

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

PARUS HOLDINGS, INC.,
Patent Owner.

IPR2022-00523
Patent 8,185,402 B2

Before THU A. DANG, PATRICK M. BOUCHER, and
STACEY G. WHITE, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

A. *Background*

In response to a Petition (Paper 2, “Pet.”) filed by Google LLC (“Petitioner”), we instituted *inter partes* review of claims 1–15 (“the challenged claims”) of U.S. Patent No. 8,185,402 B2 (Ex. 1001, “the ’402 patent”). See Paper 7 (“Dec. Inst.”). During trial, Parus Holdings, Inc. (“Patent Owner”) filed a Response (Paper 12, “PO Resp.”), to which Petitioner filed a Reply (Paper 18, Pet. Reply”). In turn, Patent Owner filed a Sur-reply. Paper 21 (“PO Sur-reply”). An oral hearing was held with the parties on May 4, 2023. A transcript of the hearing has been entered into the record. Paper 31 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of the claims on which we instituted trial. Based on the record before us, Petitioner has shown by a preponderance of the evidence that claims 1–15 of the ’402 are unpatentable.

B. *Related Proceedings*

The parties identify the ’402 patent as the subject of the following related district court matters: (i) *Parus Holdings, Inc. v. Samsung Electronics America, Inc.*, No. 6:21-cv-01073 (W.D. Tex.); (ii) *Parus Holdings, Inc. v. Apple Inc.*, No. 6:21-cv-00968 (W.D. Tex.); (iii) *Parus Holdings, Inc. v. Microsoft Corp.*, No. 6:21-cv-00570 (W.D. Tex.); and (iv) *Parus Holdings, Inc. v. Google, LLC f/k/a Google Inc.*, No. 6:21-cv-00571 (W.D. Tex.) (“the related district court litigation”). Pet. 13; Paper 5, 2.

The '402 patent also is challenged by a different petitioner in IPR2022-00804. *Microsoft Corp. v. Parus Holdings, Inc.*, IPR2022-00804, Paper 1. In addition, Petitioner identifies the following *inter partes* reviews as involving patents related to the '402 patent: IPR2020-00686, IPR2020-00687, IPR2020-00846, IPR2020-00847, IPR2022-00137, IPR2022-00279, IPR2022-00355, and IPR2022-00358. Pet. 14–15.

C. The '402 Patent

The '402 patent, titled “Robust Voice Browser System and Voice Activated Device Controller,” issued on May 22, 2012, from Application No. 12/973,475 filed on December 20, 2010, which is a continuation of Application No. 12/030,556 filed on February 13, 2008, which is a continuation of Application No. 11/409,703 filed on April 24, 2006, which is a continuation of Application No. 10/821,690 filed on April 9, 2004, which is a continuation of Application No. 09/776,996 filed on February 5, 2001, which in turn claims priority to the filing date of provisional Application No. 60/180,344 filed on February 4, 2000. Ex. 1001, codes (54), (45), (21), (22), (63), (60).

The '402 patent relates to a system for acquiring information from sources on a network, such as the Internet, comprising a voice browsing system that maintains a database containing a list of information sources, such as websites, wherein each of the information sources is assigned a rank number listed in the database. *Id.* at code (57). In response to a speech command received from a user, a network interface system accesses the information source with the highest rank number in order to retrieve information requested by the user. *Id.* Figure 1 of the '402 patent is reproduced below.

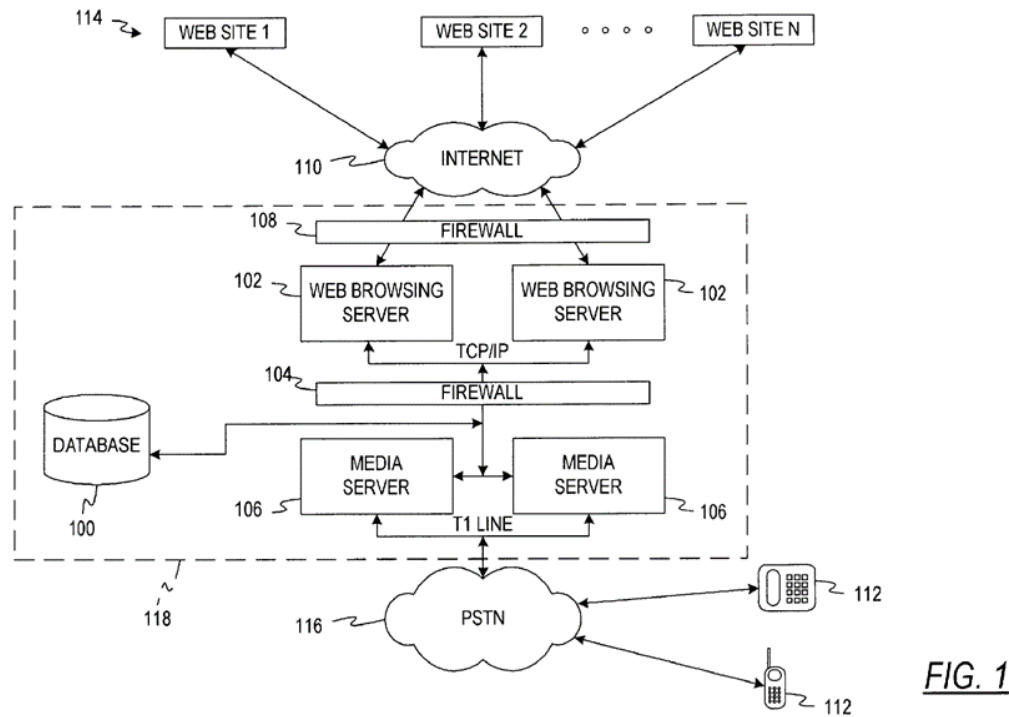


FIG. 1

Figure 1 depicts a “voice browsing system.” *Id.* at 4:16–17. As shown in Figure 1, the system includes database 100 connected to web browsing servers 102 and media servers 106. *Id.* at 4:64–67. Web browsing servers 102 provide access to a network like Internet 110, via which websites 114 may be accessed. *Id.* at 6:63–7:2.

A user establishes a connection between the user’s voice enabled device 112 and media server 106 using public switched telephone network (“PSTN”) 116 by calling a telephone number associated with voice browsing system 118. *Id.* at 19:1–6. 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 19:6–14. Using a speech recognition engine, the user’s voice 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 website, to gather information requested by the user. *Id.* at 4:49–58.

The voice browser system maintains database 100 containing a list of information sources, such as websites, wherein each information source is assigned a rank number listed in the database along with the record for the information source. *Id.* at 4:64–5:3. Referring to Figure 1, database 100 contains a separate set of records for each website accessible by the system. *Id.* at 5:3–4. Figure 2, reproduced below, illustrates an example of website record 200 in database 100. *Id.* at 4:18–19, 5:4–5.

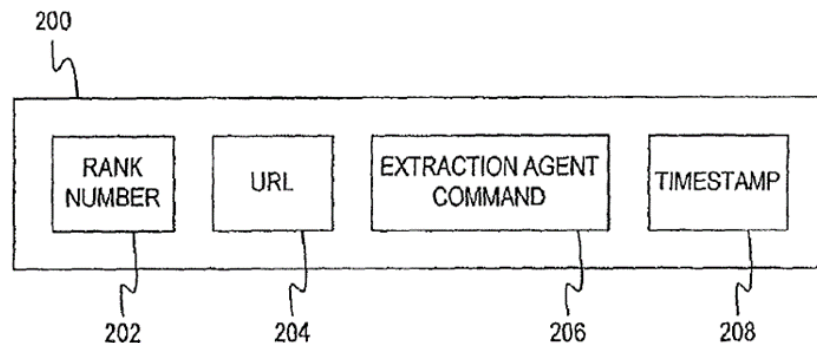


FIG. 2

Figure 2 illustrates an example of a website record in database 100. *Id.* at 4:18–19, 5:4–5. As shown in Figure 2, each website record 200 contains rank number 202 of the website, associated Uniform Resource Locator (URL) 204 for the website, and command 206 that enables an extraction agent to generate proper requests to the website and to format data received from the website. *Id.* at 5:5–10.

Database 100 categorizes each website record 200 according to the “type” of information provided by each website, wherein these categories may be further divided into subcategories. *Id.* at 5:14–29. For each category searchable by a user, database 100 may list several websites, each

with different rank number 202. *Id.* at 19:58–60. As an example, three different websites may be listed as searchable under the category of “restaurants,” and each of those websites will be assigned a rank number such as 1, 2, or 3. *Id.* at 19:60–63. The website with the highest rank (i.e., rank=1) will be the first website accessed by web browsing server 102. *Id.* at 20:63–65. If the information requested by the user cannot be found at this first website, web browsing server 102 will then search the second ranked website and so forth down the line, until the requested information is retrieved or no more websites are left to be checked. *Id.* at 19:65–20:2.

In a preferred embodiment, website polling and ranking methodology allows the system to detect changes in websites and adapt to those changes in real-time. *Id.* at 3:58–61. Referring to Figure 1, a polling mechanism continually polls or “pings” each of the sites listed in database 100. *Id.* at 20:15–18. 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 20:19–25. Polled websites that provide a complete response in the expected format have their ranking established based on their “response time” so that websites with faster response times are ranked higher than those with slower response times. *Id.* at 20:25–28. If web browsing server 102 receives no response from the polled website or if the response received is not in the expected format, then the rank of that website is lowered. *Id.* at 20:30–33.

Since web browsing server 102 accesses websites based upon their ranking number, only those websites that produce useful and error-free responses will be used by the voice browser system to gather information requested by the user. *Id.* at 20:38–41.

D. Challenged Claims

Of the challenged claims (1–15), claims 1 and 9 are the independent claims. Claims 2–8 depend from claim 1, and claims 10–15 depend from claim 9. Independent claim 1 is illustrative and is reproduced below:

1. A method for retrieving information from web sites by uttering speech commands into a voice enabled device and for providing to users retrieved information in an audio form via said voice enabled device, said method comprising the steps of:

providing a computer operatively connected to the internet, said computer further being operatively connected to at least one speaker-independent speech recognition engine and to at least one speech synthesis engine;

providing a voice enabled device operatively connected to said computer, said voice enabled device configured to receive speech commands from users;

providing a speech command to said speaker-independent speech recognition engine,

said computer accessing at least one of a plurality of web sites associated with said speech command to obtain an information to be retrieved, said computer first accessing a first web site of said plurality of web sites and, if said information to be retrieved is not found at said first web site, said computer sequentially accessing said plurality of web sites until said information to be retrieved is found or until said plurality of web sites has been accessed;

said speech synthesis engine producing an audio message containing any retrieved information from said web sites; and

said speech synthesis engine transmitting said audio message to said users via said voice enabled device.

Ex. 1001, 23:7–34.

E. Evidence

Petitioner relies on the references listed below.

Reference		Date	Exhibit No.
Kovatch	WO 01/50453 A2	Pub. July 12, 2001	1004
Neal	US 6,324,534 B1	Nov. 27, 2001	1010
Burrows	US 5,765,149	June 9, 1998	1006
Wise	US 5,884,262	March 16, 1999	1007
Shaffer	US 5,950,165	Sep. 7, 1999	1011
Kovatch Provisional	60/174,371	Filed Jan. 4, 2000	1005

In addition, Petitioner relies on Declarations by Stuart J. Lipoff, P.E. Exs. 1002, 1050. Mr. Lipoff was cross-examined by Patent Owner, and a transcript of his deposition was entered into the record. Ex. 2061.

Patent Owner relies on a Declaration by Randy Winters. Ex. 2063. Mr. Winters was cross-examined by Petitioner, and a transcript of his deposition was entered into the record. Ex. 1052.¹

F. Instituted Grounds of Unpatentability

We instituted *inter partes* review of all challenged claims on all challenges in the Petition. Petitioner contends that claims 1–15 of the '402 patent are unpatentable based on the following grounds. Pet. 2.

¹ The parties also filed evidence related to Patent Owner's arguments for antedating Kovatch: 1) Declarations by Hal Poel and Alex Kurganov, filed by Patent Owner, Exs. 2043, 2052; 2) cross-examination testimony of Messrs. Poel and Kurganov, filed by Petitioner, Exs. 1051, 1053; 3) Declaration by Martin G. Walker, Ph.D., filed by Petitioner, Ex. 1048; and 4) cross-examination testimony of Dr. Walker, filed by Patent Owner, Ex. 2065. Because we do not reach Patent Owner's antedating arguments, as further explained below, we do not consider this additional testimonial evidence in detail.

Claim(s) Challenged	35 U.S.C. § ²	Reference(s)/Basis
1–5, 9, 10, 13, 14	103(a)	Kovatch, Neal
6–8, 11, 12, 15	103(a)	Kovatch, Neal, Burrows
1, 2	103(a)	Wise, Shaffer
3–15	103(a)	Wise, Shaffer, Burrows

II. ANALYSIS

A. *Level of Ordinary Skill in the Art*

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). In our analysis, various factors may be considered, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC, Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (quotation marks omitted). Furthermore, the prior art itself can reflect the appropriate level of ordinary skill in the art. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

Petitioner, relying on the testimony of Mr. Lipoff, contends that a POSITA “would have had a Bachelor’s Degree in electrical engineering, computer science or a related field, and at least two years of experience with voice interfaces and information processing,” wherein “[m]ore education could substitute for less experience, and vice versa.” Pet. 4–5 (citing Ex. 1002 ¶¶ 40, 61–74). Patent Owner does not contest Petitioner’s proposal or offer an alternative. *See generally* PO Resp.

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103. Because the ’402 patent was filed before March 16, 2013, the effective date of the relevant amendment, the pre-AIA version of § 103 applies.

We apply Petitioner’s definition of a POSITA at the time of the claimed invention because, based on the record, this proposal is consistent with the ’402 patent, the asserted prior art, and is supported by the testimony of Mr. Lipoff.

B. Claim Construction

We construe each claim “in accordance with the ordinary and customary meaning of such claim 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). Under this standard, claim terms are generally given their plain and ordinary meaning as would have been understood by a person of ordinary skill in the art (POSITA) at the time of the invention and in the context of the entire patent disclosure. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc).

Neither Petitioner nor Patent Owner proposes any claim construction. *See* Pet. 5; *See generally* PO Resp.

We do not perceive a need to construe any claim terms of the ’402 patent to resolve the disputed issues before us. *See, e.g., Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (holding that “only those terms need to be construed that are in controversy, and only to the extent necessary to resolve the controversy”)))); *see also Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (applying *Vivid Techs.* in the context of an *inter partes* review).

C. Principles of Law

A patent claim is unpatentable under 35 U.S.C. § 103(a) 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.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). 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 ordinary skill in the art; and (4) objective evidence of non-obviousness.³ *See Graham*, 383 U.S. at 17–18.

“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, 1367 (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”)).

D. Claims 1 and 2 as obvious over Wise and Shaffer (ground 3); and Claims 3–15 as obvious over Wise, Shaffer and Burrows (ground 4)

Petitioner contends that Wise and Schaffer render obvious claims 1 and 2 of the ’402 patent. Pet. 36–49 (ground 3); *see also* Pet. Reply 1–7. Petitioner further contends that Wise and Shaffer in further view of Burrows render obvious claims 3–15 of the ’402 patent. Pet. 49–60 (ground 4); *see*

³ Neither party presents arguments or evidence of secondary considerations. Therefore, secondary considerations do not constitute part of our analysis herein.

also Pet. Reply 7–8. In response, Patent Owner contends that Wise does not teach or render obvious limitations of claims 1, 2, and 9; the combination of Wise and Shaffer does not teach or render obvious limitations in claims 1 and 9; and the combination of Wise, Shaffer and Burrows does not teach or render obvious limitations of claims 5–9, 14, and 15. PO Resp. 67–79; *see also* PO Sur-reply 1–9. We summarize the asserted prior art below.

1. Wise (Ex. 1007)

Wise relates to accessing information from a computer network via a telephone or other audio devices. Ex. 1007, 1:6–9. Figure 2 of Wise is reproduced below.

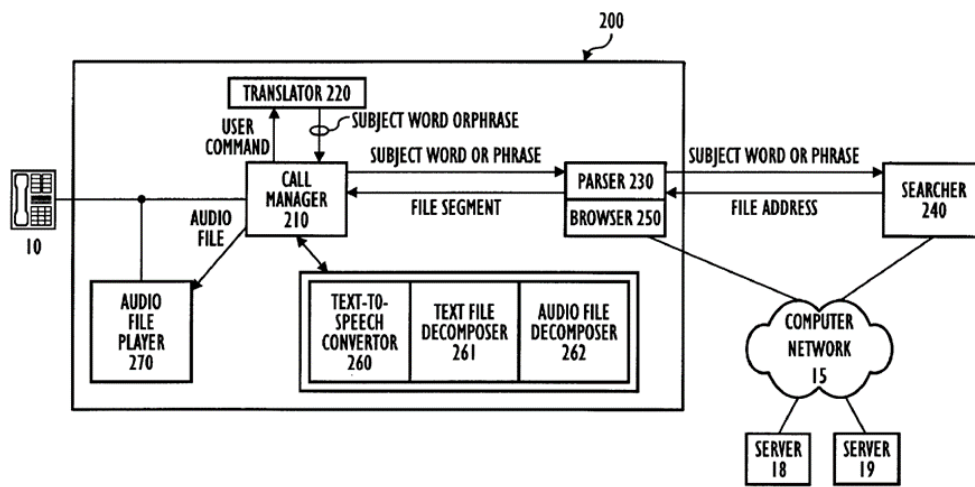


FIG. 2

Figure 2 illustrates a software and hardware architecture in which telephone 10 is connected via a telephone line to system 200, which is then connected through computer network 15 to servers 18, 19. *Id.* at 3:51–58, 5:38–45. Network 15 may be the Internet, and servers 18, 19 may be web servers. *Id.* at 3:55–58. User voice commands or signals from telephone 10 are captured by call manager 210 and sent to a speech-to-text engine embodied by translator 220 for translation. *Id.* at 6:14–30. “Generally, the system will

attempt to interpret the user command and then attempt to navigate based on the command.” *Id.* at 6:31–33.

A subject word or phrase derived from the user command is passed to call manager 210, which routes the information to parser 230, which then sends the subject word or phrase to searcher 240 to find addresses of files on target computer network 15 relating to the subject word or phrase. *Id.* at 6:33–46. Once an address is found, parser 230 passes the address to browser 250, which establishes a connection to appropriate server 18 through network 15 so that browser 250 may download a requested file to return to parser 230. *Id.* at 7:7–13. Parser 230 dynamically analyzes the structure and content of the downloaded file, and passes the structure type and associated text or audio content to call manager 210, which routes it for creation of an audio file to be played by audio file player 270. *Id.* at 7:13–37.

Wise describes how “a network search engine may be provided to investigate documents located on a relatively unconstrained network such as the World Wide Web in order to locate documents which are highly compatible with audio presentation of even documents which are specifically labeled to be compatible.” *Id.* at 9:56–61. To do so, the search engine may be a “worm type searcher or other robotic search engine,” allowing the document search to be automated “along with the process of indexing such documents.” *Id.* at 9:61–66. Parser 230 and call manager 210 may interrogate found documents to determine whether they reach a threshold level of audio compatibility. *Id.* at 10:2–6. Compatible documents may be indexed, with the index “stored as one or more documents preferably in a hierarchical order.” *Id.* at 10:7–9. “The user may use the navigation commands to traverse the index and invoke a link to a source document.” *Id.* at 10:9–10.

2. Shaffer (Ex. 1011)

Shaffer, titled “Automated Visiting of Multiple Web Sites,” discloses an apparatus and method for allowing a telephone user to be automatically connected, in sequence, to multiple telephone numbers in response to a single directory assistance query, wherein the user connected to the internet navigates by voice interaction through queued site-visit options. Ex. 1011, codes (54), (57).

Shaffer relates to directory assistance inquiries handled by transferring the caller to a voice response unit that plays the phone number audibly, wherein, in an example, when a shopper wants to call several retail establishments in order to compare services, a user may ask for several numbers in the same inquiry. *Id.* at 1:14–20. Alternatively, the information provided by the directory assistance server can be made in response to inquiries according to categories, or the lists provided could be pared geographically. *Id.* at 5:7–15. In an example, the user inquires about websites, and a browser supplies a list of websites, e.g., in response to a voice search request or saved from a previous session. *Id.* at 5:34–37. In response to the user input, the browser uses the supplied websites to initialize a candidate list of websites to visit. *Id.* at 5:46–48.

Figure 7 of Shaffer is reproduced below:

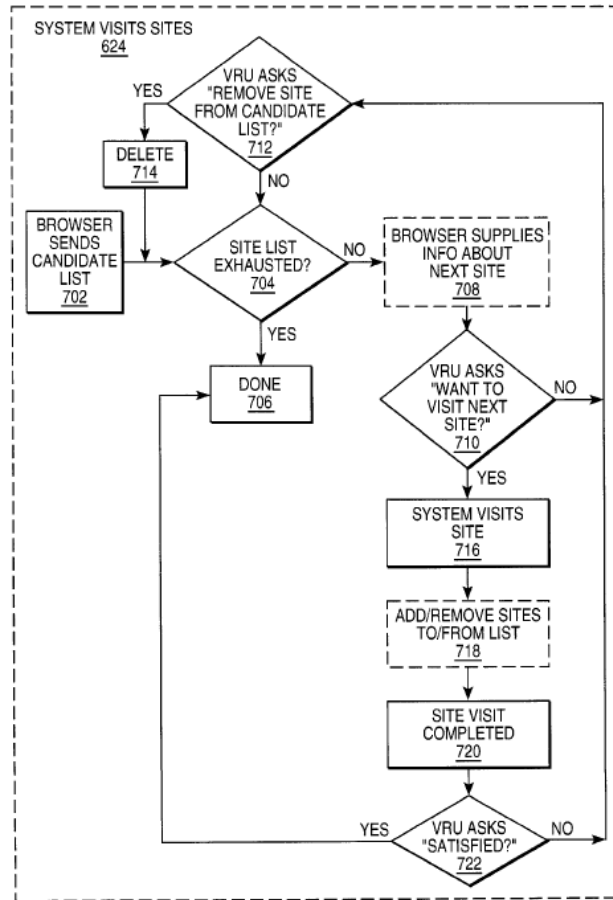


FIG. 7

Figure 7 shows substeps in a method of using “voice response unit” (VRU) navigation on the internet. *Id.* at 2:6–11. As shown in Figure 7, at substep 704, the system determines whether it is at the end of a list of websites to visit, wherein if it determines that it is not at the end of the list, the system at step 710 asks the user if he/she wants to visit the next website, and if so, at substep 716, the system visits the website and the visit is then completed at substep 720. *Id.* at 6:3–24.

3. Burrows (Ex. 1006)

Burrows, titled “Modified Collection Frequency Ranking Method,” 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,

code (54), 1:5–8. In particular, Burrows 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 of 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.

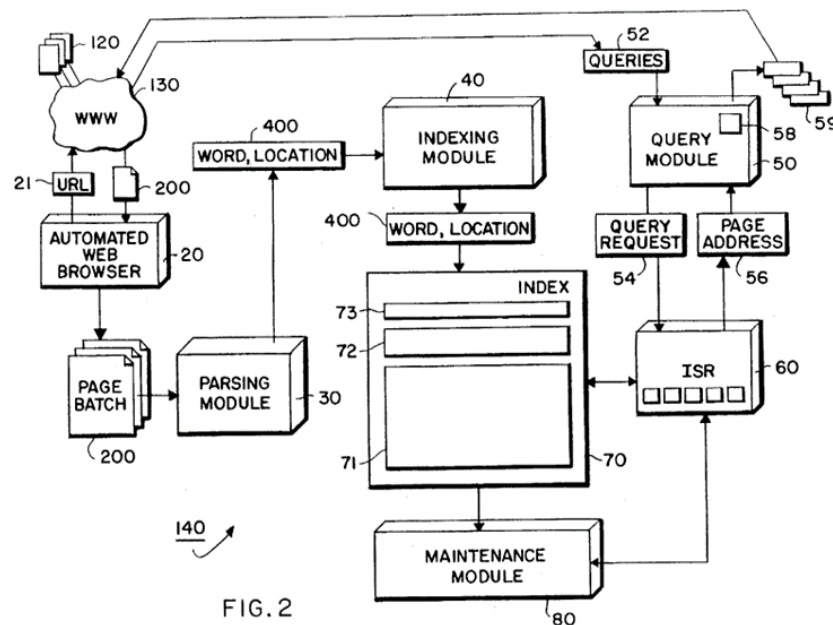


Figure 2 is a block diagram of a search engine, including an index. *Id.* at 2:27–28. Search engine 140 includes automated web browser 20, parsing module 30, indexing module 40, query module 50, index stream readers 60, index 70, and maintenance module 80. *Id.* at 4:9–13. Automated web browser 20 periodically 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 40 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.

Ranking is performed by assigning weight *w* to each indexed word, with score *W* for a page being equal to the sum of the weights *w* for each occurrence of a word specified in the query (or for each word that does not appear if an exclusionary query was used). *Id.* at 27:35–39. Figure 22 of Burrows is reproduced below.

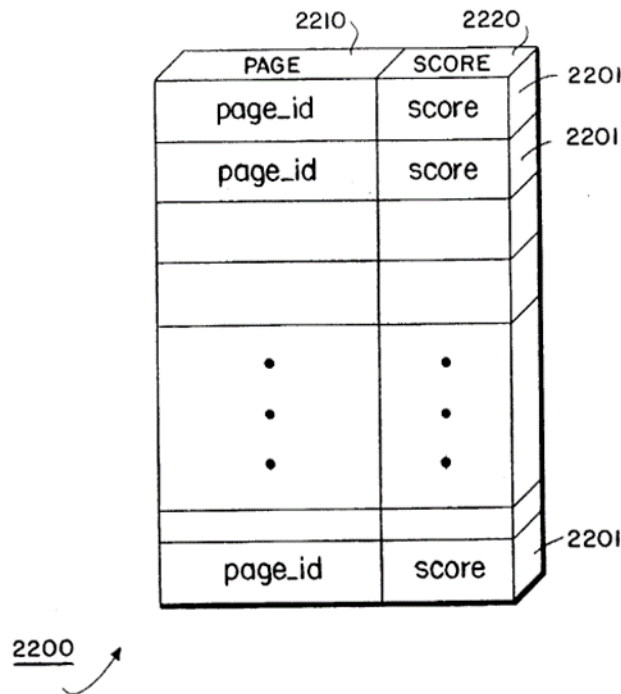


Figure 22 is a block diagram that illustrates a ranking list of qualified pages, with each entry 2201 including identification 2210 of a qualified page and score 2220 associated with that qualified page. *Id.* at 2:66, 28:19–24. Entries 2201 are maintained in rank order according to scores 2220. *Id.*

4. Independent claim 1 as obvious over Wise and Shaffer.

As an initial matter, we address in detail Petitioner’s arguments and Patent Owner’s responses regarding Wise and Shaffer with respect to the limitations of claim 1.

a) “A method for retrieving information from web sites by uttering speech commands into a voice enabled device and for providing to users retrieved information in an audio form via said voice enabled device”

Petitioner presents evidence that Wise describes a “voice response system” including “voice recognition” that “attempt[s] to match a speech input” (e.g., command) via a simple telephone (voice-enabled device) “to a preselected list of potential selections or choices.” Pet. 41 (citing Ex. 1007, 1:66–2:2, 2:50–58) (alteration in original). Petitioner contends Wise discloses that after a speech command uttered into the telephone is converted to text, the word or phrase is used to select “predetermined audio-compatible [website] address[es]” or “to find addresses of files on a target computer network 15” relating to the word or phrase (e.g., websites relating to “Washington D.C. weather”). *Id.* at 41–42 (citing Ex. 1007, 6:31–49) (alteration in original). According to Petitioner, Wise “establishes a connection to the appropriate server 18 through []network 15,” “downloads the entire requested file,” analyzes it, translates it into an audio file, and routes it to the user’s audio file player 270. *Id.* at 42 (citing Ex. 1007, 7:7–20, 38–42; Ex. 1002 ¶¶ 207–208) (alteration in original).

Although Patent Owner does not present arguments addressing the specific merits of Petitioner’s contentions with respect to the preambles (*see generally* PO Resp.; PO Sur-Reply), the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). Having reviewed all

of Petitioner’s assertions regarding the recitations in the preambles, as well as all supporting evidence, we determine on this complete record presented that Petitioner has persuasively shown that the combination of Wise and Shaffer teaches “[a] method for retrieving information from web sites by uttering speech commands into a voice enabled device and for providing to users retrieved information in an audio form via said voice enabled device, said method comprising the steps of,” as recited in claim 1.⁴

b) “providing a computer operatively connected to the internet,” “providing a voice enabled device operatively connected to said computer,” said voice enabled device configured to “receive speech commands from user”, said computer “accessing at least one of a plurality of web sites associated with said speech command to obtain an information to be retrieved,”

Petitioner presents evidence that Wise discloses a standard telephone connected to architecture 100, which “is then connected through a computer network 15, such as the internet, to various . . . Web servers.” Pet. 42 (citing Ex. 1007, 3:52–61) (alteration in original). Citing to Mr. Lipoff’s supporting testimony, Petitioner contends that a POSITA would have understood Wise’s architecture 100 may be a computer because it is connected to a computer network and contains “an operating system.” *Id.* (citing Ex. 1007, 3:62–66; Ex. 1002 ¶ 209).

⁴ The issue of whether the preamble is limiting need not be resolved because, regardless of whether the preamble is limiting, Petitioner has sufficiently shown that the recitations of a “method” for “retrieving information from web sites by uttering speech commands into a voice enabled device” and for “providing to users retrieved information in an audio form via said voice enabled device” in the preamble of claim 1 are satisfied by Wise in view of Shaffer. *See Realtime Data, LLC v. Iancu*, 912 F.3d at 1375.

Petitioner further presents evidence that Wise discloses that “a standard telephone (voice-enabled device) may be connected to architecture 100, which ‘is then connected through a computer network 15, such as the internet, to . . . Web servers.’” Pet. 45 (citing Ex. 1007, 3:52–61; Ex. 1002 ¶ 214; Ex. 1025, 415) (alteration in original). Citing to Mr. Lipoff’s supporting testimony, Petitioner explains that, in Wise, “users’ speech commands, e.g., ‘Baltimore Orioles,’ are captured by Call Manager 210 and sent to translator 220 which uses speech recognition to interpret the command as a request for ‘the most recent Baltimore Orioles baseball score.’” *Id.* (citing Ex. 1007, 6:14–28; Ex. 1002 ¶ 215). In particular, according to Petitioner, when a user states a speech command, it is provided to Wise’s speaker-independent speech recognition engine 360, which “‘convert[s]’ the ‘command to text,’ to ‘be used by the system to control navigation.’” *Id.* (citing Ex. 1007, 2:53–58, 4:13–16, 6:20–30; Ex. 1002 ¶ 216) (alteration in original). That is, in Wise, after a speech command uttered into the telephone is converted to text, the word or phrase is then used to select “predetermined audio-compatible [website] address[es]” or “to find addresses of files on a target computer network 15” relating to the word or phrase. *See id.* at 41–42 (alteration in original); *see also* Ex. 1007, 6:31–49.

Patent Owner acknowledges that Wise “provides for a speech command (the ‘subject word or phrase’) that is associated with one or more web site addresses (the audio-compatible address(es)).” PO Resp. 68. However, Patent Owner contends that “this ‘subject word or phrase’ speech command provides no information about any ‘information to be retrieved’ within a selected website,” and thus, “the Wise ‘subject word or phrase’ **is not associated** with a content descriptor as the limitations require.” *Id.*

(citing Ex. 2063 ¶ 282). According to Patent Owner, Wise’s subject word or phrase “merely functions to indicate a particular website address so that the particular web page can be downloaded and processed.” *Id.* (citing Ex. 2063 ¶ 282).

We disagree with Patent Owner’s arguments. First, as Petitioner points out, “there is nothing in Claim[] 1 . . . that requires ‘a speech command further associated with a content descriptor’” as Patent Owner contends (PO Resp. 68), since such limitation “is found only in dependent Claim 2.” Pet. Reply 2. In fact, claim 1 does not even recite a “content descriptor.” *See* Ex. 1001, 23:7–34.

We are persuaded by Petitioner’s reliance on Wise’s use of a word or phrase to select predetermined audio-compatible website addresses or to find addresses of files on a target computer network “relating to” or “associated with” the word or phrase, as specifically required by claim 1. *See* Pet. 41–42; *see also* Ex. 1007, 6:31–49. Here, Patent Owner acknowledges that Wise’s subject word or phrase “functions to indicate a particular website address so that the particular web page can be downloaded and processed.” PO Resp. 68 (citing Ex. 2063 ¶ 282). We credit Mr. Lipoff’s testimony, which is consistent with Wise’s teachings, that a “subject word or phrase” speech command, such as “Baltimore Orioles score,” in Wise, functions to indicate a website address with scores for the Baltimore Orioles to be downloaded and processed, and thus, “is information about the ‘information to be retrieved.’” *See* Ex. 1050 ¶¶ 11–13.

Having reviewed all of Petitioner’s assertions regarding these limitations, as well as all supporting evidence, we determine on the complete record presented that Petitioner has persuasively shown that the combination of Wise and Shaffer teaches “providing a computer operatively connected to

the internet,” “said computer further being operatively connected to at least one speaker-independent speech recognition engine and to at least one speech synthesis engine,” “providing a voice enabled device operatively connected to said computer, said voice enabled device configured to receive speech commands from users”, “said computer accessing at least one of a plurality of web sites associated with said speech command to obtain an information to be retrieved,” as recited in claim 1.

c) “said computer first accessing a first web site of said plurality of web sites and, if said information to be retrieved is not found at said first web site, said computer sequentially accessing said plurality of web sites until said information to be retrieved is found or until said plurality of web sites has been accessed”

Petitioner provides evidence that Wise discloses using navigation commands to traverse the index and invoke a link to a source document. Pet. 38 (citing Ex. 1007, 10:2–4, 10:7–10; Ex. 1002 ¶¶ 97–101). According to Petitioner, Wise’s system accesses websites to retrieve user-requested information, but Wise “does not disclose sequentially/subsequently accessing websites until information is found.” *Id.* Relying on the supporting testimony of Mr. Lipoff, Petitioner contends that a POSITA would have been motivated to modify Wise’s system that accesses websites to retrieve user-requested information based on Shaffer, resulting in a system that accesses websites sequentially/subsequently until information is found. *Id.* (citing Ex. 1002 ¶ 200). In particular, Petitioner contends that a POSITA would have been motivated “to apply Shaffer’s sequential search technique when retrieving information from websites in Wise’s ranked index” to “maximize the likelihood of finding the desired information and efficiently use computing resources by searching in the most likely sources first.” *Id.* at

40–41 (citing Ex. 1002 ¶ 205). Petitioner notes that “[t]he language of independent claim 1 does not preclude user interaction or instruction during the process of the sequential search.” *Id.* at 46 (citing Ex. 1002 ¶ 218).

Patent Owner acknowledges Petitioner’s contention that “independent claim 1 does not preclude user interaction or instruction during the process of sequential search,” but argues that Petitioner and Mr. Lipoff “fail to provide any evidence, outside of mere speculation, that user interaction can be a part of the sequential search process recited in the claims of the ’402 patent.” PO Resp. 72 (citing Pet. 46; Ex. 1002 ¶ 218). According to Patent Owner, since the ’402 patent is silent as to the participation of a user in the sequential search process, “to suggest otherwise is an impermissible broadening of the patent specification, and that flies in the face of the fundamental principles of claim interpretation.” *Id.* at 73 (citing Ex. 2063 ¶ 290). Rather, Patent Owner contends that the ’402 patent’s specification “teaches **against** the notion of user interaction in the claimed ‘sequentially accessing’ operation,” which “is time consuming and inefficient,” since such “multiple user interactions, website retrievals, and web page processing operations run counter to the goals of the ’402 specification.” *Id.* at 73–75 (citing Ex. 2063 ¶¶ 291–292; Ex. 1001, 2:40–44, 2:55–58, 3:63–4:8). According to Patent Owner, such combination “is nothing more than a justification for the hindsight reconstruction of Claim 1 using Wise and Shaffer.” *Id.* at 75.

We are not persuaded by Patent Owner’s arguments. In particular, we disagree with Patent Owner’s position that the claim language in view of the ’402 specification precludes user interaction or instructions during the process of the sequential search, wherein Petitioner must “provide any

evidence, outside of mere speculation, that user interaction can be a part of the sequential search process recited in the claims of the '402 patent.” PO Resp. 72–75. Instead, we agree with Petitioner that Patent Owner’s suggested “without user interaction” is an unclaimed negative limitation unsupported by the plain and ordinary meaning of the claim language and the specification. *See* Pet. Reply 4–6.

“While a negative limitation need not be recited in the specification *in haec verba*, there generally must be something in the specification that conveys to a skilled artisan that the inventor intended the exclusion.”

Novartis Pharm. Corp. v. Accord Healthcare, Inc., 38 F.4th 1013, 1017 (Fed. Cir. 2022). Here, Patent Owner does not provide sufficient evidentiary support that conveys an intended exclusion of user interaction during sequential access. Instead, both parties and both experts merely point out that the specification of the '402 patent is silent with respect to user participation during sequential access. PO Resp. 73 (Patent Owner asserting that “the '402 patent is silent as to the participation of a user in the sequential search process”); Ex. 2063 ¶ 289 (Mr. Winters testifying that “there is no disclosure in the specification of the '402 patent related to user interaction in the sequential search process”); Pet. Reply 5 (Petitioner asserting that Patent Owner is “[i]mporting a requirement that user interaction is precluded by the claims—a negative limitation, when the specification is wholly silent on it”); Ex. 2061, 107:15–22 (Mr. Lipoff agreeing that “there’s no specific mention of the user interacting” in the portion of the specification related to “the sequential search”). As the Federal Circuit explained in *Novartis*, silence is not sufficient support for a negative limitation. *See Novartis*, 38 F.4th at 1017.

Based on these facts, we find insufficient reason to exclude user interaction from the plain and ordinary meaning of the sequential access limitation. Instead, we are persuaded by Petitioner’s reliance on Shaffer for disclosing the sequential access limitation as recited. *See* Ex. 1011, 6:3–29.

In particular, Shaffer discloses determining whether a system is at the end of a list of sites to visit, and sequentially visiting the sites until the user is satisfied. Ex. 1011, 6:3–29. Furthermore, Wise’s system accesses web pages relating to a subject phrase to retrieve user-requested information. Ex. 1007, 6:31–49. We credit the supporting testimony of Mr. Lipoff, which is consistent with the teachings of Wise and Shaffer, in which he testified that a POSITA would have been motivated to modify Wise’s system that accesses websites to retrieve user-requested information based on Shaffer, resulting in a system that accesses websites sequentially/subsequently until information is found. *See* Ex. 1002 ¶ 200.

We disagree with Patent Owner that the ’402 patent’s specification “teaches against the notion of user interaction in the claimed ‘sequentially accessing’ operation,” which “is time consuming and inefficient.” PO Resp. 73–75. A given course of action often has simultaneous advantages and disadvantages, which “does not necessarily obviate motivation to combine.” *Allied Erecting v. Genesis Attachments*, 825 F.3d 1373, 1381 (Fed. Cir. 2016). Here, Petitioner has articulated sufficient reason, supported by rational underpinning, to effect the combination of teachings it proposes. We credit Petitioner’s contention, which is supported by Mr. Lipoff’s testimony, that a POSITA would have been motivated “to apply Shaffer’s sequential search technique when retrieving information from websites in Wise’s ranked index” in order to “maximize the likelihood of finding the desired information and efficiently use computing resources by searching in

the most likely sources first.” Pet. 40–41; Ex. 1002 ¶ 205. We accordingly determine that Petitioner makes a sufficient showing for the sequential access limitation.

We determine on the complete record presented that Petitioner has persuasively shown that the combination of Wise and Shaffer teaches a computer “first accessing a first web site” of a plurality of web sites and, “if said information to be retrieved is not found at said first web site, . . . sequentially accessing said plurality of web sites until said information to be retrieved is found or until said plurality of web sites has been accessed,” as recited in claim 1.

d) “said speech synthesis engine producing an audio message containing any retrieved information from said web sites,” and “transmitting said audio message to said users via said voice enabled device”

Petitioner presents evidence that Wise’s system “[t]ypically . . . use[s] a text-to-speech engine to convert the document [i.e., webpage] to audio information,” the document being accessed and passed “through a parser to interpret its contents” and “a text-to-speech engine to read the text,” wherein the parser “passes the structure type and the associated text or audio contents” to a call manager “which routes it to the appropriate board to create an audio file to be played by [an] audio file player.” Pet. 47–48 (citing Ex. 1007, 2:11–17, 2:28–34, 5:66–7:5, 7:34–55; Ex. 1002 ¶ 222) (alteration in original). Petitioner further contends that Wise discloses that “a text-to-speech convertor output could” alternatively “be bridged directly to a telephone line.” *Id.* at 48 (citing Ex. 1007, 7:34–55; Ex. 1002 ¶ 223).

Although Patent Owner does not present arguments in its Response or Sur-reply addressing the merits of Petitioner’s contentions with respect to this claim limitation (*see generally* PO Resp.; PO Sur-reply), the burden

remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378. Having reviewed all of Petitioner’s assertions regarding this limitation, as well as all supporting evidence, we determine on the complete record presented that Petitioner has persuasively shown that the combination of Wise and Shaffer teaches “said speech synthesis engine producing an audio message containing any retrieved information from said web sites; and said speech synthesis engine transmitting said audio message to said users via said voice enabled device,” as recited in claim 1.

e) Claim 1 conclusion

For the foregoing reasons, Petitioner has proven, by a preponderance of the evidence, that claim 1 would have been obvious over Wise and Shaffer under 35 U.S.C. § 103(a).

5. Dependent claim 2 depending from claim 1 over Wise and Shaffer.

Claim 2 depends from independent claim 1 and recites that “said speech command is further associated with a content descriptor associated with each said web site address, said content descriptor pre-defining a portion of said web site containing said information to be retrieved.” Ex. 1001, 23:35–39. Petitioner presents evidence that Wise’s documents contain content “useful for navigation” “such as ‘tags that ‘designat[e] links or portions of a document.’” Pet. 48 (citing Ex. 1007, 2:61–66). According to Petitioner, “software residing on the server IP uses Wise’s document(s) with tags to execute the functionality of the ‘content descriptor’ as described by the ’402 patent.” *Id.* Relying on the supporting testimony of Mr. Lipoff, Petitioner contends that a POSITA would have understood that such software is a “content descriptor” because “it uses ‘tags’ and the ‘file associated with the web page’ which directs the extraction agent (Wise’s

Parser 230) to identify and interpret data from the website,” wherein “this software is stored in script ‘files’ to be accessed by the content extraction agent (Parser 230)” to execute scripts that parse tag data accessed by Wise’s “file-based hierarchical system.” *Id.* at 48–49 (citing Ex. 1007, 10:7–19; Ex. 1002 ¶ 224).

Patent Owner acknowledges Petitioner’s reliance on Wise’s “tags to execute the functionality of the ‘content descriptor,’” but argues that Petitioner is “silent as to how Wise provides for ‘said speech command is further associated with a content descriptor associated with each said web site address’ as the limitation requires.” PO Resp. 67–68. Patent Owner contends that Wise’s “subject word or phrase” is “**not associated with a content descriptor as the limitations require.**” *Id.* at 68 (citing Ex. 2063 ¶ 282). In particular, according to Patent Owner, in Wise, “**after** a user has provided a **subject work or phrase command** relating to a stock quote web page and **after** a corresponding stock quote web page has been downloaded and processed, the user may provide an **additional command**” (e.g., a command for a particular stock symbol), such that the system may skip ahead to that particular stock information within the webpage. *Id.* at 69 (citing Ex. 1007, 3:4–8). Patent Owner contends that “the ‘subject word or phrase’ command is unrelated and has no association with any additional navigation command,” wherein both these types of speech commands are distinct and perform very different functions.” *Id.* at 69–70.

We are not persuaded by Patent Owner’s arguments, which turn on the contention that Wise’s subject word or phrase is “not associated with a content descriptor as the limitations require” because Wise’s content descriptor is not known beforehand but rather after a user has provided a subject word or phrase command relating to a web page. PO Resp. 68–70

(emphasis omitted). However, claim 2 merely requires that the speech command be “associated with” the content descriptor. *See* Ex. 1001, 23:35–39. As Petitioner points out, although Patent Owner contends that Wise’s content descriptor file (“tag”) “must be used to navigate a webpage *before* it is ‘processed,’” whereas “Wise creates the association *after* the webpage is processed” (PO Resp. 68–70), no such distinction from the claimed “content descriptor” is provided in the specification of the ’402 patent, and “importantly, no before/after temporal requirement is disclosed.” Pet. Reply 3.

Here, we are persuaded by Petitioner’s contention, which is supported by Mr. Lipoff’s testimony, that a POSITA would have understood that, in Wise, for speech commands to operate, “a user’s natural speech recognition grammars are recognized by the system to retrieve information from a plurality of websites,” wherein, “logically, a ‘subject work or phrase’ speech command such as ‘Baltimore Orioles score’ in Wise is information about the ‘information to be retrieved.’” *Id.* at 2–3 (citing Ex. 1050 ¶¶ 11–13). As Petitioner explains, for “stock” quotes for example, Wise discloses “a content descriptor file (‘tag’) designating stock symbol links in ‘a document containing a list of stock symbols and quotes,’” wherein “in response to a speech command requesting, e.g., ‘today’s stocks,’” the data including “today’s stocks” would have been returned which clearly would be “‘associated’ with the command.” *Id.* at 4 (citing Ex. 1050 ¶¶ 14–17). We agree with Petitioner that “[n]othing more is required by the claims.” *Id.*

We are persuaded by Petitioner’s reliance on Wise’s use of a word or phrase to select predetermined audio-compatible website addresses or to find addresses of files on a target computer network “relating to” or “associated with” the word or phrase. *See* Pet. 41–42; *see also* Ex. 1007, 6:31–49. We

credit Mr. Lipoff's testimony, which is consistent with Wise's teachings, that a "subject word or phrase" speech command such as "Baltimore Orioles score" in Wise "is information about the 'information to be retrieved.'" *See* Ex. 1050 ¶¶ 11–13.

Having reviewed all of Petitioner's assertions regarding claim 2, as well as all supporting evidence, as well as Patent Owner's evidence and arguments to the contrary, we determine on the complete record presented that Petitioner has persuasively shown that that the combination of Wise and Shaffer teaches providing a "speech command" that is "associated with" a "content descriptor," wherein the content descriptor is in turn "associated with each said web site address" and "pre-defining a portion of said web site containing said information to be retrieved," as recited in claim 2. For the foregoing reasons, Petitioner has proven, by a preponderance of the evidence, that claim 2 would have been obvious over Wise and Shaffer under 35 U.S.C. § 103(a).

6. Independent claim 9 as obvious over Wise, Shaffer and Burrows.

Petitioner challenges independent claim 9 as unpatentable under 35 U.S.C. § 103(a) over Wise, Shaffer, and Burrows. Pet. 49–56. With respect to Wise and Shaffer, Petitioner relies on the same analysis discussed above for claim 1. *Id.* at 50–53. Furthermore, Petitioner presents evidence that storing the index in a database would have been an obvious implementation of Wise's system because "databases are a standard format for storing computer files" and a POSITA would have understood that Wise's predetermined addresses are a "plurality of web site addresses" that "are stored and ranked in the system." *Id.* at 51–53 (citing Ex. 1007, 4:17–23, 4:66–5:4, 9:61–65, 10:2–10; Ex. 1002 ¶¶ 233–236). According to

Petitioner, the Wise and Shaffer combination discloses “sequentially accessing a plurality of websites” and thus, “[a]n obvious implementation of the Wise/Shaffer combination would have been to include a ranking indicating the order in which the websites in Wise’s ordered index are accessed, as Burrows teaches.” *Id.* (citing Ex. 1002 ¶¶ 238–239).

Patent Owner disputes Petitioner’s analysis regarding Wise and Shaffer generally for the same reasons discussed above in connection with independent claim 1. *See* PO Resp. 74–81. Furthermore, Patent Owner contends that Petitioner’s reliance on “the Wise/Shaffer combination” provides “no content relating to the ranking aspects” of claim 9. *Id.* at 75–76. Patent Owner then contends the combination of Wise and Shaffer in further view of Burrows does not show the claimed ranking and polling with respect to the claimed “information to be retrieved,” as recited in claim 9. *Id.* at 76–79.

We are not persuaded by Patent Owner’s arguments. In particular, although Patent Owner contends that the Wise/Shaffer combination provides “no content relating to the ranking aspects” (PO Resp. 75–76), we are instead persuaded by Petitioner’s reliance on the combination of Wise and Shaffer in further view of Burrows for such ranking aspects. Pet. 53. We find persuasive Petitioner’s contention that “[a]n obvious implementation of the Wise/Shaffer combination would have been to include a ranking indicating the order in which the websites in Wise’s ordered index are accessed, as Burrows teaches.” *Id.*

Although Patent Owner contends the combination of Wise, Shaffer and Burrows does not show the claimed ranking and polling with respect to the claimed “information to be retrieved” (PO Resp. 76–79), Patent Owner does not address Petitioner’s particular combination of the references. *See*

Pet. Reply 7. The test for a determination of obviousness “is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981)). As Petitioner points out, Petitioner “has not suggested that a POSITA would have bodily incorporated the teachings of Burrows (such as its search methodology) in the Wise-Shaffer combination.” Pet. Reply 7. We credit Petitioner’s particular argument, which is not addressed by Patent Owner but is supported by Mr. Lipoff’s testimony, that an obvious implementation of the Wise/Shaffer combination would have been to “apply Burrow’s *ranking and polling* teachings ‘to Wise/Shaffer’s *sequentially searched* index,’ wherein the search results are navigated sequentially until the information to be retrieved is found. *Id.* (citing Pet. 49–50); *see also* Ex. 1002 ¶¶ 233–234. As Petitioner points out, Patent Owner’s contentions “ignore[] Shaffer, which, in this combination, sequentially accesses a plurality of websites until the information to be retrieved is found.” Pet. Reply 8 (citing Ex. 1050 ¶¶ 25–27).

Having reviewed all of Petitioner’s assertions regarding the limitations of claim 9, as well as all supporting evidence and Patent Owner’s evidence and argument to the contrary, we determine on the complete record presented that Petitioner has persuasively shown that the combination of Wise, Shaffer, and Burrows teaches the limitations recited in claim 9. For the foregoing reasons, Petitioner has proven, by a preponderance of the evidence, that claim 9 would have been obvious over Wise, Shaffer and Burrows under 35 U.S.C. § 103(a).

7. Claims 3–8 depending from claim 1, and claims 10–15 depending from claim 9, as obvious over Wise, Shaffer, and Burrows.

Citing Mr. Lipoff’s testimony for support, Petitioner presents evidence that the limitations recited in dependent claims 3–8, and 10–15 would have been obvious over Burrows in combination with Wise and Shaffer to a person of ordinary skill in the art. Pet. 49, 56–60 (citing Ex. 1006, 1:38–49, 3:29–33, 3:40–42, 3:56–4:5, 4:16–20, 13:39–45, 15:11–16, 27:22–32, 28:36–50, 32:14–47; Ex. 1007, 3:51–61; Ex. 1002 ¶¶ 225–229, 247–271). In particular, with respect to claim 3 depending from claim 1, Petitioner presents evidence that the combination of Wise and Shaffer discloses “said speech command is further associated with a ranking from highest to lowest associated with each said web site, . . . indicating the order in which the plurality of web sites are accessed.” Pet. 56 (citing Ex. 1002 ¶¶ 247–248). With respect to claim 4 depending from claim 1, Petitioner presents evidence that the combination of Wise and Shaffer discloses “said computer accesses said plurality of web sites based on said ranking, . . . accessing said web site having the highest ranking.” *Id.* (citing Ex. 1002 ¶¶ 249–250). With respect to claim 5 depending from claim 1, Petitioner presents evidence that the combination of Wise and Shaffer discloses “adjusting said rankings . . . such that said web site having said information to be retrieved is assigned the highest ranking and any web sites not having said information . . . are assigned lower rankings.” *Id.* (citing Ex. 1002 ¶¶ 251–252). Similarly, with respect to claim 14 depending from claim 9, Petitioner presents evidence that the combination of Wise and Shaffer in further view of Burrows discloses “said computer is configured to establish or adjust said rankings.” *Id.* at 59 (citing Ex. 1002 ¶¶ 268–269).

With respect to claim 6, which recites “periodically polling each said web site to determine whether said web site contains said information to be retrieved” (Ex. 1001, 23:53–55), Petitioner presents evidence that “Burrows discloses the polling features.” Pet. 57. Relying on Mr. Lipoff’s supporting testimony, Petitioner further contends that a POSITA would have been motivated to include Burrow’s polling mechanism to Wise and Shaffer “to ensure that [the] most up-to-date and complete information is presented to the user.” *Id.* (citing Ex. 1006, 3:56–4:5; Ex. 1002 ¶¶ 253–255). Similarly, with respect to claim 7, which recites “the computer periodically polls each said web site without being instructed by said user . . . creating a ranking of said plurality of web sites based on said periodic polling” (Ex. 1001, 23:56–63), Petitioner presents evidence that “Burrows discloses the polling features.” Pet. 57. Relying on Mr. Lipoff’s supporting testimony, Petitioner further contends that a POSITA would have found it obvious to include Burrow’s polling mechanism to Wise and Shaffer “to present ‘search results in a usable manner so that users are not burdened with perusing all qualifying records, ‘to admit modified . . . entries’ as necessary to the index, and because long response times are less desirable than short response times.” *Id.* at 57–58 (citing Ex. 1006, 1:47–49, 3:56–4:5, 13:39–45; Ex. 1002 ¶¶ 256–258) (alteration in original). With respect to claim 15 depending from claim 9, Petitioner similarly presents evidence that the combination of Wise, Shaffer and Burrows discloses “said computer is configured to establish or adjust said rankings . . . based on periodic polling of each of said web sites without being instructed.” *Id.* at 60 (citing Ex. 1002 ¶¶ 270–271).

With respect to claim 8 depending from claim 1, which recites “periodically searching said internet to find new web sites containing said

information to be retrieved, and adding said new web sites to said plurality of websites” (Ex. 1001, 23:64–66), Petitioner presents evidence that Burrows discloses polling features. Pet. 58. Relying on Mr. Lipoff’s supporting testimony, Petitioner contends that a POSITA would have been motivated to combine Burrows with Wise and Shaffer “to ensure that [the] most up-to-date and complete information is presented to the user.” *Id.* (citing Ex. 1006, 3:56–4:5; Ex. 1002 ¶¶ 259–261).

With respect to claim 10 depending from claim 9, which recites “said phone comprises a standard telephone, a cellular phone, or an IP phone” (Ex. 1001, 24:45–46), Petitioner presents evidence that Wise discloses a standard telephone which “may be connected to []architecture 100 using a standard POTS or ISDN telephone line.” Pet. 58 (citing Ex. 1007, 3:51–61; Ex. 1002 ¶ 262) (alteration in original). With respect to claim 11 depending from claim 9, which recites “said internet is a local area network” (Ex. 1001, 24:47–48), Petitioner presents evidence that Wise’s architecture 100 is “connected through a computer network 15, such as the Internet, to various . . . Web servers,” and that Burrows teaches that “other wide or local area networks” may be “used for locating and indexing information.” Pet. 58–59 (citing Ex. 1007, 3:51–61). Relying on the supporting testimony of Mr. Lipoff, Petitioner contends that “a POSITA would also have been motivated to combine Burrow’s LAN or WAN with Wise/Shaffer and had a reasonable expectation of success in doing so.” *Id.* at 59 (Ex. 1002 ¶¶ 263–264). With respect to claim 12 depending from claim 9 which similar recites “said internet is a wide area network” (Ex. 1001, 24:49–50), Petitioner presents evidence that Wise and Burrows disclose a wide area network. Pet. 59 (citing Ex. 1002 ¶¶ 265–266). With respect to claim 13 depending from claim 9 which recites “said internet is the Internet” (Ex. 1001, 24:51–52),

Petitioner presents evidence that Wise discloses that architecture 100 is “connected through a computer network 15, such as the Internet.” Pet. 59 (citing Ex. 1007, 3:51–61; Ex. 1002 ¶ 267).

Although Patent Owner does not provide arguments for the dependent claims separate from the independent claims (*see generally* PO Resp.; PO Sur-reply), the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378. Having reviewed all of Petitioner’s assertions regarding the limitations of these claims, as well as all supporting evidence, we determine on this complete record presented that Petitioner has persuasively shown that claims 3–8, and 10–15 would have been obvious over Wise, Shaffer and Burrows.

For the foregoing reasons, Petitioner has proven, by a preponderance of the evidence, that claims 3–8, and 10–15 would have been obvious over Wise, Shaffer and Burrows under 35 U.S.C. § 103(a).

E. Obviousness of Claims 1–2 over Kovatch and Neal (Ground 1); and Claims 3–15 over Kovatch Neal and Burrows (Ground 2).

Petitioner contends that claims 1–5, 9, 10, 13, and 14 of the ’402 patent also would have been obvious over Kovatch and Neal (Ground 1), and claims 6–8, 11, 12, and 15 over Kovatch, Neal and Burrows (Ground 2). *See* Pet. 5–36. Because the Wise-Shaffer/Wise-Shaffer-Burrows obviousness grounds (Grounds 3–4) are dispositive as to all challenged claims (*see supra* § II(D)), we need not reach Petitioner’s challenges based on obviousness over Kovatch and Neal, and Kovatch, Neal and Burrows. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (2018) (holding a petitioner “is entitled to a final written decision addressing all of the claims it has challenged”); *Bos. Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App’x

984, 990 (Fed. Cir. 2020) (non-precedential) (recognizing that “[t]he Board has the discretion to decline to decide additional instituted grounds once the petitioner has prevailed on all its challenged claims”); *see also* Tr. 6:17–20 (Petitioner stating at oral hearing that “if Your Honors were to agree that the Wise grounds invalidate the claims, then the Kovatch grounds and the inventorship do not need to be decided”).

III. CONCLUSION⁵

For the foregoing reasons, we determine on the record at hand that Petitioner has demonstrated by a preponderance of the evidence that the challenged claims of the ’402 patent are unpatentable.

In summary:

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–5, 9, 10, 13, 14	103(a)	Kovatch, Neal ⁶		
6–8, 11, 12, 15	103(a)	Kovatch, Neal, Burrows ⁷		

⁵ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. *See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. § 42.8(a)(3), (b)(2).

⁶ We do not reach this ground because we have determined claims 1–5, 9, 10, 13, 14 to be unpatentable under other grounds. *See supra* § II(D).

⁷ We do not reach this ground because we have determined claims 6–8, 11, 12, and 15 to be unpatentable under other grounds. *See supra* § II(D).

1, 2	103(a)	Wise, Shaffer	1, 2	
3–15	103(a)	Wise, Shaffer, Burrows	3–15	
Overall Outcome			1–15	

IV. ORDER

For the reasons given, it is

ORDERED that, based on the preponderance of the evidence, claims 1–15 of the '402 patent have been shown to be unpatentable; and

FURTHER ORDERED that, because this is a final written decision, parties to this proceeding seeking judicial review of our decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2022-00523
Patent 8,185,402 B2

PETITIONER:

Benjamin Haber
Caitlin P. Hogan
O'MELVENY & MYERS LLP
bhaber@omm.com
chogan@omm.com

Elisabeth H. Hunt
WOLF, GREENFIELD & SACKS, P.C.
EHunt-PTAB@wolfgreenfield.com

PATENT OWNER:

John B. Campbell
Scott W. Hejny
MCKOOL SMITH, P.C
jcampbell@mckoolsmith.com
shejny@mckoolsmith.com