

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.,

Petitioner,

v.

TAASERA LICENSING LLC,

Patent Owner.

Patent No. 6,842,796

Filing Date: July 3, 2001

Issue Date: January 11, 2005

Inventors: Geoffrey G. Zweig and Mukund Padmanabhan

Title: INFORMATION EXTRACTION FROM DOCUMENTS WITH
REGULAR EXPRESSION MATCHING

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2023-00443

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2001	Fifth Amended Docket Control Order, Dkt. 225, <i>In re: Taasera Licensing LLC, Patent Litigation</i> , No. 2:22-md-03042-JRG (E.D. Tex. May 19, 2023)
2002	Defendant Palo Alto Network, Inc.’s Patent L.R. 3-3 Invalidity Contentions and Subject Matter Ineligibility Contentions, <i>In re: Taasera Licensing LLC, Patent Litigation</i> , No. 2:22-md-03042-JRG, served April 29, 2023
2003	Invalidity Contentions for U.S. Patent No. 6,842,796 Based on U.S. Patent No. 6,311,194 to Amit Sheth <i>et al.</i> (“Sheth”), <i>In re: Taasera Licensing LLC, Patent Litigation</i> , No. 2:22-md-03042-JRG, served April 29, 2023
2004	Invalidity Contentions for U.S. Patent No. 6,842,796 Based on U.S. Patent No. 6,278,996 to Keith D. Richardson <i>et al.</i> (“Richardson”), <i>In re: Taasera Licensing LLC Patent Litigation</i> , No. 2:22-md-03042-JRG, served April 29, 2023
2005	Invalidity Contentions for U.S. Patent No. 6,842,796 Based on U.S. Patent No. 5,913,214 to Stuart E. Madnick <i>et al.</i> (“Madnick”), <i>In re: Taasera Licensing LLC, Patent Litigation</i> , No. 2:22-md-03042-JRG, served April 29, 2023
2006	Defendants’ Joint Patent L.R. 4-2 Preliminary Claim Constructions and Extrinsic Evidence, <i>In re: Taasera Licensing LLC, Patent Litigation</i> , No. 2:22-md-03042-JRG, served May 10, 2023
2007	Redline Comparison of the Declaration of John R. Black, Jr., Ph.D. (Ex. 1003) to the Petition

I. INTRODUCTION

On January 10, 2023, Palo Alto Networks, Inc. (“Petitioner”) submitted a petition (Paper 1, “Petition” or “Pet.”) to institute *inter partes* review (“IPR”) of U.S. Patent No. 6,842,796 (Ex. 1001, “the ’796 Patent”), challenging claims 1-25 (the “Challenged Claims”).

The Petition identifies that “Petitioner is the real party-in-interest” and that “[n]o other party had access to or control over the present Petition, and no other party funded or participated in preparation of the present Petition.” Pet. at 71. Petitioner is a party to the district court case captioned as *In re: Taasera Licensing LLC, Patent Litigation*, No. 2:22-md-03042-JRG (E.D. Tex. August 3, 2022) (the “District Court Litigation”).

The Petition asserts that the Challenged Claims are obvious (1) over U.S. Patent No. 6,311,194 to Sheth *et al.* (Exhibit 1004, “Sheth”); (2) U.S. Patent No. 6,278,996 to Richardson *et al.* (Exhibit 1005, “Richardson”) and U.S. Patent No. 5,913,214 to Madnick *et al.* (Exhibit 1006, “Madnick”); and (3) over Richardson, Madnick, and U.S. Patent No. 6,507,643 to Groner (Exhibit 1007, “Groner”). Pet. at 3. However, the Board should deny the Petition for at least three reasons: (1) the Board should exercise its discretion to deny the Petition under 35 U.S.C. § 314(a); (2) the Petitioner fails to identify how certain elements of the Challenged Claims are obvious over Sheth, Richardson, Madnick, and Groner, or any combination thereof;

and (3) the Petition does not demonstrate that a person of ordinary skill in the art would have been motivated to combine Richardson, Madnick, and Groner, which are directed to different technological fields.

Based on the reasons set forth regarding § 314(a) below, the Board should exercise its discretion to deny this Petition. The Petition does not establish “a reasonable likelihood that the Petitioner would prevail with respect to at least 1 of the claims challenged in the Petition.” 35 U.S.C. § 314(a). While Patent Owner explicitly reserves the right to present additional arguments, the deficiencies of the Petition noted herein are sufficient for the Board to find that Petitioner has not met its burden to demonstrate a reasonable likelihood that it would prevail in showing unpatentability of any of the Challenged Claims.

II. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(A)

Based on Petitioner’s reasons regarding § 314(a), the Board should exercise its discretion to deny this Petition.

The circumstances of the parallel District Court proceeding necessitate denial of the Petition under the Board’s precedent, as every factor considered in relation to efficiency, fairness, and the merits supports denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (precedential) (considering (a) “whether the petitioner and the defendant in the parallel proceeding are the same

party”; (b) “overlap between issues raised in the petition and in the parallel proceeding” (c) “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision”; (d) “investment in the parallel proceeding by the court and the parties”; (e) “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted”; and (f) “other circumstances that impact the Board’s exercise of discretion, including the merits.”).

As set forth below, these factors collectively demonstrate that efficiency and integrity of the AIA are best served by denying review. First, the Petitioner is the Defendant in the parallel proceeding. *See infra* Section II.A. Second, the Challenged Claims are all at issue in the District Court Litigation, and Petitioner has raised identical arguments for invalidity there. *See infra* Section II.B. Third, trial in the District Court Litigation is set for March 15, 2024, five months earlier than the projected statutory deadline for a final written decision of this Petition in August 22, 2024. *See infra* Section II.C. Fourth, the parties (and Taasera in particular) have invested significant resources on developing legal and factual issues of validity and infringement in the District Court Litigation and will have invested substantially more resources before any decision on this Petition. *See infra* Section II.D. Fifth, the Court has neither granted nor denied a stay pending this Petition. *See infra* Section II.E. Finally, no other factors favor institution. *See infra* Section II.F.

Accordingly, the Board should exercise its discretion under § 314(a) and deny the Petition because institution of this proceeding would not be consistent with the objective of the AIA to “provide an effective and efficient alternative to District Court litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential)).

A. The Parallel District Court Proceeding and the Petition Involve the Same Parties

As noted in Patent Owner’s Mandatory Notice, there exists a parallel District Court proceeding between the same parties regarding the same subject patent (the ’796 Patent). *Palo Alto Networks, Inc., v. Taasera Licensing LLC*, IPR2023-00443, Paper 4 at 2-3 (P.T.A.B. January 23, 2023); Pet. at 71-72. Accordingly, this factor weighs in favor of discretionary denial.

B. The District Court Litigation Involves Substantially the Same Claims, Grounds, Arguments, and Evidence

This Petition is co-extensive with invalidity arguments that Petitioner has already raised in the District Court Litigation. *See generally* Ex. 2003, Invalidity Contentions for U.S. Patent No. 6,842,796 based on U.S. Patent No. 6,311,194 to Amit Sheth *et al.*, *In re: Taasera Licensing LLC, Patent Litigation*, No. 2:22-md-03042-JRG served April 29, 2023; Ex. 2004, Invalidity Contentions for U.S. Patent

No. 6,842,796 based on U.S. Patent No. 6,278,996 to Keith D. Richardson *et al.*, *In re: Taasera Licensing LLC, Patent Litigation*, No. 2:22-md-03042-JRG served April 29, 2023; Ex. 2005, Invalidity Contentions for U.S. Patent No. 6,842,796 based on U.S. Patent No. 5,913,214 to Stuart E. Madnick *et al.*, *In re: Taasera Licensing LLC, Patent Litigation*, No. 2:22-md-03042-JRG served April 29, 2023. “In at least these ways, the parallel proceedings would duplicate effort. This is an inefficient use of Board, party, and judicial resources and raises the possibility of conflicting decisions.” *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (P.T.A.B. May 15, 2020). Accordingly, this fact weighs strongly in favor of discretionary denial.

Petitioner states that it “will not pursue in parallel district court proceedings the same grounds as in the Petition.” Pet. at 71. Yet, three of the four references used in the Petition (Sheth, Richardson, and Madnick) and Petitioner’s corresponding arguments significantly overlap with the claims, references, arguments, and evidence in the District Court Litigation. In fact, for each of the three overlapping references, Petitioner explicitly incorporates by reference the grounds asserted in the PTAB and points to the same sections of each reference for each of the same claim elements. *See, e.g.*, Ex. 2002 at 80 (“Defendant incorporates by reference each of the grounds of invalidity presented in the petition for the following *inter partes* review proceeding(s) (IPRs) and any additional petitions for

IPRs that may be filed challenging the patentability of the '796 patent: IPR2023-00443”), 107 (“Defendant incorporates by reference each of the obviousness combinations and motivations to combine presented in the petition for the following *inter partes* review proceeding(s) (IPRs) and any additional petitions for IPRs that may be filed challenging the patentability of the '796 patent: IPR2023-00443”); Ex. 2003 at 1 (“Defendant hereby incorporates by reference Ground 1 presented in *Palo Alto Networks, Inc. v. Taasera Licensing LLC*, IPR2023-00443”; Ex. 2004 at 1 (“Defendants hereby incorporate by reference Ground 2 presented in *Palo Alto Networks, Inc. v. Taasera Licensing LLC*, IPR2023-00443 (PTAB)”); Ex. 2005 at 1 (“Defendant incorporate[s] by reference Ground 2 presented in *Palo Alto Networks, Inc. v. Taasera Licensing LLC*, IPR2023-00443 (PTAB).”).

For this reason, denial of institution under § 314(a) is appropriate because the Petition “includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel [District Court] proceeding.” *Fintiv*, IPR2020-00019, Paper 11, at 12.

C. Proximity of The District Court’s Trial Date

The proximity of the District Court Litigation’s trial date to the Board’s projected statutory deadline for a final written decision strongly weighs in favor of discretionary denial.

The parties' trial is scheduled for March 15, 2024. Exhibit 2001 (Fifth Amended Docket Control Order, Dkt. 225, *In re: Taasera Licensing LLC, Patent Litigation*, No. 2:22-md-03042-JRG (E.D. Tex. May 19, 2023)). Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a final written decision of this Petition is August 22, 2024. As the District Court's trial will be more than five months before the projected statutory deadline, this factor weighs strongly in favor of denying institution. *See Supercell Oy v. Gree, Inc.*, IPR2020-00513, Paper 11 at 10-12 (P.T.A.B. June 24, 2020) (denying institution where the jury trial was scheduled to conclude approximately ten months before the statutory deadline); *Edward LifeSciences Corp. v. Evalve, Inc.*, IPR2019-01479, Paper 7, at 6-13 (P.T.A.B. Feb. 26, 2020) (denying institution where jury trial would conclude more than nine months before a final decision would be due); *Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7, at 7-10 (P.T.A.B. Jan. 7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TrustID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude "several months," before a final decision would be due); *Cisco Sys., Inc.*, IPR2020-00122, Paper 15 at 8 ("Because the trial date is substantially earlier than the projected statutory deadline for the Board's final decision, this factor weighs in favor of discretionary denial.").

Petitioner does not contest that the proximity of the trial favors denial of institution. Thus, this factor also weighs in favor of discretionary denial.

D. Significant Investment and Petitioner's Delay in Filing the Petition

The parties' investment in the parallel proceeding weighs in favor of discretionary denial.

In the District Court Litigation, the Court has already entered six Docket Control Orders (Dkts. 8, 15, 46, 84, 209, 225), Discovery Order (Dkt. 137), Protective Order (Dkt. 162), and E-Discovery Order (Dkt. 195). Discovery is also well under way. The parties have already exchanged initial disclosures, infringement contentions pursuant to P.R. 3-1, and invalidity contentions pursuant to P.R. 3-3. The parties have already exchanged proposed claim terms and preliminary claim constructions for those terms, fact discovery closes in approximately five months on October 16, 2023, and a trial date is set for March 15, 2024, which is less than a year away. Ex. 2001.

As noted above, three of the four references used in the Petition (Sheth, Richardson, and Madnick) and Petitioner's corresponding arguments significantly overlap with the claims, references, arguments, and evidence in the District Court Litigation. Petitioner further fails to offer any explanation why the Board should review the same claims on the same grounds which will already have been

adjudicated by the District Court based on the parties' investment. Thus, the parties' and Court's substantial investment in this proceeding weighs in favor of denial of institution under this factor.

E. No Stay of the Parallel District Court Proceeding

There is no stay of the parallel District Court proceeding. Even if the Petition was instituted and Petitioner filed a motion to stay the District Court Litigation, prejudice, tactical disadvantage to Taasera, the late stage of the litigation, and the lack of potential simplification would weigh strongly against such a motion. *See Lennon Image Techs., LLC v. Macy's Retail Holdings, Inc.*, 2:13-CV-00235-JRG, 2014 WL 4652117, at *1 (E.D. Tex. Sept. 18, 2014). The statutory deadline for institution is not until after responsive claim construction briefing is due, placing any motion for a stay close to trial. Ex. 2001; *see Intell. Ventures v. FedEx Corp.*, No. 2:16-cv-00980-JRG, Dkt. 141 at 4-5 (E.D. Tex. Oct. 24, 2017) ("The Court agrees that the Parties have already invested substantial effort and resources during discovery and in preparing claim construction briefing. . . . These circumstances weigh against staying this case").

Moreover, a stay would not decrease the burden on the Court and the parties since the instituted IPRs cover three out of the nine references that Petitioner raised in the District Court Litigation for both anticipation and at least 72 combinations of obviousness, under § 112, and under § 101. Ex. 2002, at 79-80, 95-107, 359-363,

395-406. *Intell. Ventures*, No. 2:16-cv-00980-JRG, Dkt. 141 at 3-4 (“[T]he instituted IPRs only cover a narrow slice of the invalidity arguments Defendants have raised in this case. For example, Defendants have argued that the ’715 Patent is invalid under § 102 with respect to at least eight references . . . under § 103 with respect to at least twenty-six combinations . . . under § 112 [], and under § 101.”).

Accordingly, it would be unlikely for the Court to hold that a stay would streamline the litigation and this factor supports denial of institution.

F. Other Factors Favor Discretionary Denial

Petitioner does not present a strong case on the merits, further supporting denial of institution. *See infra* Section VII. Petitioner also does not identify any other factors which weigh against discretionary denial. Pet. at 70-71.

Thus, when viewing the factors together, the Petition should be denied in the Director’s discretion under 35 U.S.C. § 314(a).

III. THE ’796 PATENT AND ITS PROSECUTION

The ’796 Patent discloses and claims “techniques for exploiting the readily-identifiable structure of language to explicitly identify portions of data in a document that a user seeks to be identified, *e.g.*, relevant or important information.” ’796 Patent, 1:51-55.

The ’796 Patent describes why such techniques are necessary in view of the “need for data processing techniques which explicitly identify portions of data that

are sought to be identified, rather than only implicitly identifying, or tagging, such portions of data,” as in the prior art:

In the past, several techniques have been developed to solve the somewhat simpler problem of “named entity extraction.” In this task, the goal is to identify all occurrences of certain classes of words in a document. For example, all the person-names, city-names, dates, and times might be identified. One way of identifying such entities is to train a statistical classification system to tag each word in the document as either a “person-name,” “city-name,” “date,” “time,” or “other” word. . . .

While the problem of extracting key pieces of information can also be viewed as a tagging problem, in which each word is tagged as either “key information” or “irrelevant,” such a tagging approach fails to explicitly identify the portions of text that are important.”

Id. at 1:24-50.

The '796 Patent's independent claims describe that regularly identifiable expressions “represent a pattern that is matchable.” *Id.* at Claims 1, 12, 23, 24, 25; 3:22-26 (“the term ‘regular expression’ is taken to mean any form of pattern that is matchable.”). In one embodiment, “stereotypical phrases that people commonly use to convey particular information” are referred to as regular expressions. *Id.* at 2:1-15. “[F]or example, in a phone call, the caller is likely to identify himself in one of just a few ways, e.g., ‘Hi <recipient-name>, it’s <caller-name>’ (e.g., ‘Hi John, it’s Bob’) or ‘<recipient-name>, <caller-name> here’ (e.g., ‘John, Bob here’). Or in a cover letter, a job applicant is likely to express his interest with a phrase like ‘I am

looking for a job in <field>' (e.g., 'I am looking for a job in electrical engineering')."

Id.

In other particular embodiments, a regular expression may be a trigger prefix or trigger suffix. *Id.* at 3:41-50 ("A trigger prefix is a characteristic phrase that typically precedes a piece of information, for example, in a voice mail message, 'give me a call back at' is a trigger phrase that precedes a phone number. A trigger suffix is a phrase that typically follows a key piece of information, even when a trigger prefix is not present. For example, the phrase 'talk to you later bye' is often a post-facto signal that a phone number has been provided, when the words immediately preceding the phrase are a sequence of numbers.").

By using regularly identifiable expressions, "the invention is able to automatically identify them in an input data stream and then identify and extract the particular information associated with the phrase that is being sought, e.g., important or relevant information." *Id.* at 2:17-21. For example, "if the voice message input to the methodology 10 contains the phrase 'call me back at 555-1234,' the above program determines that the phrase 'call me back at' matches one of the enumerated expressions. Then, the information associated with the phrase 'call me back at,' namely, '555-1234,' is identified as the information-bearing portion of the expression, and extracted." *Id.* at 11:25-34.

The '796 Patent's approach has several advantages over the prior art:

First, the phrases are readily expressible as regular expressions, and this allows them to be stored in one of several common programming languages, *e.g.*, as a “flex” or “perl” program. Both these languages have built-in support for regular expressions. Secondly, the use of regular-expression technology enables extremely fast pattern matching and information extraction with highly optimized standard programs. Thirdly, the phrases can be identified without the expensive and time consuming step of gathering and annotating a large “training database. Finally, if desired, the technique can be combined with statistical based procedures, *e.g.*, by using the phrases as features in a statistical system, or by using a statistical procedure to automatically collect a large pool of candidate phrases which can then be selected for inclusion by a human.

Id. at 2:22-39.

During prosecution, the claims of the '796 Patent were rejected over Adler (U.S. Pat. No. 6,342,901). Ex. 1002, 86-90. While Applicants believed that the originally filed claims were patently distinguishable over Adler, Applicants amended each of the independent claims to further clarify that a regularly identifiable expression represents a pattern that is matchable in accordance with a programming language that supports such a regularly identifiable expression. *Id.* at 96-102. Applicants also argued that Adler only disclosed “cue words” which are not matchable patterns and, therefore, does not disclose, teach, or suggest the regularly identifiable expressions. *Id.*

The Examiner then rejected the claims over Klein (U.S. Pat. App. Pub. No.

US 2002/0194026). Examiner allowed the patent claims after Applicant submitted a declaration under 37 C.F.R. §1.131 showing prior conception before the effective date of Klein, which precluded the need to provide arguments over Klein.

IV. THE ALLEGED PRIOR ART

A. Sheth

Sheth is directed to “[a] system and method for creating a database of metadata (metabase) of a variety of digital media content, including TV and radio content delivered on Internet. This semantic-based method captures and enhances domain or subject specific metadata of digital media content.” Ex. 1004 at Abstract, 4:54-59.

Sheth describes why it has taken an exclusively semantics or context-based approach to capturing metadata: “syntax and structure-based methods pervade the entire Web—both in its creation and the applications realized over it. The challenge has been to include semantics in creating physical or virtual organizations of the Web and its applications.” *Id.* at 4:44-48.

Sheth extracts metadata through “look[ing] up a set of extraction rules” that “list the metadata attributes for the type of media that this site contains as well as rules that describe where to find values for these attributes within the page.” *Id.* at 10:35-42, 11:40-52. One example is that “a particular asset extracted from

CNN.com could have the type 'News Asset', location 'Atlanta', clip length '1:32', as well as several other attribute-values,” which are extracted. *Id.* at 12:34-42.

B. Richardson

Richardson “is directed to a method and apparatus for automatically recognizing and responding to intent in message text, particularly as used in a large-scale automatic message response system to examine input text and respond appropriately with output text relevant to the writer’s intent.” Ex. 1005 at 1:21-26.

In order to recognize intent, Richardson uses a regular expression list and a phrase type list to assign tags to a message, such as shown in Table 1 and Table 2 in its specification as well as in Fig. 5A. *Id.* at 8:49-9:28. If a regular expression from the list is matched in the message, the matching expression is tagged. *Id.*

TABLE 1

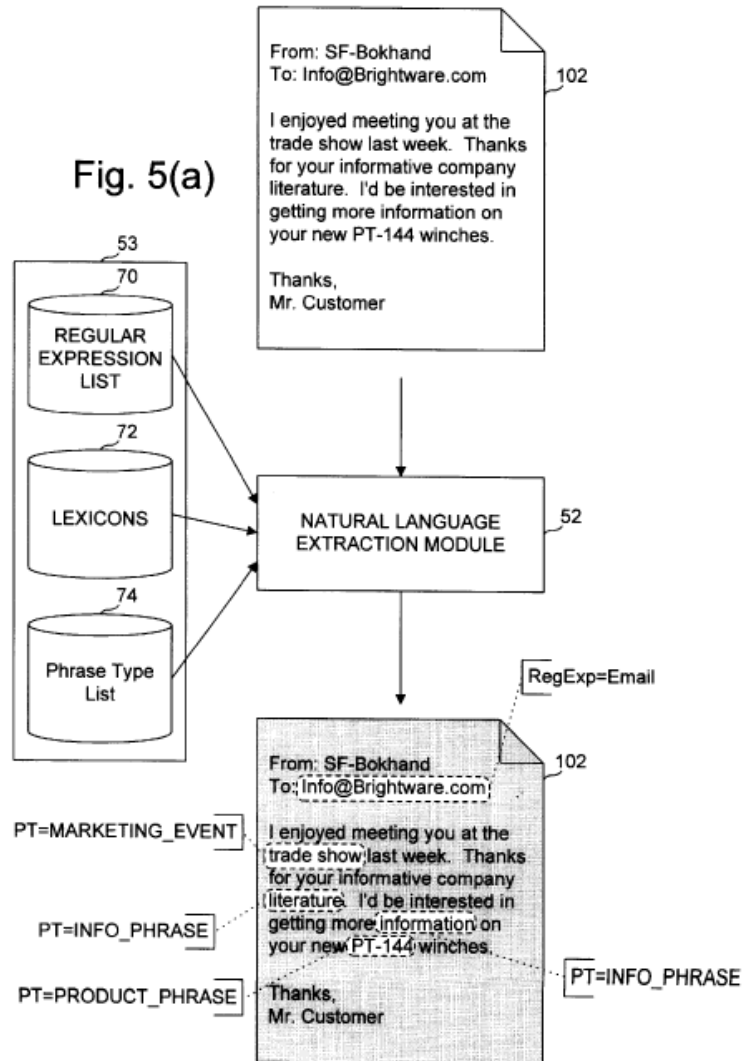
Regular Expression List	
Expression	Type
http://*{/}>	URL
###-###-####	Phone
[a-zA-Z]@*.*	Email
...	...

Id. at Table 1.

TABLE 2

Phrase Type List	
Phrase	Type
information	INFO_PHRASE
“product literature”	INFO_PHRASE
...	...
PT-140	PRODUCT_PHRASE
PT-141A	PRODUCT_PHRASE
PT-143	PRODUCT_PHRASE
PT-144	PRODUCT_PHRASE
“trade show”	MARKETING_EVENT
...	...
#\$%%\$^!!*	PROFANITY_PHRASE
...	...

Id. at Table 2.



Id. at Fig. 5(a).

The message with its tags and additional data are then provided to intent matching module 54, which identifies the writers and System operator's intents using an intent list. *Id.* at 10:35-63. The identified intents, the tags and their values are provided to action mapping module 55, which continues generating an action queue 120 based on the intents. *Id.*

C. Madnick

Madnick “relates to retrieving data from heterogeneous data sources including structured sources and semi-structured sources and, more particularly, extracting data from World Wide Web pages in response to a query phrased in a structured query language.” Ex. 1006, at Abstract, 1:15-20.

Due to the differences in multiple queried data sources, Madnick discloses a request translator to standardize multiple data requests to a common data context, a query converter to convert a portion of the data query into a command that interacts with a web page, a command transmitter, a data retriever, and an accompanying data translator to translate the retrieved data back into the data context that the request was made in. *Id.* at 5:6-35, 7:36-49, 9:57-10:5.

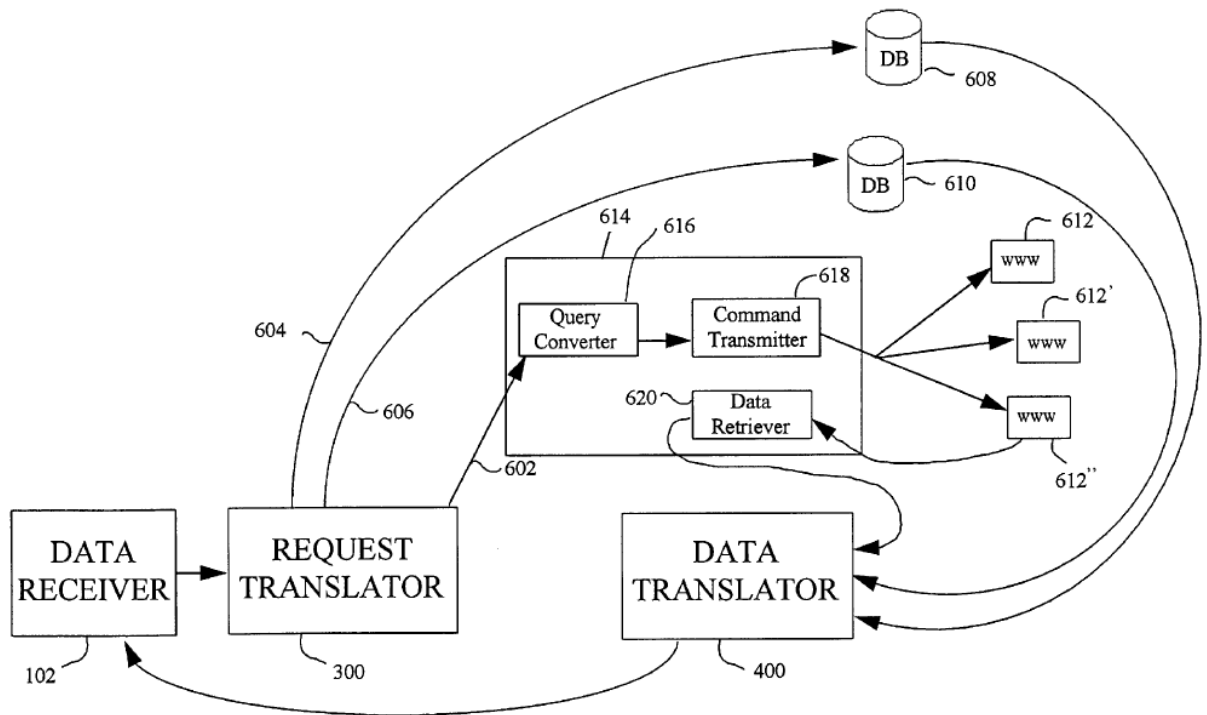


FIG. 6

Id. at Fig. 6.

D. Groner

Groner “relates generally to speech recognition systems as applied to voice and electronic message mailing. More particularly the invention is a system and method for converting speech to a text message suitable for sending as an e-mail message and for viewing on a text display device.” Ex. 1007, Abstract, 2:54-60.

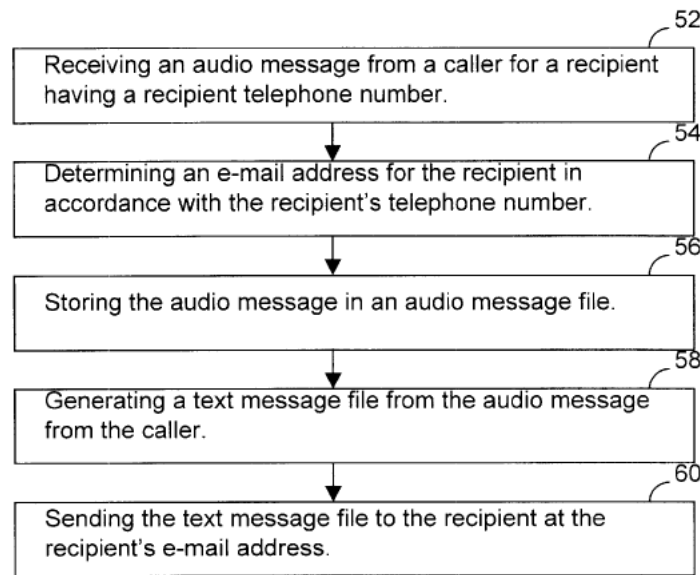


FIG. 2

Id. at Fig. 2.

V. CLAIM CONSTRUCTION

For the purposes of this Preliminary Response only, Patent Owner believes that claim construction is not required to resolve any issues outside of the correction of a typographical error in claim 20: “pen programming language” should be construed as “perl programming language.” Pet. at 8-9. This obvious error may be corrected by the Board. *Id.*; *Samsung Elecs. Co. v. M&K Holdings Inc.*, IPR2018-00696, Paper 55 at 13-14 (P.T.A.B. Aug. 23, 2021).

While Petitioner notes that it, too, believes that claim construction is not otherwise warranted, Petitioner still construed the term “regularly identifiable expression” as indefinite in the District Court Litigation. *See* Ex. 2006 at 11; *see*

also Ex. 2002 at 359-363. This, in addition to the plethora of other outstanding issues that affect validity, weighs in favor of the Board using its discretion to deny institution of this Petition so that all validity issues could be resolved in the District Court Litigation.

VI. LEVEL OF ORDINARY SKILL IN THE ART

For the purposes of this Preliminary Response only, Patent Owner utilizes Petitioner's proposed level of skill in the art: "a bachelor's degree in computer science, computer engineering or an equivalent, as well as four years of industry experience, and would have had working knowledge of data extraction methods and programming languages including perl and flex. Additional graduate education could substitute for professional experience, or significant experience in the field could substitute for formal education." Pet. at 4 (citations omitted).

VII. PETITIONER HAE NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF SUCCESS FOR THE GROUNDS ADVANCED IN THE PETITION, AND THE PETITION SHOULD BE DENIED

The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) so-called secondary considerations where in evidence. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966); *KSR Int'l Co. v. Teleflex*

Inc., 550 U.S. 398, 406 (2007). The question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983).

The Board has held that a failure to identify the differences between the claimed subject matter and the prior art is fatal to an obviousness challenge. *See, Apple, Inc. v. Contentguard Holdings, Inc.*, IPR2015-00355, Decision Denying Institution of *Inter Partes* Review, Paper 9 at 9-10 (P.T.A.B. June 26, 2015) (denying institution for failure to identify the differences between the claimed subject matter and the prior art).

In arriving at an obviousness determination, the Board must sufficiently explain and support the conclusions that the prior-art references disclose all the elements recited in the Challenged Claims and a relevant, skilled artisan not only could have made, but would have been motivated to combine all the prior art references in the way the patent claims and reasonably expected success. *Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017). That is, even if all the claim elements are found across a number of references, an obviousness determination must consider whether a person of ordinary skill in the art would have the motivation to combine those references. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1368 (Fed. Cir. 2016); *Los Angeles Biomedical*

Rsch. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co., 849 F.3d 1049, 1067 (Fed. Cir. 2017) (vacating and remanding an obviousness determination, in part, because the Board did not make factual finding as to whether there was an apparent reason to combine all three prior art references to achieve the claimed invention and whether a person of skill in the art would have had a reasonable expectation of success from such a combination). This combinability determination, as supported by an articulated motivation to combine, requires a plausible rationale as to why those prior art references would have worked together. *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1335 (Fed. Cir. 2013). Absent some articulated rationale, a “common sense” finding is no different than the conclusory statement “would have been obvious.” *In re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017). Of additional importance, “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references. . . .” *Innogenetics, N.V. v. Abbott Lab’ys.*, 512 F.3d 1363, 1373 (Fed. Cir. 2008).

A. Ground 1: Claims 1-10, 12-21, 23, and 25 are Not Obvious Over Sheth

1. Independent Claims 1, 12, 23, and 25

- (a) Sheth Does Not Disclose “identifying at least one regularly identifiable expression [that] represents a pattern that is matchable in accordance with a programming language that supports such a regularly identifiable expression” as Required by Claims 1, 12, 23, and 25**

Claims 1 and 23 of the '796 Patent recite “identifying at least one regularly identifiable expression in the input sequence of data symbols, wherein the at least one regularly identifiable expression represents a pattern that is matchable in accordance with a programming language that supports such a regularly identifiable expression.” Claim 12 recites “at least one processor operative to” . . . “identify at least one regularly identifiable expression in the input sequence of data symbols, wherein the at least one regularly identifiable expression represents a pattern that is matchable in accordance with a programming language that supports such a regularly identifiable expression.” Claim 25 of the '796 Patent recites “identifying one or more regular expressions in the input document by comparing the input document to one or more previously-stored regular expressions to determine if there is a match between a portion of the input document and at least one of the previously-stored regular expressions, wherein a regular expression represents a pattern that is matchable in accordance with a programming language that supports such a regular expression.” Sheth does not render this claim limitation obvious, as Petitioner asserts. Pet. at 19-20.

Petitioner and its expert assert, without citation or evidence, that Sheth’s disclosure of scanning portions of text meets the step of identifying at least one regularly identifiable expression. Pet., 19-20, Ex. 1003, ¶ 78. Merely because a pattern is matched does not meet Petitioner’s burden to show the use of regular

expressions, or how the regularly identifiable expression “represents a pattern that is matchable” as required by the claims. Petitioner asserts that “the ability to retrieve text that matches a particular pattern is provided by the PERL regular expression language.” Pet. at 20. But without evidentiary support, Petitioner cannot make the logical leap to invent the use of regularly identifiable expressions where no such disclosure exists in the prior art.

Petitioner incorrectly alleges that “look[ing] up a set of extraction rules” that “list the metadata attributes for the type of media that this site contains as well as rules that describe where to find values for these attributes within the page” in Sheth discloses, teaches, or suggests the claimed element of “identifying at least one regularly identifiable expression in the input sequence of data symbols.” , Sheth’s extraction rules are merely inputs to an extractor program to “specify where and how to retrieve the metadata from the Web site.” Ex. 1004 at 10:35-42. Extraction rules that figure out how to retrieve website metadata, as in Sheth, are not related to identifying a matchable regular expression, as the claim requires.

The ’796 Patent’s independent claims describe that regularly identifiable expressions “represent a pattern that is matchable.” ’796 Patent at Claims 1, 12, 23, 24, 25; 3:22-26 (“the term “regular expression” is taken to mean any form of pattern that is matchable.”). In one embodiment, “stereotypical phrases that people commonly use to convey particular information” are referred to as regular

expressions. *Id.* at 2:11-15. In other particular embodiments, a regular expression may be a trigger prefix or trigger suffix. *Id.* at 3:41-50 (“A trigger prefix is a characteristic phrase that typically precedes a piece of information, for example, in a voice mail message, ‘give me a call back at’ is a trigger phrase that precedes a phone number. A trigger suffix is a phrase that typically follows a key piece of information, even when a trigger prefix is not present. For example, the phrase ‘talk to you later bye’ is often a post-facto signal that a phone number has been provided, when the words immediately preceding the phrase are a sequence of numbers.”).

Sheth explicitly teaches away from matchable text patterns and, particularly, the aforementioned embodiments of regular expressions (*e.g.*, stereotypical phrases, trigger prefixes, and trigger suffixes) described in the ’796 Patent. For example, Sheth notes that it is directed to a ***semantics or context-based approach*** to its extraction rules: “syntax and structure-based methods pervade the entire Web—both in its creation and the applications realized over it. The challenge has been to include semantics in creating physical or virtual organizations of the Web and its applications.” Ex. 1004 at 4:44-48. Therefore, “text as on a Web page, in HTML, or in a database by itself constitutes [] syntax only” and not within the definition of “metadata” that an extraction rule would specify. *Id.* at 7:1-4. In fact, because Sheth focuses on a semantics-based approach to matching, instead of syntax and structure, Sheth admits that it must use asset objects containing a set of attribute-value pairs

rather than regularly identifiable expressions of text because “the task of reliably finding proper names in continuous text is nearly impossible using only a regular expression-based language.” *Id.* at 13:3-11. The unreliability of Sheth for such use cases is precisely what the ’796 Patent solves.

Thus, Petitioner fails to show that Sheth renders this limitation obvious.

(b) Sheth Does Not Disclose “identifying at least a portion of information associated with the at least one regularly identifiable expression” as Required by Claims 1, 12, 23, and 25

Claims 1, 23, and 25 of the ’796 Patent recite “identifying at least a portion of information associated with the at least one regularly identifiable expression.” Claim 12 recites “at least one processor operative to” “identify at least a portion of information associated with the at least one regularly identifiable expression.” Sheth does not render this claim limitation obvious, as Petitioner asserts. Pet. at 20-21. In other words, the claims require not just matching the text identified by the regular expression, but also identifying a portion of information “associated with” the matched regular expression.

Since Petitioner fails to show how Sheth discloses, teaches, or suggests “identifying at least one regularly identifiable expression,” it cannot now disclose, teach, or suggest “identifying at least a portion of information associated with the at least one regularly identifiable expression.” *See supra* Section VII.A.1(a).

Additionally, Petitioner incorrectly alleges that “‘locat[ing] the value’ for an attribute using a matchable pattern” meets this claimed limitation. Pet. at 20-21. However, designating a pattern to locate a value for attributes associated with the type of content is completely unrelated to identifying information associated with regularly identifiable expressions. Ex. 1004 at 11:40-52 (“These rules list the *metadata attributes for the type of media* that this site contains”) (emphasis added). One example given by Sheth is that “a particular asset extracted from CNN.com could have the type ‘News Asset’, location ‘Atlanta’, clip length ‘1:32’, as well as several other attribute-values.” *Id.* at 12:34-42. Sheth’s attribute-values are neither regularly identifiable expressions nor portions of information associated with regularly identifiable expressions, but rather attributes, metadata, or a classification of the entire content itself.

Petitioner also alleges that “retriev[ing] small sections of text” meets this claimed limitation. Pet. at 20-21. This is wrong because retrieved text cannot, at once, be both the regularly identifiable expression and the claimed “portion of information associated,” as Petitioner argues. As noted above in Section VII.A.1(a), particular embodiments of the ’796 Patent describe that regularly identifiable expressions *can be text*, such as trigger prefixes, trigger suffixes, or stereotypical phrases, instead of the “*at least a portion of information associated with* the [text]” that is claimed by this element.

Therefore, Petitioner completely sidesteps actually showing where Sheth discloses, teaches, or suggests the claimed “at least a portion of information associated with at least one regularly identifiable expression” and fails to show that Sheth renders this limitation obvious.

(c) Sheth Does Not Disclose “extracting the portion of information” as Required by Claims 1, 12, 23, and 25

Claims 1 and 23 of the '796 Patent recite “extracting the portion of information.” Claim 12 recites “at least one processor operative to” “extract the portion of information.” Claim 25 recites “identifying at least a portion of information . . . for extraction.” Sheth does not render this claim limitation obvious, as Petitioner asserts. Pet. at 21-22.

Since Petitioner fails to show how Sheth discloses, teaches, or suggests “identifying at least a portion of information associated with the at least one regularly identifiable expression,” it cannot now disclose, teach, or suggest “extracting the portion of information.” *See supra* Section VII.A.1(b).

2. Dependent Claims 2-10 and 13-21

Claims 2-10 are dependent on Claim 1 and Claims 13-21 are dependent on Claim 12. Therefore, Claims 2-10 and Claims 13-21 are not obvious over Sheth for at least the same reasons as Claims 1 and 12, respectively.

B. Ground 2: Claims 1-10, 12-21, 23, and 25 are Not Obvious Over Richardson and Madnick

1. Independent Claims 1, 12, 23, and 25

(a) Richardson and Madnick Do Not Disclose “identifying at least a portion of information associated with the at least one regularly identifiable expression” as Required by Claims 1, 12, 23, and 25

Claims 1, 23, and 25 of the '796 Patent recite “identifying at least a portion of information associated with the at least one regularly identifiable expression.” Claim 12 recites “at least one processor operative to” “identify at least a portion of information associated with the at least one regularly identifiable expression.” Sheth does not render this claim limitation obvious, as Petitioner asserts. Pet. at 20-21.

Richardson uses a regular expression list and a phrase type list to assign tags to a message, such as shown in Table 1 and Table 2 in its specification, as well as in Fig. 5A. Ex. 1005 at 8:49-9:28. If a regular expression from the list is matched in the message, the matching expression is tagged.

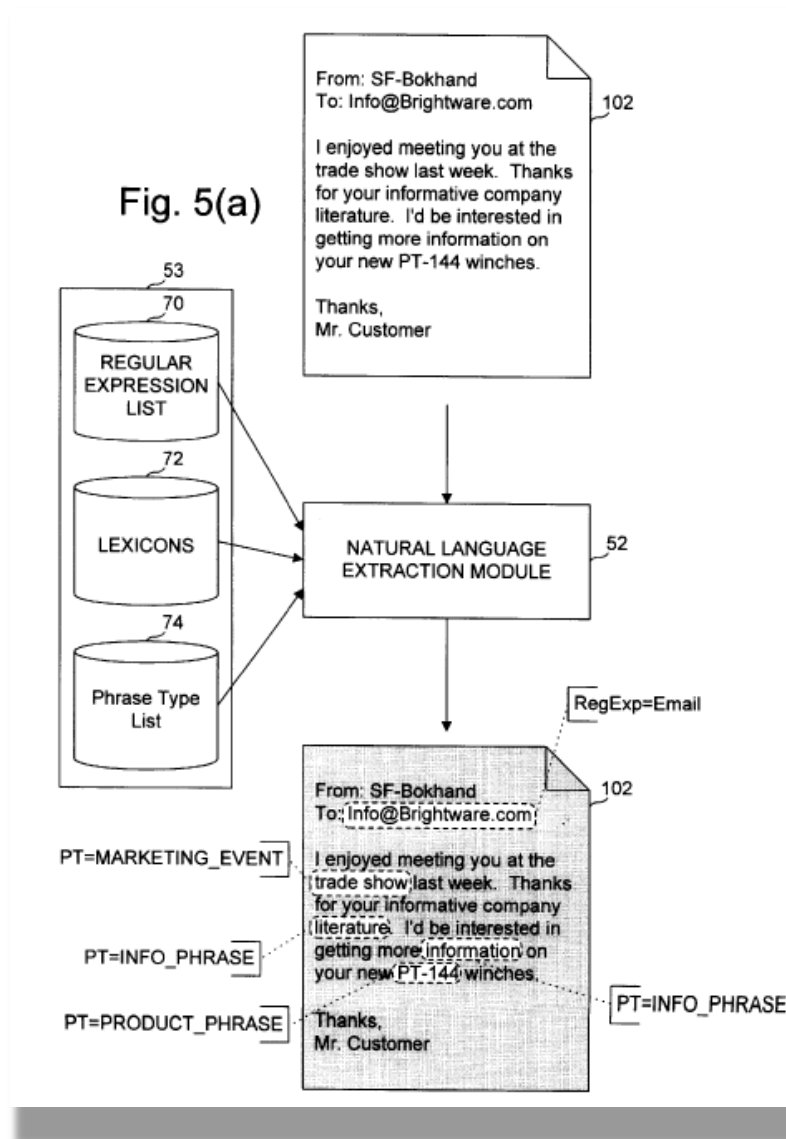
TABLE 1

Regular Expression List	
Expression	Type
http://*{ /* }>	URL
###-###-####	Phone
[a-zA-Z]@*.*	Email
...	...

TABLE 2

<u>Phrase Type List</u>	
Phrase	Type
information	INFO_PHRASE
“product literature”	INFO_PHRASE
...	...
PT-140	PRODUCT_PHRASE
PT-141A	PRODUCT_PHRASE
PT-143	PRODUCT_PHRASE
PT-144	PRODUCT_PHRASE
“trade show”	MARKETING_EVENT
...	...
#\$%%\$^!!*	PROFANITY_PHRASE
...	...

Id.



Id. at Fig. 5(a).

But this tagging mechanism of Richardson is exactly the kind of prior art that the '796 Patent mentions in its background and seeks to improve through this claim limitation of “*identifying at least a portion of information associated with* the at least one regularly identifiable expression,” instead of just tagging any regularly identifiable expression, as Richardson does.

In the past, several techniques have been developed to solve the somewhat simpler problem of “named entity extraction.” In this task, the goal is to identify all occurrences of certain classes of words in a document. For example, all the person-names, city-names, dates, and times might be identified. One way of identifying such entities is to train a statistical classification system to tag each word in the document as either a “person-name,” “city-name,” “date,” “time,” or “other” word. . . .

[S]uch a tagging approach fails to explicitly identify the portions of text that are important. Thus, there is a need for data processing techniques which *explicitly identify portions of data that are sought to be identified, rather than only implicitly identifying, or tagging, such portions of data.*

’796 Patent at 1:24-50 (emphasis added). The claim limitation requires more than the mere tagging offered by Richardson.

Madnick does not remedy Richardson’s failure to obviate this claim limitation, which is why Petitioner does not rely on Madnick at all to disclose, teach, or suggest this limitation. Therefore, Petitioner fails to show that Richardson in combination with Madnick renders this limitation obvious.

**(b) Richardson and Madnick Does Not Disclose
“extracting the portion of information” as Required by
Claims 1, 12, 23, and 25**

Claims 1 and 23 of the ’796 Patent recite “extracting the portion of information.” Claim 12 recites “at least one processor operative to” “extract the portion of information.” Claim 25 recites “identifying at least a portion of

information . . . for extraction.” Sheth does not render this claim limitation obvious, as Petitioner asserts. Pet. at 21-22.

Since Petitioner fails to show how Sheth discloses, teaches, or suggests “identifying at least a portion of information associated with the at least one regularly identifiable expression,” it cannot now disclose, teach, or suggest “extracting the portion of information.” *See supra* Section VII.B.1(a).

2. Dependent Claims 2-10 and 13-21

Claims 2-10 are dependent on Claim 1 and Claims 13-21 are dependent on Claim 12. Therefore, Claims 2-10 and Claims 13-21 are not obvious over Richardson in combination with Madnick for at least the same reasons as Claims 1 and 12, respectively.

C. Ground 3: Claims 11, 22, and 24 Are Not Obvious Over Richardson, Madnick, and Groner

1. Richardson, Madnick, and Groner Do Not Disclose Claim 24

Claim 24 shares the claim elements “at least one processor, operatively coupled to the data capture device, operative to: (i) identify at least one regularly identifiable expression in the input Sequence of data symbols, wherein the at least one regularly identifiable expression represents a pattern that is matchable in accordance with a programming language that supports such a regularly identifiable expression; (ii) identify at least a portion of information associated with the at least

one regular expression; and (iii) extract the portion of information” with Claim 12, and is not obvious for substantially the same reasons discussed above for Claim 12 with respect to Richardson and Madnick, alone or in combination. *See supra* Section V.B.1.

Groner also does not disclose, teach, or disclose these claim limitations of Claim 12 and 24. Groner is merely directed towards “a need for a system and method that uses speech recognition software to automatically convert voice messages not text messages suitable for sending as e-mail messages and for viewing on a display device[.]” Ex. 1007 at 2:54-60.

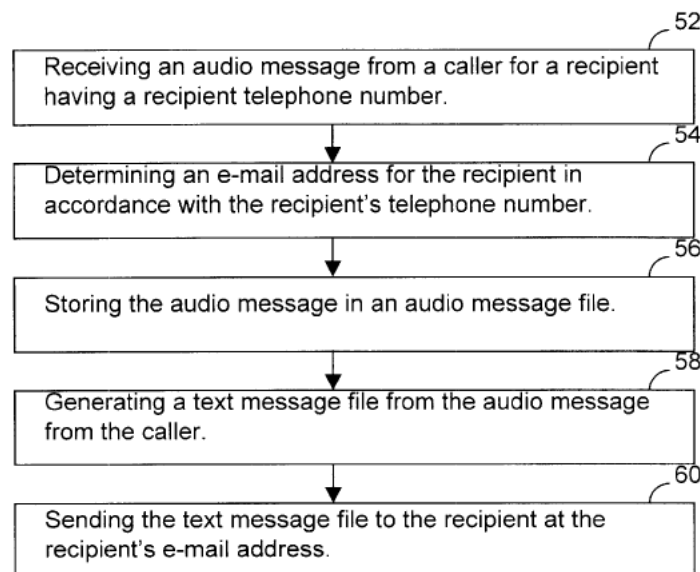


FIG. 2

Id. at Fig. 2. Groner does not even remotely talk about a regularly identifiable expression, identifying a portion of information associated with the regularly

identifiable expression, or extracting the portion of information. Groner only extracts the full text conversion from a full voice mail.

Moreover, there is no reason any person of skill in the art would be motivated to combine Groner with either Richardson or Madnick. Groner is not directed toward tagging types of data like Richardson nor is it directed toward retrieving applicable data through queries on heterogeneous data sources. Groner merely converts a voicemail message to text using speech recognition. Petitioner alleges that a person of skill in the art could conceivably use Groner to convert speech to text, and then use Richardson to tag regular expressions in the text. This is not a combination. It is using one reference for one problem and then sequentially using another reference for another problem. Under Petitioner's faulty logic, a person of skill in the art would be motivated to combine all devices and methods that utilize text with Groner. It is only by hindsight that Petitioner fuses the processes of both Groner and Richardson, which even then does not disclose, teach, or suggest the claimed invention.

Therefore, the combination of Richardson, Madnick, and Groner cannot disclose Claim 24.

**2. Richardson, Madnick, and Groner Do Not Disclose
Dependent Claims 11 and 22**

Claim 11 is dependent on Claim 1 and Claim 22 is dependent on Claim 12.

Therefore, Claims 11 and 22 are not obvious over either Richardson or Madnick, alone or in combination, for at least the same reasons as Claims 1 and 12, respectively. Groner adds nothing to the combination of Richardson or Madnick to obviate Claims 1 or 12, nor is there motivation to combine Groner with Richardson or Madnick, as described above in Section VII.C.1.

Therefore, Claims 11 and 22 are not obvious over Richardson in combination with Madnick and Groner.

VIII. PETITIONER’S EXPERT DECLARATION SHOULD NOT BE CONSIDERED

“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.” 37 C.F.R. § 42.65(a). Here, the Declaration of Dr. Black is almost entirely a word-for-word recitation of the Petition, except for the Introduction, Background sections describing Dr. Black’s experience, and Legal Standards Used in Dr. Black’s analysis. *See* Ex. 2007 (redline comparison). Because Dr. Black does not provide any independent analysis aside from copying the attorney arguments in the Petition and does not disclose the underlying facts or data upon which his opinions are based, his opinion should be entitled to no weight. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper No. 9 (P.T.A.B. Aug 24, 2022) (designated precedential Feb. 10, 2023, Paper 12) (denying

institution and rejecting a conclusory and unsupported expert declaration that repeated portions of the Petition verbatim.).

IX. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board deny institution of the Petition in its entirety.

Respectfully submitted,

Dated: May 22, 2023

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE specified in 37 C.F.R. § 42.24 has 7,126 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

Respectfully Submitted,

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A copy of PATENT OWNER'S PRELIMINARY RESPONSE and EXHIBITS 2001 through 2007 have been served on Petitioner's counsel of record as follows:

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