatentability

Petitioner challenges the patentability of the claims on the following grounds, relying on a Declaration from Dr. Oded Gottesman (Ex. 1003).
Pet. 11–12, 35–85.

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
1–11, 13–18, 21–26	102	Gentile
1–11, 13–18, 21–26	103	Gentile, Massé
1–11, 13–18, 20–26	103	Gentile, Harris
1–11, 13–18, 21–26 ²	103	Gentile, Boncyk
1–11, 13–18, 20–26	103	Gentile, Massé, Boncyk
1–11, 13–18, 20–26	103	Gentile, Harris, Boncyk
1–26	103	Gentile, Davis
1–26	103	Gentile, Massé, Davis
1–26	103	Gentile, Harris, Davis

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. §§ 102 and 103 for applications filed on or after March 16, 2013. Petitioner argues that September 26, 2013 is the earliest possible effective date of the ’595 patent, and its expert uses this date in the analysis. Pet. 12–13; Ex. 1003 ¶ 36; *see* Ex. 1001, code (60). Patent Owner does not comment on whether this is correct. *See* Prelim. Resp. 7. For the purpose of institution, we apply the AIA version of 35 U.S.C. §§ 102 and 103. Our analysis and determination remain the same under either the pre- or post-AIA versions of 35 U.S.C. §§ 102 and 103.

² Petitioner presents this challenge as part of its Ground 4 and describes the ground as challenging claim 20, however the Petition does not appear to address claim 20 under a combination of Gentile and Boncyk.

III. ANALYSIS

A. *Legal Standards*

“In an [*inter partes* review], the petitioner 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) (requiring [*inter partes*] review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review). Furthermore, Petitioner must explain with particularity how the prior art would have rendered the challenged claims unpatentable. 35 U.S.C.A. § 312(a)(3); 37 C.F.R. § 42.104 (“The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”). Under 35 U.S.C. § 103(a), a claimed invention is unpatentable 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. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

A claim is unpatentable under 35 U.S.C. § 102 “if each and every [claim] limitation is found either expressly or inherently in a single prior art reference.” *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 851 F.3d 1270, 1273 (Fed. Cir. 2017) (citation omitted). “A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present.” *Akamai Techs., Inc. v. Cable & Wireless*

Internet Servs., Inc., 344 F.3d 1186, 1192 (Fed. Cir. 2003) (citing *Rosco, Inc. v. Mirror Lite, Co.*, 304 F.3d 1373, 1380 (Fed. Cir. 2002)).

A claim is unpatentable under 35 U.S.C. § 103 if the differences between the subject matter sought to be patented 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. *KSR*, 550 U.S. at 406. The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of nonobviousness, i.e., secondary considerations. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

B. Level of Ordinary Skill in the Art

Relying on the testimony of Dr. Gottesman, Petitioner contends that at the time of the effective filing date, a person of ordinary skill in the art “would have had a bachelor’s degree in computer science, electrical engineering, or a related field of study, and at least three years of experience with online web services, database systems, and/or related software applications.” Pet. 21–22 (citing Ex. 1003 at ¶ 127). Petitioner adds, “[t]his is an approximation and additional education (e.g., masters/doctorate degree(s)) could make up for less practical experience (and vice versa). *Id.* Patent Owner does not present a different proposal for level of skill or comment on Petitioner’s proposal. *See Prelim. Resp.*

For purposes of this Decision on Institution, we adopt Petitioner’s proposed level of ordinary skill in the art. This level of skill comports with the teachings of the ’595 patent and the asserted prior art.

C. Claim Construction

In an *inter partes* review, claims are construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b), including construing the claims in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b) (2020). We apply the claim construction standard as set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

Claim terms are generally given their ordinary and customary meaning as would be understood by one with ordinary skill in the art in the context of the specification, the prosecution history, other claims, and even extrinsic evidence including expert and inventor testimony, dictionaries, and learned treatises, although extrinsic evidence is less significant than the intrinsic record. *Phillips*, 415 F.3d at 1312–17. Usually, the specification is dispositive, and it is the single best guide to the meaning of a disputed term. *Id.* at 1315.

Only those terms that are in controversy need be construed, and only to the extent necessary to resolve the controversy. *Nidec Motor Corp.*, 868 F.3d at 1017 (citing *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Petitioner requested construction of the term “application programming interface (API),” which appears in challenged claims 1 and 9, and in all other challenged claims by virtue of dependency from challenged claim 1. Pet. 28–34. Petitioner additionally requests construction of the term “mechanism,” which appears in challenged claims 1 and 10–13, and in all challenged claims by virtue of dependency from challenged claim 1. *Id.*

at 34. Patent Owner also addresses the construction of API. Prelim. Resp. 10–15.

In this instance, we determine that no terms require construction to resolve the controversy.

D. Asserted Anticipation of Claims 1–11, 13–18, and 21–26 by Gentile

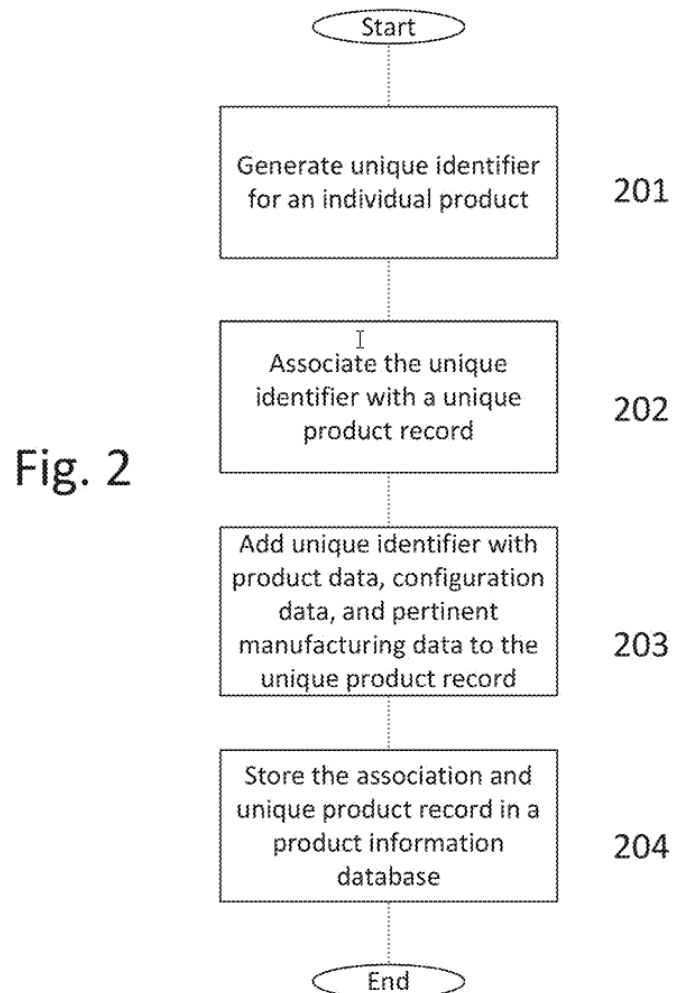
Petitioner argues that claims 1–11, 13–18, and 21–26 are anticipated by Gentile. Pet. 19–68. Patent Owner asserts certain deficiencies in Petitioner’s anticipation case. Prelim. Resp. 18–27.

1. Gentile

Gentile is titled “Method and System for Retrieving Information Using Serialized Scannable Codes,” and describes products with attached machine-readable unique identification tags, and the storage of information associated with the products. Ex. 1004, codes (54), (57). The tags allow easy retrieval of information specific to the individual products, such as registration and service functions. *Id.* ¶¶ 1, 10. For example, a QR code may be affixed to a window in a home, and the homeowner may use a code reader application on a cell phone to read the code. *Id.* ¶ 10. Based on the code, the homeowner may access information through a website associated with the product, which allows access to a record including the type or dimensions of the window, date of installation, and warranty information, among other data. *Id.* Generally, a product owner may use the system to obtain access to registration information, contact information, warranty information, recall information, or other product information; an installer may obtain access to installation information; a field service technician may obtain access to registration, service, or troubleshooting information. *Id.* ¶¶ 37–39.

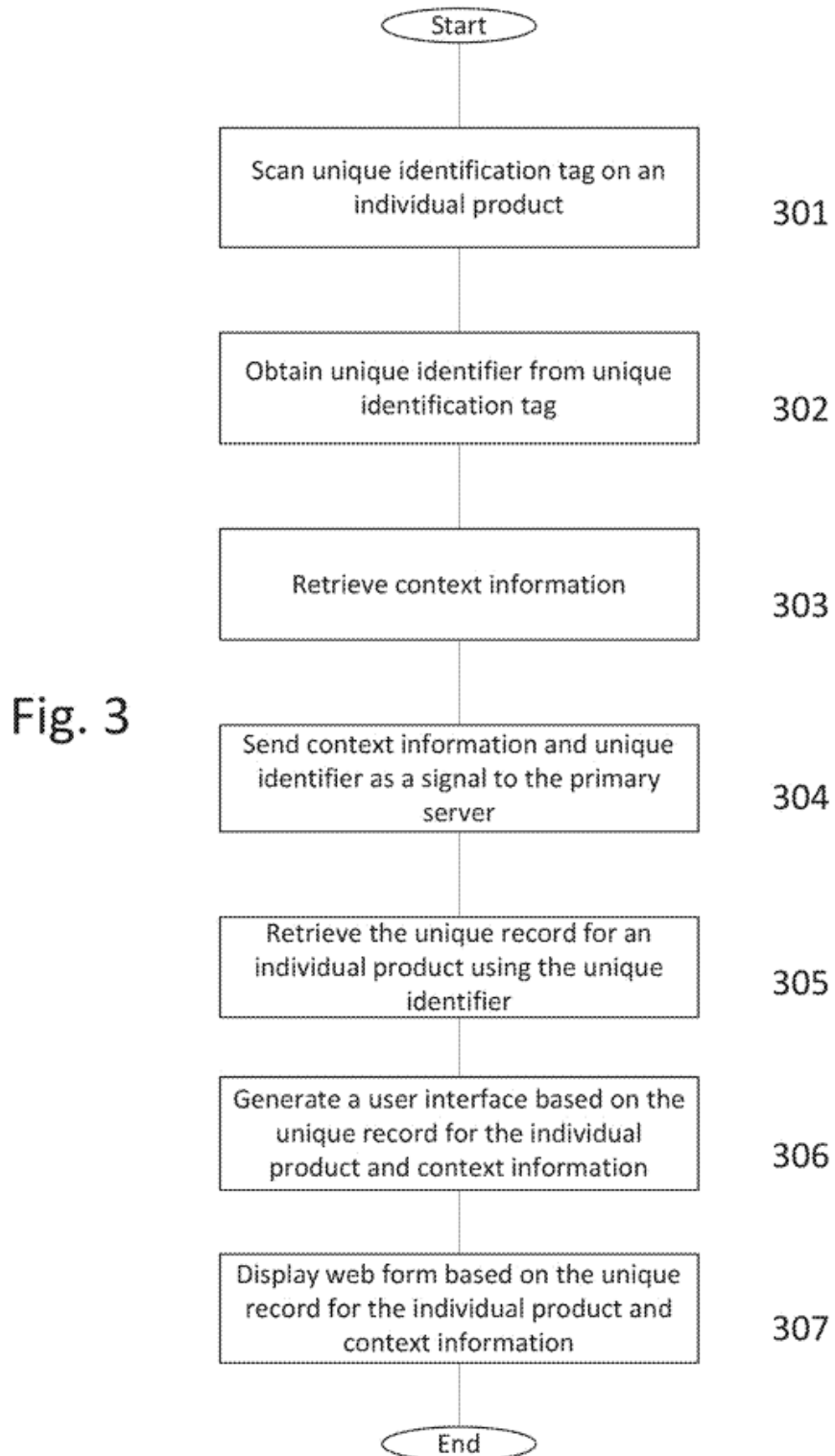
Gentile describes that, at the time of manufacturing of a product, a unique identification tag is created for the product and the unique identification tag is stored in a product information database, associated with a unique identifier, product information, customer information, and other information related to the product. *Id.* ¶ 59. Once the association between the product and the tag has been stored in the database, a scanning device can be used to scan the unique identifier from the tag and retrieve information related to the product from the database. *Id.* ¶¶ 60–62.

Figure 2, reproduced below, describes the process for creating an association between a unique product identifier and a database record. *Id.* ¶ 65.



As shown in Figure 2, at the time of manufacturing, a unique identifier is generated for the individual product, at step 201. *Id.* In step 202, the unique identifier is then associated with a unique product record that will only be used for the product associated with that identifier. *Id.* At the time that the association is made between the unique identifier and the unique record, additional information can be added to the record if available at the time of manufacture. *Id.* ¶ 66. “Once a unique identifier has been generated and associated with a unique product record, and any additional information has been added to the unique product record, the unique product record is stored in step 204.” *Id.* ¶ 68.

Figure 3, reproduced below, describes the process for scanning a unique identification tag and providing information based on the scan. *Id.* ¶ 69.



As shown in Figure 3, a scanning device is used to scan the identification tag and obtain a unique identifier from that tag, in steps 301 and 302. *Id.* ¶¶ 69–

70, 80. Additional context information, such as data about who is performing the scan, where the scan is being performed, or the software being used to perform the scan, is also gathered. *Id.* ¶¶ 70, 80. The scanning device sends the information to the primary server in step 304. *Id.* ¶¶ 70, 81. The primary server uses the unique identifier to retrieve the unique record from the database, which is used along with the context information to generate a user interface, which is sent to the scanning device, in steps 305–307. *Id.* ¶¶ 71–72, 82–83.

2. *Claim 1*

Petitioner contends that the method of claim 1 is anticipated by Gentile. Pet. 35–58. Patent Owner presents arguments countering certain aspects of these contentions. Prelim. Resp. 18–27.

a) Preamble and Steps (a) of Claim 1

Petitioner asserts that, to the extent the preamble is limiting, Gentile discloses the hardware and software set forth in the preamble, and the object database, in its system including a server and database. Pet. 35–37 (citing Ex. 1004 ¶¶ 14, 60–61, 64, 78, Fig. 5; Ex. 1003 ¶¶ 196–200). Petitioner argues that Gentile discloses object information applications for maintaining and accessing information in the database and an API to these object information applications in Gentile’s disclosure of applications that maintain and access database records and interfaces to access those applications. *Id.* at 37–41 (citing Ex. 1004 ¶¶ 13, 18–19, 62, 81, 77, 78, 97, Fig. 5; Ex. 1003 ¶¶ 201–214). Petitioner also argues that Gentile’s object database “maintains a persistent profile for each of a plurality of objects,” as recited in the preamble, as the product information database in Gentile stores a unique record associated with each product. *Id.* at 41–42 (citing Ex. 1004 ¶ 78; Ex. 1003 ¶ 215).

Claim 1 describes a method operable on an object information service, reciting a step of “(a) obtaining, at a device, information about an object.” Petitioner argues that this is disclosed in Gentile’s description of a user using a scanning device, such as a device with a camera, to obtain information about a product. *Id.* at 42 (citing Ex. 1004 ¶¶ 60; Ex. 1003 ¶¶ 217–218).

b) Steps (b) and (c) of Claim 1

The method of claim 1 additionally sets forth step (b), the step of “determining an identifier for the object from the information obtained in [step] (a) by” “providing at least some of said information to an identification mechanism” and “obtaining an identifier for the object from an identification mechanism.” Petitioner argues that this step is disclosed in Gentile’s extraction of a QR code from a QR tag on the object, arguing that in Gentile “the scanning device . . . extract[s] the unique identification information . . . from the identification tag.” *Id.* at 42–44 (citing Ex. 1004 ¶¶ 43, 60, 80; Ex. 1003 ¶¶ 219–226). Petitioner cites the QR code reader as disclosing the “identification mechanism” of step (b), arguing that in Gentile the QR code reader is provided image information (“at least some of said information”) from, e.g., a camera, and decodes the product identifier. *Id.* at 42–43 (citing Ex. 1004 ¶¶ 60, 84; Ex. 1003 ¶¶ 221–223). Petitioner argues that “obtaining an identifier for the object” is disclosed by Gentile’s QR code reader obtaining the unique product identifier from the image. *Id.* at 44 (citing Ex. 1004 ¶¶ 71, 80, 81; Ex. 1003 ¶¶ 224).

Step (c) of claim 1 recites that the identifier is used to add the object to the object information service. Petitioner argues that Gentile describes this in the initial association of a unique identifier with a product. Pet. 45–46 (citing Ex. 1004 ¶¶ 46, 65–67, Fig. 2; Ex. 1003 ¶¶ 227–231). Petitioner quotes Gentile’s disclosure that “[a]t the time the association between the

unique identifier and the unique record is made, additional information can be added at step 203.” *Id.* at 45 (quoting Ex. 1004 ¶ 66). Petitioner additionally cites Gentile’s disclosure that additional information added to the unique record could come from the manufacturer or a user’s scanning device. *Id.* (quoting Ex. 1004 ¶ 67). Petitioner quotes the disclosure that “[a] scanning device or similar smart device could be used for data collection and could also be used to add information such as GPS location or photos to the unique record.” *Id.* (quoting Ex. 1004 ¶ 67). Petitioner concludes “when the unique identifier and additional information (e.g., information from the scanning device) is sent to primary server 531 for storage in database 561 as unique record 562, both the identifier and the API are used to add the product to the database.”

Patent Owner argues that Gentile does not disclose using a scanned identifier to add the object to the object information service. Prelim. Resp. 23–26. Instead, Patent Owner argues, Gentile teaches that a manufacturer directly adds objects to its database, and that “[o]nce the association between product 103 and unique identification tag 104 has been stored in the product information database 108” then the scanning device can be used to retrieve the record. *Id.* at 25–26. Patent Owner asserts “[t]here is no disclosure that the adding of an object to the database is performed based on information obtained from the device.” *Id.* at 26.

We agree with Patent Owner. As Petitioner argues, Gentile does discuss the use of a scanner to add “additional information” to a unique record for an object, however, Gentile does not disclose the use of a scanner to read a unique identifier for an object during the creation of an association between the unique identifier and an object as required by the claims. *Id.* at 23–26; *see* Ex. 1004 ¶¶ 59–61, 65–72. Gentile discloses that “[a]t the time

of manufacturing, a unique identification tag 104 is created for product 103” and “stored in product information database 108.” Ex. 1004 ¶¶ 59, 65.

Gentile also discloses that at the time the product record associated with the identifier is stored, additional information can be added that could come from a scanning device. *Id.* ¶¶ 66–67. However, this “additional information” is disclosed as information in addition to the unique identifier. *Id.* ¶ 67. It is only after the initial association has been created that a scanner is disclosed in Gentile as being used to scan the unique identification tag on a product. *Id.* ¶¶ 61, 69–70.

The claim requires that a scan be performed to determine an identifier for an object, “and then” that the identifier is used to add the object to the object information service, but this is not disclosed by Gentile’s process of creating an association between a unique product identifier and a database record (as disclosed in Figure 2 of Gentile and related disclosure) or by Gentile’s process of scanning a unique product identifier to access an already extant record (as disclosed in Figure 3 of Gentile and related disclosure). Petitioner’s showing relies on elements from each of these two separate processes, for example relying on Gentile’s disclosures of a device scanning a QR code on an object to obtain the identifier (Pet. 42–44) for step (b) and then on the disclosures relating to the initial association of the identifier with a database record for step (c) (Pet. 45–47).

Gentile’s disclosures of scanning a QR code relied upon by Petitioner for step (b) describe the use of the scanned code “to locate and read the unique record . . . associated with the unique identifier found on [the] QR Code” and do not address adding a new record or suggest any possibility that the identifier might not yet be present in the database. Ex. 1004 ¶ 81.

For these reasons, we determine that Petitioner has not sufficiently shown how Gentile anticipates steps (b) and (c) of claim 1.

c) Conclusion – Claim 1

For the reasons above, therefore, we determine that Petitioner has not shown a reasonable likelihood of prevailing in showing claim 1 anticipated by Gentile.

3. Claims 2–11, 13–18 and 21–26

Petitioner’s arguments regarding the unpatentability of claims 2–11, 13–18 and 21–26 rely on the arguments made with respect to claim 1. Pet. 49–58. Therefore, for the same reasons, we determine that Petitioner has not shown a reasonable likelihood of prevailing in showing claims 2–11, 13–18, and 21–26 anticipated by Gentile.

E. Asserted Obviousness of Claims 1–11, 13–18, and 21–26 over Gentile and Massé

Petitioner’s arguments regarding the unpatentability of claims 1–11, 13–18, and 21–26 rely on the arguments made with respect to anticipation of claim 1 by Gentile. Pet. 58–62. Therefore, for the same reasons, we determine that Petitioner has not shown a reasonable likelihood of prevailing in showing claims 1–11, 13–18, and 21–26 would have been obvious over Gentile and Massé.

F. Asserted Obviousness of Claims 1–11, 13–18, and 20–26 over Gentile and Harris

Petitioner’s arguments regarding the unpatentability of claims 1–11, 13–18, and 20–26 rely on the arguments made with respect to anticipation of claim 1 by Gentile. Pet. 62–74. Petitioner does describe Harris as teaching a portion of step (c) of claim 1, however, Petitioner’s argument is that Harris teaches providing “product updates” in order to “update” the records in the

database. Pet. 68–70 (citing Ex. 1012 ¶¶ 112–113, Fig. 7B; Ex. 1003 ¶¶ 343–345). Petitioner argues that a product ID is included in such updates, and that therefore, “the product updates of Harris include ‘a unique identifier’ and are provided to the ‘product identification database’” via an API. *Id.* at 69–70. However, Petitioner does not provide any teaching that addresses the deficiency noted in the ground with respect to anticipation over Gentile – and there is no discussion of any teaching of Harris which, alone or in combination with Gentile, would describe the required determination of an identifier for an object that is unique within the information service, which is obtained at a device and then used to add an object to the object information service so as to be accessible using the unique identifier.

For this reason, and for the reasons described with respect to the anticipation of claim 1 by Gentile, we determine that Petitioner has not shown a reasonable likelihood of prevailing in showing claims 1–11, 13–18, and 21–26 would have been obvious over Gentile and Harris.

G. Asserted Obviousness over Combinations including Boncyk

Relying on arguments regarding anticipation by Gentile and obviousness over Gentile and Massé or Gentile and Harris, Petitioner argues that certain claims are unpatentable over a combination of Gentile and Boncyk (claims 1–11, 13–18, and 21–26), Gentile, Massé, and Boncyk (claims 1–11, 13–18, and 20–26), and Gentile, Harris, and Boncyk. Pet. 74–80. These arguments incorporate by reference the prior arguments, describing a different location for the identification mechanism of step (b) of claim 1. *Id.* Again, no teaching is identified that addresses the deficiency noted in the grounds upon which these arguments rely.

Therefore, for the reasons described with respect to the showings of anticipation by Gentile and obviousness over Gentile and Massé or Gentile and Harris, we determine that Petitioner has not shown a reasonable likelihood of prevailing in showing claims 1–11, 13–18, and 21–26 would have been obvious over Gentile and Boncyk, or that claims 1–11, 13–18, and 20–26) would have been obvious over Gentile, Massé, and Boncyk or over Gentile, Harris, and Boncyk.

H. Asserted Obviousness over Combinations including Davis

Relying on arguments regarding anticipation by Gentile and obviousness over Gentile and Massé or Gentile and Harris, Petitioner argues that claims 1–26 are unpatentable over a combination of Gentile and Boncyk, Gentile, Massé, and Boncyk, and Gentile, Harris, and Boncyk. Pet. 80–85. These arguments incorporate by reference the prior arguments, substituting an online identification mechanism and the generation of new identifiers for objects “on the fly” when identifying an object. Pet. 80–83. No teaching is identified that addresses the deficiency noted in the grounds upon which these arguments rely.

Therefore, for the reasons described with respect to the showings of anticipation by Gentile and obviousness over Gentile and Massé or Gentile and Harris, we determine that Petitioner has not shown a reasonable likelihood of prevailing in showing claims 1–26 would have been obvious over Gentile and Davis, over Gentile, Massé, and Davis, or over Gentile, Harris, and Davis.

IV. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(a)

Patent Owner argues that we should exercise discretion under 35 U.S.C. § 314(a) and deny institution. *See* Prelim. Resp. 1, 37–44. As we

have found that the Petitioner has not shown a reasonable likelihood that it would prevail on the merits, we do not address this argument.

V. CONCLUSION

After considering the evidence and arguments presented in the Petition and the Preliminary Response, we determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail with respect to at least 1 of the claims challenged in the petition. Accordingly, we do not institute an *inter partes* review.

VI. ORDER

Accordingly, it is

ORDERED that the Petition is denied as to all challenged claims of the '595 patent; and

FURTHER ORDERED that no *inter partes* review is instituted.

IPR2021-00865
Patent 9,582,595 B2

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