

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

PARUS HOLDINGS, INC.,
Patent Owner.

IPR2022-00279
Patent 6,721,705 B2

Before DAVID C. McKONE, PATRICK M. BOUCHER, and
STACEY G. WHITE, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

DECISION

Granting Petitioner's Request for Rehearing

37 C.F.R. § 42.71(d)

Granting Institution of *Inter Partes* Review

35 U.S.C. § 314(a)

I. INTRODUCTION

Google LLC (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–4 of U.S. Patent No. 6,721,705 B2 (Ex. 1001, “the ’705 patent”). Paper 1 (“Pet.”). Parus Holdings, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We denied the Petition and declined to institute an *inter partes* review. Paper 7 (“Decision” or “Dec.”). Specifically, we determined that Petitioner failed to establish a reasonable likelihood of prevailing with respect to at least one of the challenged claims under the following asserted grounds:

Claim(s) Challenged	35 U.S.C. § ¹	References
1, 2	103(a)	Kovatch, ² Burrows ³
1, 2	103(a)	Wise, ⁴ Burrows
3, 4	103(a)	Buchner ⁵
3, 4	103(a)	Buchner, Launey ⁶

Petitioner timely filed a Request for Rehearing of that Decision regarding the ground relying on the combination of Kovatch and Burrows. Paper 8 (“Rehearing Request” or “Reh’g Req.”); *see id.* at 3 n.6. Petitioner

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103(a). The ’705 patent was filed on February 5, 2001, claiming the benefit of the filing dates of two earlier provisional applications. Ex. 1001 at codes (22), (60). The pre-AIA version of § 103(a) thus applies, and neither party contends otherwise.

² WO 01/50453 A2 (Ex. 1004).

³ US 5,765,149 (Ex. 1006).

⁴ US 5,884,262 (Ex. 1007).

⁵ EP 0 911 808 A1 (Ex. 1008).

⁶ US 5,086,385 (Ex. 1009).

also requested that the Precedential Opinion Panel (“POP”) review the Decision. Paper 9; Ex. 3001. The POP denied that request, ordering that “the original panel maintains authority over all matters, including considering the submitted rehearing request.” Paper 10.

We subsequently authorized additional briefing. First, we invited Patent Owner to file a Response to the Rehearing Request (Paper 12, “Rehearing Response” or “PO Reh’g Resp.”). Second, the parties filed papers to address the relevance of an earlier final written decision involving the same parties and a related patent, *Google LLC v. Parus Holdings, Inc.* IPR2020-00846 (“the 846 IPR”), Paper 31 (PTAB Oct. 19, 2021) (Ex. 1030, “the 846 FWD”), *aff’d Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365 (Fed. Cir. 2023) (Ex. 1040, “*Parus*”).

For the reasons that follow, we grant Petitioner’s Rehearing Request and institute an *inter partes* review.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify specifically all matters we misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply. *Id.* When reconsidering a decision on institution, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment 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 heart of Petitioner's Rehearing Request arises from inconsistencies in factual findings related to Kovatch (1) as expressed in the Decision in this proceeding and (2) as expressed in the 846 FWD. The parties agree that the two decisions are in conflict on this point. PO Reh'g Resp. 1 (Patent Owner agreeing that, "[a]s Google suggests in its Rehearing Request, the PTAB's Final Written Decision in IPR2020-00846 . . . is at odds with the PTAB's Denial of Institution in IPR2022-00279"). As we describe below when elaborating on the specific nature of the conflict, the inconsistency arises, in part, from different emphases by the parties on the relevant factual issue in the different proceedings. Regardless, we agree that we overlooked that conflict when issuing our Decision in this proceeding.

III. BACKGROUND

A. The '705 Patent

The '705 patent relates to a "system that allows users to browse web sites and retrieve information by using conversational voice commands." Ex. 1001, 1:15–18. Figure 1 of the '705 patent is reproduced below.

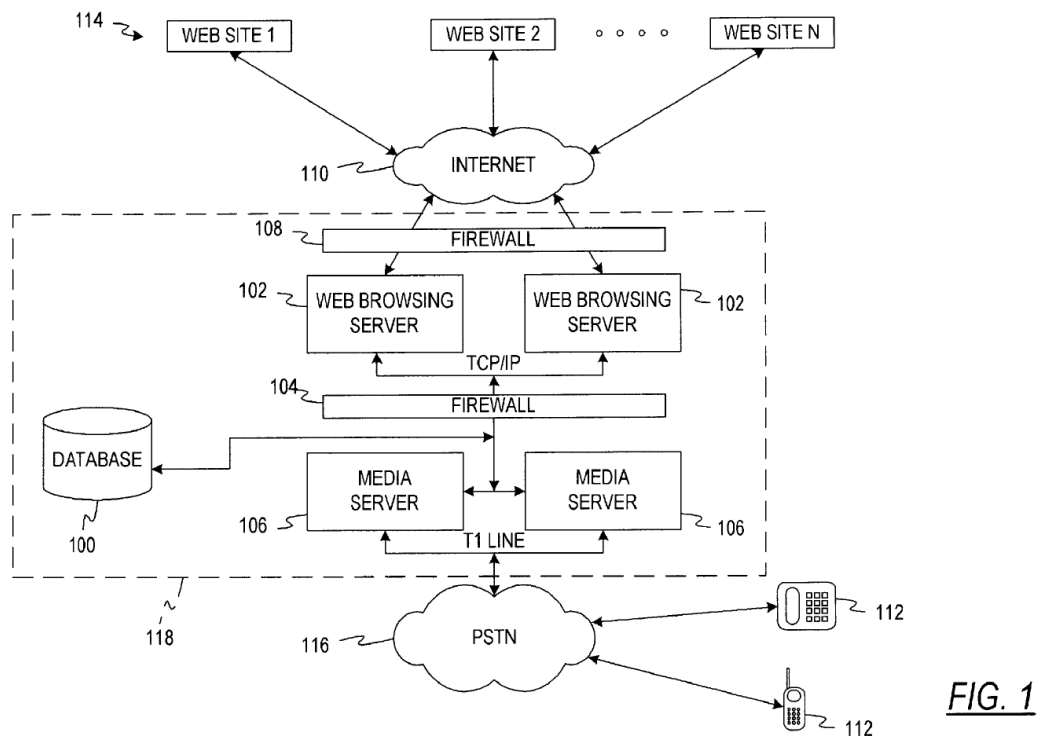


Figure 1 depicts a “voice browsing system.” *Id.* at 4:10–11. The system includes database 100 connected to web browsing servers 102 and media servers 106. *Id.* at 4:58–61. Web browsing servers 102 provide access to a network like Internet 110, via which web sites 114 may be accessed. *Id.* at 6:59–65.

Voice commands may be provided by a user to voice-browsing system 118 using public switched telephone network (“PSTN”) 116 and establishing a connection between the user’s voice enabled device 112 and media server 106. *Id.* at 15:31–37. Once the connection is established, media server 106 initiates an interactive voice response application that presents the user with a list of options based on the available web-site categories, from which the user makes selections by speaking into voice enabled device 112. *Id.* at 15:37–45. The user’s speech commands are converted into data messages that are sent to a “network interface system,”

such as a “web browsing server” that “then accesses the appropriate information source, such as a web site, to gather information requested by the user.” *Id.* at 4:46–52.

“A preferred embodiment of the voice browser system and method uses a web site polling and ranking methodology that allows the system to detect changes in web sites and adapt to those changes in real-time.” *Id.* at 3:52–55. Thus, database 100 contains a separate set of records for each web site accessible by the system, with each web site record containing (1) a “rank number” of the web site, (2) the associated uniform resource locator (“URL”) for the web site, (3) a timestamp indicating the last time the web site was accessed, and (4) a command that enables format-specific communication with the web site. *Id.* at 4:64–5:6. In addition, database 100 categorizes each database record according to the “type” (and perhaps subtype) of information provided by each web site, such as “weather” or “stock” information. *Id.* at 5:7–23. In responding to a user voice command, media server 106 uses recognition results generated by a speech-recognition engine to retrieve a web site record from database 100 that can provide responsive information, particularly the highest-ranked web site record in the appropriate category. *Id.* at 6:38–50.

A “polling mechanism continually polls or ‘pings’ each of the sites listed in the database 100.” *Id.* at 16:50–52. Web browsing server 102 sends brief data requests to each site listed in database 100 and monitors the response to determine whether it is complete and in the expected format. *Id.* at 16:52–59. Polled web sites that provide a complete response in the expected format “have their ranking established based on their ‘response time’” so that web sites with faster response times are ranked higher than

those with slower response times. *Id.* at 16:59–63. “If the web browsing server 102 receives no response from the polled web site or if the response received is not in the expected format, then the rank of that web site is lowered.” *Id.* at 16:63–66.

B. Illustrative Claim

Claim 1 is reproduced below as representative.

1. An Internet voice browsing system for gathering information from web sites on the Internet, comprising:

- a CPU-based media server, said media server including at least a speech recognition engine, a speech synthesis engine, an interactive voice response application, a call processing system, and telephony hardware, said media server configured to receive a speech command from a user and to convert said speech command into a digital data message;

- a database containing a list of web sites stored on magnetic media;

- a rank number assigned to each one of said web sites and stored in said database;

- a CPU-based web browsing server, said web browsing server including at least a content extraction agent, a content fetcher, a polling and ranking agent, and a content descriptor file, said web browsing server configured to receive said digital data message from said media server and configured to access one of said web sites having the highest said rank number and to retrieve information from said one of said web sites;

- said media server configured to generate an audio message representing said information and to transmit said audio message to said user; and

- a polling mechanism configured to periodically send a polling digital data message to each one of said web sites and to receive a response, each of said web sites thereby becoming a polled web site, said polling mechanism configured to decrease said rank number of said polled web site if no response is received from said polled web site, said polling mechanism also

configured to decrease said rank number of said polled web site if an unexpected response is received from said polled web site, and said polling mechanism also configured to decreases [sic] said rank number of said polled web site if a response time of said polled web site is longer than a second response time of a second polled web site.

C. Kovatch

Kovatch describes “interactive voice response systems for accessing information from a computer network via remote telephony devices.”

Ex. 1004, 1:9–12. Such systems are described with reference to the so-called “HeyAnita” system, which allows individuals to access the Internet through phone commands from a telephone. *Id.* at 5:25–28, 7:10–24.

Figure 1 of Kovatch is reproduced below.

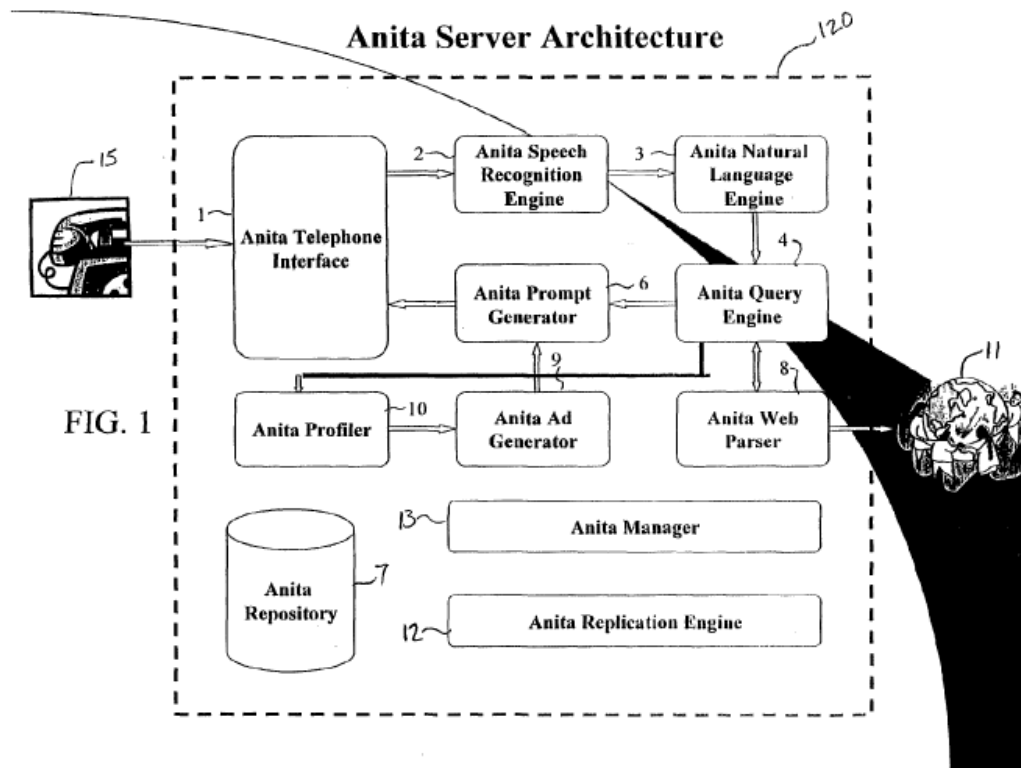


Figure 1 illustrates an architecture for the “Anita Server” 120, which implements the “HeyAnita Voice Platform.” *Id.* at 13:23–25. In this implementation, Anita Telephone Interface 1 “[i]mplements call management features such as ring and hangup detection, call switch-over, call transfer, call waiting and tromboning.” *Id.* at 14:20–21. Anita Speech Recognition Engine 2 “[t]ranslates spoken utterances to a set of text phrases,” which are input to Anita Natural Language Engine 3 for conversion to a set of structured commands. *Id.* at 14:30–15:3. Such structured commands drive Anita Query Engine 4, which maps commands to an application, such as to obtain weather information using the Yahoo! web site. *Id.* at 15:3–21.

Anita State Machine and Web Parser 8 retrieves information from web sites and other applications, including the retrieval of web pages from conventional web sites without requiring changes to such web sites. *Id.* at 15:23–31. For example, Anita State Machine and Web Parser 8 may pass a ZIP code to the Yahoo! web site, execute a form to retrieve results, and select and format the results without modification of the Yahoo! web site. *Id.* at 15:31–16:2. Anita Prompt Generator 6 converts text phrases to audio prompts “in natural human voice using concatenated speech fragments.” *Id.* at 16:19–23.

During each user session, Anita Query Engine 4 transfers relevant information to Anita Profiler 10, which “captures and filters this information to build a repository of user preferences, navigational history and usage patterns.” *Id.* at 16:6–8. Anita Manager 13 implements standard interfaces for remotely managing these and other Anita Server components. *Id.* at 17:11–15.

Figure 2 of Kovatch is reproduced below.

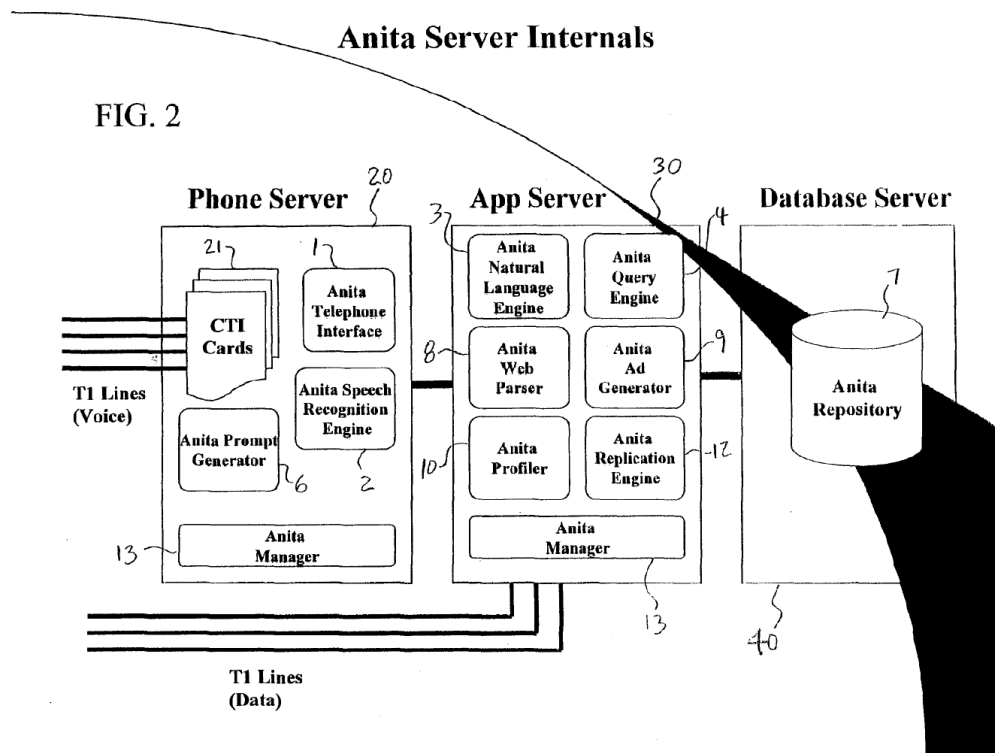


Figure 2 illustrates the logical structure of Anita Server 120, which includes three logical servers. *Id.* at 6:18. First, Anita phone server 20 implements a computer telephony interface with, *inter alia*, Anita telephone interface 1, Anita speech recognition engine 2, and Anita prompt generator 6 to connect digital lines to accept calls. *Id.* at 18:30–32. Second, Anita application server 30 implements applications with, *inter alia*, Anita natural language engine 3, Anita query engine 4, and Anita web parser 8. *Id.* at 19:1–3. Third, Anita database server 40 implements Anita repository database 7. *Id.* at 19:10.

Figure 4 of Kovatch is reproduced below.

FIG. 4

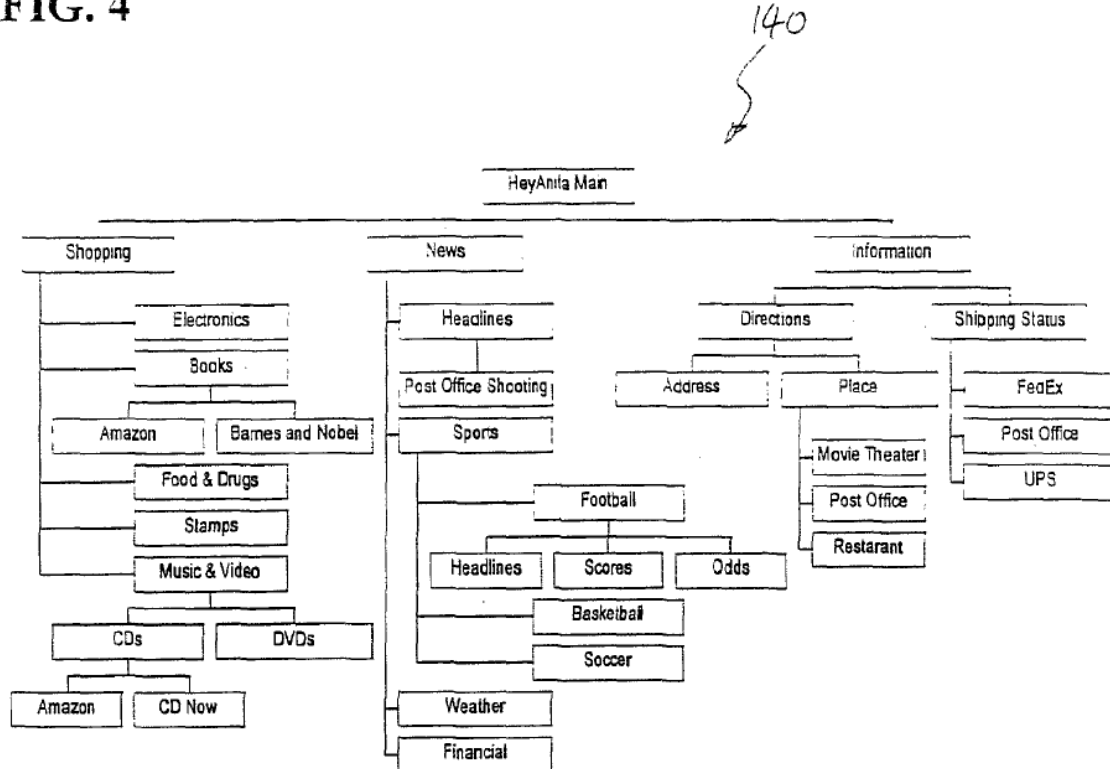


Figure 4 illustrates an embodiment of a tree structure to exemplify clarification questions that may be asked while narrowing a search. *Id.* at 6:23–24. Kovatch provides examples of such clarification questions for different scenarios, and explains that “[t]he way in which data is added and stored is also important [in] creating a navigable application via the Anita Prompt Generator 6.” *Id.* at 21:9–22:26.

D. Burrows

Burrows relates to “ranking records of a database which have been located by searching an index to the database, and more particularly to ranking the records for presentation based on the content of the records.” Ex. 1006, 1:5–8. Burrows particularly describes applications in which the database records are Internet web pages and in which a search engine

identifies pages of interest. *Id.* at 3:29–44, 3:56–61. Because of the large number web pages that can be qualified by search queries, Burrows expresses a “desire[] to present search results in a usable manner so that users are not burdened with perusing all qualifying records.” *Id.* at 1:47–49.

Figure 2 of Burrows is reproduced below.

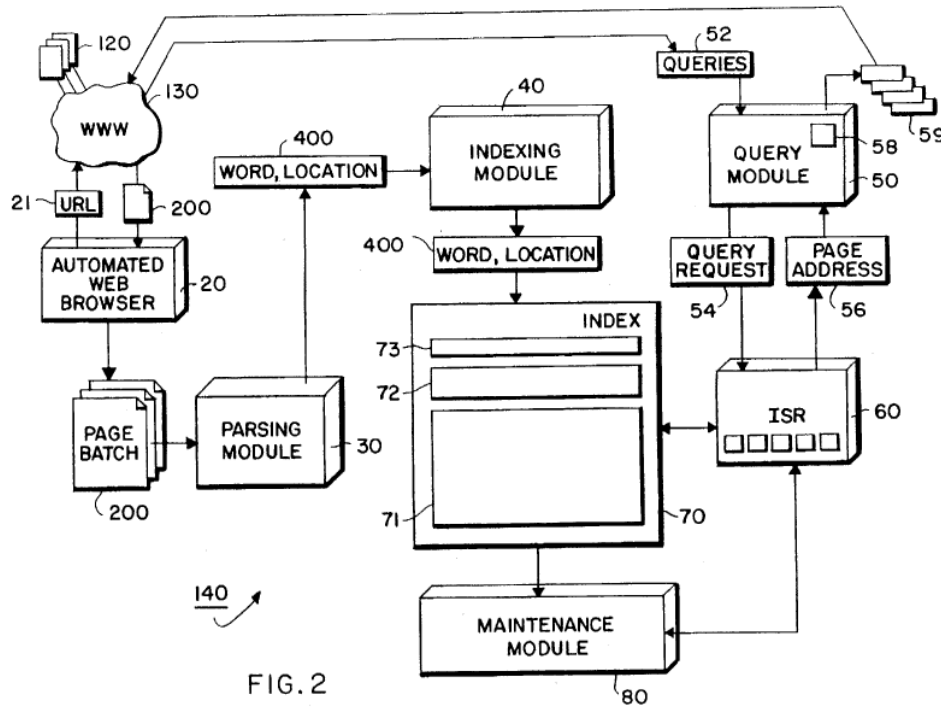


Figure 2 is a block diagram of a search engine, including an index. *Id.* at 2:27–28. Search engine 140 includes automated web browser 20, parsing module 30, indexing module 40, query module 50, index stream readers 60, index 70, and maintenance module 80. *Id.* at 4:9–13. Automatic web browser 20 periodically sends out requests 21 over network 130 so that sites 120 return records or pages 200. *Id.* at 4:16–20. Parsing module 30 breaks down portions of information of pages 200 into fundamental indexable elements or atomic pairs 400. *Id.* at 4:31–33. Indexing module 50 sorts pairs 400 to generate index 70. *Id.* at 4:46–48.

Query module 50 analyzes queries 52 provided by users to generate query requests 54, which invoke index stream readers 60 to sequentially scan data structures 71–73 within index 70. *Id.* at 5:15–16, 5:25–31. Addresses 56 of pages qualified by the queries are thereby identified so that information 59 about the qualifying pages may be delivered to users by presentation module 58. *Id.* at 5:32–35.

Because the number of pages indexed by search engine 140 may be large, “there needs to be a way to rank order the list in a meaningful manner.” *Id.* at 27:23–29. Ranking may be performed by assigning a weight w to each indexed word, with a score W for a page being equal to the sum of the weight w for each occurrence of a word specified in the query (or does not appear if an exclusionary query was used). *Id.* at 27:35–39.

Figure 22 of Burrows is reproduced below.

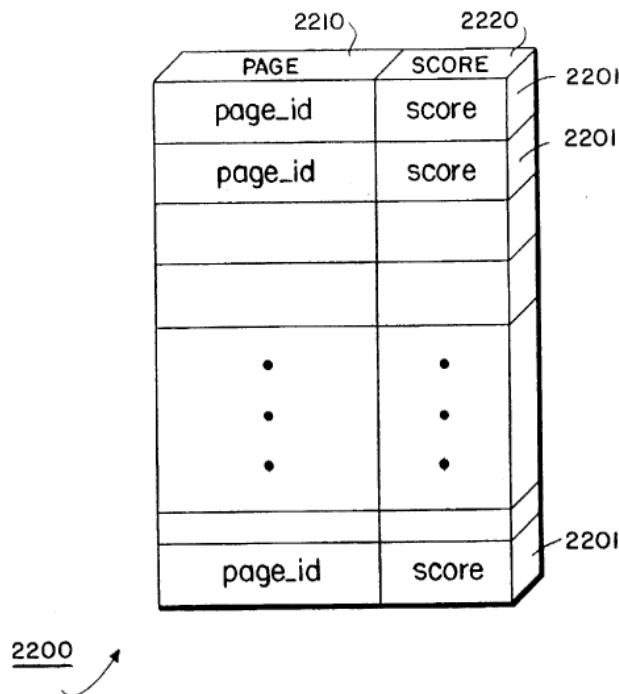


Figure 22 is a block diagram that illustrates a ranking list of qualified pages, with each entry 2201 including identification 2210 of a qualified page and

score 2220 associated with that qualified page. *Id.* at 2:66, 28:19–24.
Entries 2201 are maintained in rank order according to scores 2220.

E. The 846 IPR

1. The Board's Decision

The 846 FWD held all challenged claims of U.S. Patent No. 7,076,431 B2 (“the ’431 patent”) unpatentable. Ex. 1030, 65. Two factual findings made in that decision bear on the issue currently before us in the instant proceeding.

First, certain dependent claims of the ’431 patent include limitations directed at rankings associated with the order in which web site addresses are accessed: claim 10 recites that “said instruction set further comprises *a ranking associated with each said web site address*, . . . indicating the order in which the plurality of pre-selected web sites are accessed” and claim 13 recites that “said computer is configured *to access said plurality of web sites in order of ranking* to retrieve said information requested by said user, [and] to first *access said web site having the highest ranking*.” 846 IPR, Ex. 1001, 21:8–11 (emphasis added), 21:25–29 (emphases added). Both of these dependent claims were challenged by Petitioner in the 846 IPR, and, when addressing those claims, the 846 FWD found that “Kovatch teaches a ranking associated with web site addresses indicating the order in which to access a plurality of pre-selected web sites, for example ranking Amazon’s web site over that of CD Now and accessing those web sites in that order.” Ex. 1030, 47 (citing Ex. 1004, 16:28–34, 19:8–10, 23:25–29).

Second, the 846 FWD found that “Kovatch teaches accessing multiple pre-selected web sites.” *Id.* at 38. The Board arrived at that finding in light

of a scenario described in Kovatch where a “user wants HeyAnita to find the best price for an item from two websites.” *Id.* (citing, *inter alia*, Ex. 1004, 20:30–21:3).

The record in the 846 IPR did not include specific arguments by Patent Owner on the correct understanding of Kovatch’s teachings with respect to rankings associated with the order in which web site addresses are accessed. *See id.* at 48 (“Patent Owner does not present separate arguments challenging Petitioner’s allegations for claims 2, 4–7, 10, 13, and 14.”).

2. *The Federal Circuit Appeal*

Another issue raised during the 846 IPR was whether Kovatch is prior art to the challenged claims of the ’431 patent, with Patent Owner contending that the inventors conceived of their invention earlier than Kovatch’s earliest priority date. *Id.* at 12–25. Because Patent Owner failed to comply with 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated by reference from one document into another document.”), the Board “disregard[ed] Patent Owner’s arguments that the inventors conceived of and reduced to practice the invention claimed in the ’431 patent prior to the earliest priority date of Kovatch,” and “conclude[d] that Kovatch is prior art to the ’431 patent.” *Id.* at 25 (citations omitted).

When appealing the 846 FWD to the Federal Circuit, Patent Owner again did not challenge the factual finding related to rankings associated with the order in which web site addresses are accessed; instead, Patent Owner argued against the Board’s conclusion that Kovatch is prior art to the challenged claims of the ’431 patent. *Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1370 (Fed. Cir. 2023) (summarizing Patent Owner’s “two

main arguments on appeal: (1) that the Board erred in holding that Kovatch qualified as prior art because it improperly declined to consider Parus's arguments and evidence regarding antedating, and (2) that the Board erred in holding that the challenged claims lack written description support and were therefore not entitled to their earlier priority date"); *see also* Paper 13, 2 (Petitioner stating that "Parus appealed the Board's decision to the Federal Circuit but did not challenge this finding of fact. It instead argued that Kovatch did not qualify as prior art."). The Federal Circuit affirmed the Board's holding that Kovatch qualifies as prior art to the '431 patent, explaining that "we do not find the Board's decision to disregard Parus's alleged evidence and argument of antedating to be a violation of the [Administrative Procedure Act] or any other provision of law." *Parus*, 70 F.4th at 1373.

F. The Decision in the Instant Proceeding

The factual issue of whether Kovatch discloses rankings associated with the order in which web site addresses arises again in the instant proceeding. But, unlike in the 846 IPR, here, Patent Owner presents arguments in the instant proceeding addressing that factual issue. Specifically, independent claim 1 of the '705 patent recites "a rank number assigned to each one of said web sites and stored in said database," and independent claim 2 similarly recites "assigning a rank number to each of said web sites and storing said rank number in said database." Ex. 1001, 19:58–59, 20:22–23. In the Decision, we credited Patent Owner's argument that Petitioner "makes no consideration for the use of the Kovatch tree by multiple users." Dec. 24–25. But in doing so, according to Petitioner, we

“overlook[ed] one of the scenarios expressly relied on in the 846FWD to find that Kovatch teaches accessing multiple websites.” Reh’g Req. 6. Petitioner adds that we consequently “focused only on other scenarios disclosed by Kovatch, and ignored the multi-website teaching of Kovatch explained in the 846FWD.” *Id.*

IV. ANALYSIS

The parties, and we, agree that the Decision in this proceeding and the 846 FWD are inconsistent. Fundamentally, that inconsistency arises, at least in part, from different understandings of what Kovatch teaches with respect to rankings associated with the order in which web site addresses are accessed. *See* PO Reh’g Resp. 5 (Patent Owner acknowledging that Petitioner “suggests that the findings of the 846FWD are correct,” and Patent Owner contending that “[t]he opposite is true and obvious when the proper understanding of Kovatch is considered”).

But, as Petitioner aptly summarizes, the parties “disagree on the proper remedy,” with Patent Owner “ask[ing] the current panel to maintain its decision despite the conflict” and Petitioner “ask[ing] the current panel to grant rehearing of its decision to resolve the conflict.” Paper 13, 1. More specifically, Petitioner contends that “collateral estoppel also applies” such that Patent Owner “cannot relitigate the issues from the prior case.” *Id.* Based on the preliminary record before us, we agree with Petitioner.

“It is well established that collateral estoppel applies to IPR proceedings.” *Google LLC v. Hammond Dev. Int’l, Inc.*, 54 F.4th 1377, 1381 (Fed. Cir. 2022). Collateral estoppel in *inter partes* reviews “is not limited ‘to patent claims that are identical. Rather, it is the identity of the

issues that were litigated that determines whether collateral estoppel should apply.”” *Nestle USA, Inc. v. Steuben Foods, Inc.*, 884 F.3d 1350, 1352 (Fed. Cir. 2018) (quoting *Ohio Willow Wood Co. v. Alps S., LLC*, 735 F.3d 1333, 1342 (Fed. Cir. 2013)).

The party seeking to invoke collateral estoppel must show: “(1) the issue is identical to one decided in the first action; (2) the issue was actually litigated in the first action; (3) resolution of the issue was essential to a final judgment in the first action; and (4) [the party against who collateral estoppel is being asserted] had a full and fair opportunity to litigate the issue in the first action.”

Google, 54 F.4th at 1381. Each of these requirements appears to be met with respect to the issue of whether Kovatch discloses rankings associated with the order in which web site addresses are accessed. First, the claim limitations at issue in the two proceedings are sufficiently similar to raise the issue of collateral estoppel. *See Ohio Willow Wood*, 735 F.3d at 1342 (“If the differences between the unadjudicated patent claims and adjudicated patent claims do not materially alter the question of invalidity, collateral estoppel applies. . . . Thus, the mere use of different words in these portions of the claims does not create a new issue of invalidity.”). For example, claim 1 of the ’705 patent recites “a rank number assigned to each one of said web sites and stored in said database” and “access[ing] one of said web sites having the highest said rank number,” while claim 10 of the ’431 patent recites “a ranking associated with each said web site address, said ranking indicating the order in which the plurality of pre-selected web sites are accessed.” Ex. 1001, 19:58–59, 19:65–66; 846 IPR, Ex. 1001, 21:9–11.

Second, “where a question of fact is put in issue by the pleadings, and is submitted to the jury or other trier of facts for its determination, and is

determined, that question of fact has been ‘actually litigated.’” *James Talcott, Inc. v. Allahabad Bank, Ltd.*, 444 F.2d 451, 459–60 (5th Cir. 1971). In addressing this prong, Patent Owner contends that collateral estoppel does not apply because Patent Owner presented no separate arguments during the 846 IPR regarding the patentability of claims 10 and 13 of the ’431 patent (which recite the ranking limitations identified above). Paper 15, 1. But the fact that Patent Owner chose not to introduce any evidence or argument on the issue does not change the fact that the factual issue was “actually litigated” in the 846 IPR. *See Nichols & Co. v. U.S.*, 586 F.2d 826, 829 (CCPA 1978) (“[A]n issue is actually litigated for purposes of collateral estoppel even though the determination is based on a failure of proof.”); *see also Peck v. Comm’r of Internal Revenue*, 904 F.2d 525, 530 (9th Cir. 1990) (“If [the party’s] case was not effectively presented at the first trial it was their fault; affording them a second opportunity in which to litigate the matter, with the benefit of hindsight, would contravene the very principles upon which collateral estoppel is based and should not be allowed.”) (quoting *Jones v. U.S.*, 466 F.2d 131, 136 (10th Cir. 1972)).

Third, resolution of the issue of whether Kovatch discloses rankings associated with the order in which web site addresses are accessed was essential to the final judgment in the 846 IPR. *See* Ex. 1030, 47 (citing Ex. 1004, 16:28–34, 19:8–10, 23:25–29) (“Kovatch teaches a ranking associated with web site addresses indicating the order in which to access a plurality of pre-selected web sites, for example ranking Amazon’s web site over that of CD Now and accessing those web sites in that order.”).

Fourth, Patent Owner had a full and fair opportunity to litigate the factual issue in the 846 IPR. Patent Owner filed both a Patent Owner

Response and a Sur-reply, but chose not to dispute Petitioner's evidence on this point. *See* 846 IPR, Papers 14, 24.

For purposes of this Decision, we thus make a preliminary determination that collateral estoppel precludes Patent Owner from relitigating the issue of whether Kovatch teaches a ranking associated with web site addresses indicating the order in which to access a plurality of pre-selected web sites. In challenging independent claims 1 and 2 as unpatentable under 35 U.S.C. § 103(a) over Kovatch and Burrows, the Petition presents an element-by-element analysis to support its position. Pet. 14–32. That analysis relies on Kovatch's disclosure of the Hey Anita system for accessing web sites to retrieve information a user requested, and relies on Burrows for disclosure of a system for ranking database records that are "presented to the users in a rank order where the pages having a higher rank are presented first." *Id.* at 12–13 (citing Ex. 1006, 27:28–32, 32:14–47). Petitioner reasons that a person of ordinary skill in the art "would have found it obvious to apply Burrows's numbered ranking and polling approach to Kovatch's destination tree to better identify and present the records of the most interest to the user." *Id.* at 13 (citing Ex. 1006, 3:56–58). In particular, because Burrows explains that "there needs to be a way to rank order the list in a meaningful manner," Petitioner reasons that a person of ordinary skill in the art "would have been motivated to apply Burrows's numbered ranking to Kovatch's destination tree web pages to provide those of interest first." *Id.* (citing Ex. 1002 ¶ 115); Ex. 1006, 27:28–29.

Petitioner's element-by-element analysis explains Petitioner's position as to how each limitation of independent claims 1 and 2 is met within such a combination. *Id.* at 14–32. Although Patent Owner makes a number of

arguments in its Preliminary Response why the combination does not meet certain limitations, those arguments are precluded by our preliminary determination that collateral estoppel applies. *See* Prelim. Resp. 29–44.⁷

We have thus re-evaluated the parties’ arguments in light of the findings made in the 846 IPR, and affirmed by the Federal Circuit, and we conclude that Petitioner demonstrates a reasonable likelihood of prevailing on its challenge of independent claims 1 and 2 as unpatentable under 35 U.S.C. § 103(a) over Kovatch and Burrows. We accordingly grant Petitioner’s Rehearing Request and institute an *inter partes* review of all claims on all grounds asserted in the Petition.⁸ *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); 37 C.F.R. § 42.108(a).

⁷ Patent Owner’s Preliminary Response also argues that we should exercise our discretion under 35 U.S.C. § 314(a) to deny the Petition in light of the state of related litigation between the parties. Prelim. Resp. 26–28. Patent Owner did not renew that argument in its authorized Response to Petitioner’s Request for Rehearing, and neither party has taken steps to apprise us of relevant developments in the related litigation. The framework for evaluating such arguments notably cautions that “[o]ther facts and circumstances may also impact the Board’s discretion to deny institution.” *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 at 16 (PTAB March 20, 2020) (precedential). Although we have considered the parties arguments as set forth in the Petition and Preliminary Response, the issues we discuss herein prompts us to decline to deny the Petition on a discretionary basis.

⁸ In its Rehearing Request, Petitioner “withdraws its challenges with respect to [claims 3 and 4], and seeks rehearing only as to Claims 1 and 2.” Reh’g Req. 3 n.6. We have limited our analysis on rehearing to the Kovatch-Burrows challenge of claims 1 and 2. *See Samsung Electronics Co. Ltd. v. Neonode Smartphone LLC*, IPR2021-00144, Paper 26 at 9 n.11 (PTAB Dec. 3, 2021) (granting petitioner’s rehearing request and acknowledging withdrawal of other grounds); *id.*, Paper 59 at 8 (PTAB Dec. 15, 2022) (limiting scope of *inter partes* review in accordance with stipulation by the parties).

IV. ORDER

In consideration of the foregoing, it is

ORDERED that Petitioner's Request for Rehearing is *granted*;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is hereby instituted as to claims 1–4 of the '705 patent on all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, commencing on the entry date of this Decision.

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