

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBER TECHNOLOGIES, INC.,
Petitioner,

v.

SURGETECH LLC,
Patent Owner.

IPR2023-00735
Patent 11,334,598 B2

Before JAMES A. TARTAL, MICHAEL L. WOODS, and
RYAN H. FLAX, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

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

I. INTRODUCTION

Uber Technologies, Inc. (“Petitioner”)¹ filed a Petition pursuant to 35 U.S.C. §§ 311–319 requesting an *inter partes* review of claims 1–20 (“the Challenged Claims”) of U.S. Patent No. 11,334,598 B2 (Ex. 1001, “the ’598 patent”). Paper 2 (“Pet.”).² Surgetech LLC (“Patent Owner”)³ filed a Corrected Patent Owner Preliminary Response. Paper 12 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b) (2018); 37 C.F.R. § 42.4(a) (2019). An *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . shows that there is 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). Even when that standard is satisfied, however, the Board has discretion to deny institution.⁴

¹ Petitioner identifies “as a potential RPI, Uber Freight Holding Corp., the entity that controls the Uber Freight product/service, which PO has maintained is infringing [the] ’598 [patent] in litigation.” Pet. 11–12.

² The Petition, as filed, exceeded the word limit set for a petition and was accompanied by a Motion to Waive Word Count Pursuant to 37 C.F.R. § 42.24(a)(2) (Paper 5, the “Motion to Waive Word Count”). Petitioner’s Motion to Waive Word Count was granted. *See* Paper 10.

³ Patent Owner identifies no additional real parties in interest. Paper 7, 2.

⁴ *See Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *see also Adaptics Limited v. Perfect Co.*, IPR2018-01596, Paper 20, at 17–18 (PTAB Mar. 6, 2019) (informative) (explaining that where a petition “suffers from a lack of particularity that results in voluminous and excessive grounds,” the Board may exercise its discretion to deny institution).

Upon consideration of the evidence and arguments in the Petition (including its supporting testimonial evidence) as well as the evidence and arguments in the Preliminary Response, for the reasons below, we determine that Petitioner fails to show a reasonable likelihood it would prevail with respect to any of the Challenged Claims. We further determine that the Petition fails to identify with particularity the grounds and evidence supporting them, which results in voluminous and excessive grounds. We thus deny institution of *inter partes* review.

II. BACKGROUND

A. The '598 Patent

The '598 patent, titled “Computer-Implemented Management Of Bookings For Transportation Services,” issued on May 17, 2020, from U.S. Patent Application No. 17/542,933, filed December 6, 2021. Ex. 1001, codes (21), (22), (45), (54). The '598 patent is directed to a “computer-implemented method of managing online bookings for transportation services inventory.” *Id.* at code (57).

According to the '598 patent, a “particular problem is that the market has forced vendors to commit physical inventory to particular Channels in a relatively ad hoc manner,” “selecting the most efficient Channels can become extremely difficult,” and “most independent hotels and accommodation properties lack the resources to have members of staff dedicated to managing allocations to Channels.” *Id.* at 1:36–44. The '598 patent describes in summary form a “computer-implemented method of managing online bookings for transportation services inventory” as follows:

The computer-implemented method links, via a computerized network, each item in the transportation services inventory with one of a plurality of online distributions channels by allocating the item to the respective online distribution channel.

Furthermore, the computer-implemented method receives, from each of a plurality of online distribution channels in real time via the computerized network, sale data pertaining to the online bookings for the items in the transportation services inventory allocated to the respective online distribution channel. The computer-implemented method processes the sale data by carrying out calculations to obtain a performance rating for each of the respective online distribution channels. Additionally, the computer-implemented method queries whether the performance rating of each of the respective online distribution channels is greater than a performance rating of other online distribution channels. Based on the query being answered in the affirmative, the computer-implemented method carries out at least one of the following: adjusting, via the computerized network, a price of the items in the transportation services inventory allocated to each of the linked online distribution channels; and modifying, via the computerized network, the linkage of the items in the transportation services inventory to the respective online distribution channels by re-allocating the items in the transportation services inventory to or from said each of the online respective distribution channels from or to the other online distribution channels.

Id. at 1:50–2:12.

B. Illustrative Claim

Petitioner challenges claims 1–20 of the '598 patent. Pet. 1. Claims 1, 9, and 17 are independent. Claim 9, which is central to Petitioner's arguments, is illustrative of the claimed subject matter and is reproduced below, with labeling in brackets added by Petitioner to identify specific portions of the claim:

9. [pre] A non-transitory computer-readable storage medium, the non-transitory computer-readable storage medium storing computer instructions to be implemented on at least one computing device including at least one processor, the computer instructions when executed by the at least one processor cause the at least one computing device to:

- [a] link, via a computerized network, each item in transportation services inventory with one of a plurality of online distributions channels by allocating the item to the respective online distribution channel;
- [b] receive, from each of the plurality of online distribution channels in real time via the computerized network, sale data pertaining to online bookings for the items in the transportation services inventory allocated to the respective online distribution channel;
- [c] process the sale data by carrying out calculations to obtain a performance rating for each of the respective online distribution channels;
- [d] query whether the performance rating of each of the respective online distribution channels is greater than a performance rating of other online distribution channels;
- [e] and based on the query being answered in the affirmative, carrying out at least one of the following:
 - [f] adjust, via the computerized network, a price of the items in the transportation services inventory allocated to each of the linked online distribution channels; and
 - [g] modify, via the computerized network, the linkage of the items in the transportation services inventory to the respective online distribution channels by reallocating the items in the transportation services inventory to or from said each of the online respective distribution channels from or to the other online distribution channels.

Ex. 1001, 42:14–48; Pet. Claims App’x. ii–iii (adding bracketed lettering to identify portions of the claim).

C. Asserted Grounds of Unpatentability

In the Petition, Petitioner purports to list sixteen grounds under which it contends the Challenged Claims are unpatentable, as set forth in the following table:

Claims Challenged	35 U.S.C. §⁵	References/Basis
1, 2, 4, 6–10, 12, 14–20	103(a)	Jacob, ⁶ Phillips ⁷
1, 2, 4, 6–10, 12, 14–20	103(a)	Jacob, Phillips, Evangelist ⁸
1, 2, 4, 6–10, 12, 14–20	103(a)	Jacob, Phillips, Franklin ⁹
1, 2, 4, 6–10, 12, 14–20	103(a)	Jacob, Phillips, Evangelist, Franklin
1–20	103(a)	Jacob, Phillips, Tamura ¹⁰
1–20	103(a)	Jacob, Phillips, Evangelist, Tamura
1–20	103(a)	Jacob, Phillips, Franklin, Tamura
1–20	103(a)	Jacob, Phillips, Evangelist, Franklin, Tamura

⁵ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 103 that became effective on March 16, 2013. We apply the pre-AIA version of § 103 here, because the earliest provisional application identified in the ’598 patent was filed before the effective date of the AIA and Petitioner does not currently challenge this priority date. *See* Ex. 1001, code (63). We note that our analysis in this Decision would not change under the AIA version of § 103.

⁶ U.S. Patent App. Pub. No. US 2007 /0075136 A1, published Apr. 5, 2007 (Ex. 1004, “Jacob”)

⁷ Robert L. Phillips, *PRICING AND REVENUE OPTIMIZATION*, Stanford University Press, 2005 (Ex. 1029, “Phillips”).

⁸ U.S. Pat. No. 7,996,265 B2, issued Aug. 9, 2011 (Ex. 1010, “Evangelist”).

⁹ Franklin, et al., *Dissemination-Based Information Systems*, Data Engineering, IEEE Computer Society, Vol. 19, No. 3, Sept. 1996 (Ex. 1009, “Franklin”).

¹⁰ Japanese Unexamined Pat. App. Pub. JP 2005-332346A, published Dec. 2, 2005 (translation) (Ex. 1005, “Tamura”).

Claims Challenged	35 U.S.C. § ⁵	References/Basis
1, 2, 4, 6–10, 12, 14–20	103(a)	Jacobs, Phillips, Kono ¹¹
1, 2, 4, 6–10, 12, 14–20	103(a)	Jacobs, Phillips, Evangelist, Kono
1, 2, 4, 6–10, 12, 14–20	103(a)	Jacobs, Phillips, Franklin, Kono
1, 2, 4, 6–10, 12, 14–20	103(a)	Jacobs, Phillips, Evangelist, Franklin, Kono
1–20	103(a)	Jacob, Phillips, Tamura, Kono
1–20	103(a)	Jacob, Phillips, Evangelist, Tamura, Kono
1–20	103(a)	Jacob, Phillips, Franklin, Tamura, Kono
1–20	103(a)	Jacob, Phillips, Evangelist, Franklin, Tamura, Kono

Pet. 13–14. Petitioner further relies on the supporting Declaration of Dr. Amelia Regan, dated March 27, 2023. Ex. 1003. Dr. Regan’s Declaration includes 718 paragraphs of testimony spanning 521 pages, as well as “Claim Charts” in an appendix that spans an additional 278 pages.

Patent Owner relies on the supporting Declaration of Dr. Vijay Madisetti. Ex. 2001. Dr. Madisetti states, in part, that Petitioner includes in the Petition “block quotations from multiple prior art references” for the same element of claims. *Id.* ¶ 60. Further, according to Dr. Madisetti, because Petitioner’s “omnibus chart does not specify which references pertain to which ground, any number of combinations could be constructed.” *Id.* ¶ 61. Dr. Madisetti calculates that the number of combinations of prior

¹¹ Japanese Unexamined Pat. App. Pub. JP 2002-104622A, published Apr. 10, 2002 (Ex. 1007, “Kono”).

art asserted in the Petition is not limited to sixteen grounds but instead encompasses thousands of grounds. *Id.* ¶ 62.

D. Related Proceedings

The parties identify the '598 patent as a subject of *SurgeTech, LLC v. Uber Technologies, Inc. d/b/a Uber*, Case No. 1:22-cv-00882-GBW (D. Del.). Pet. 12; Paper 7, 2. Petitioner also filed petitions challenging claims of two other related patents in *Uber Technologies, Inc. v. SurgeTech LLC*, IPR2023-00737 and *Uber Technologies, Inc. v. SurgeTech LLC*, IPR2023-00738.

Concurrent with the Petition, Petitioner filed a second petition challenging claims 6, 7, 14, 15, 19, and 20 of the '598 patent in *Uber Technologies, Inc. v. SurgeTech LLC*, IPR2023-00736. Pet. 12. Petitioner also filed an Explanation of Parallel Petitions, requesting that we consider the petition in IPR2023-00736 only if we denied Petitioner's Motion to Waive Word Count in this proceeding. Paper 4, 1. Because we granted Petitioner's Motion to Waive Word Count, the petition in IPR2023-00736 was dismissed. IPR2023-00736, Paper 12.

III. ANALYSIS

A. Legal Standards for Obviousness

A patent claim is unpatentable for obviousness 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). In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the Supreme Court set out a framework for assessing obviousness that requires consideration of four factors: (1) the "level of ordinary skill in the pertinent art," (2) the "scope

and content of the prior art,” (3) the “differences between the prior art and the claims at issue,” and (4) “secondary considerations” of nonobviousness such as “commercial success, long felt but unsolved needs, failure of others, etc.” 383 U.S. at 17–18; *KSR*, 550 U.S. at 407.

“Whether an ordinarily skilled artisan would have been motivated to modify the teachings of a reference is a question of fact.” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1327 (Fed. Cir. 2016) (citations omitted).

“[W]here a party argues a skilled artisan would have been motivated to combine references, it must show the artisan ‘would have had a reasonable expectation of success from doing so.’” *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1360–61 (Fed. Cir. 2017) (quoting *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1068–69 (Fed. Cir. 2012)).

B. Level of Ordinary Skill in the Art

The level of skill in the art is a factual determination that provides a primary guarantee of objectivity in an obviousness analysis. *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 1324 (Fed. Cir. 1999) (citing *Graham*, 383 U.S. at 17–18; *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991)). In determining the level of ordinary skill in the art, 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) (citation omitted).

Petitioner contends a person of ordinary skill in the art “would at minimum have a bachelor’s degree in software/computer/electrical engineering, computer science, or industrial engineering and management

with at least two years[] experience in inventory and pricing management, including with respect to systems for dynamically managing inventory and pricing of transportation services or other types of inventory, or the equivalent.” Pet. 16. Petitioner also contends “[a]dditional graduate education could substitute for professional experience, or significant inventory and pricing management experience could substitute for formal education.” *Id.* (citing Ex. 1003 ¶¶ 17–18). Patent Owner does not dispute the level of ordinary skill identified by Petitioner. *See* Prelim. Resp. 10. For purposes of this Decision, we apply Petitioner’s proposed level of skill because, on the current record, it is consistent with the level of skill at the time of the claimed invention reflected by the ’598 patent and the cited prior art references. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

C. Claim Construction

We apply the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b). 37 C.F.R. § 42.100(b). Under that standard, claim terms “are generally given their ordinary and customary meaning” as would have been understood by a person of ordinary skill in the art at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc)).

“In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). Extrinsic evidence is “less significant than the intrinsic record in determining ‘the legally operative meaning of claim language.’” *Phillips*, 415 F.3d at 1317.

Petitioner proposes constructions for two claim phrases: “receiving . . . in real time” and “carrying out at least one of the following steps: adjusting . . . ; and re-allocating.” Pet. 15. Patent Owner does not address Petitioner’s proposed constructions for these terms. *See generally* Prelim. Resp.

Patent Owner additionally argues that Petitioner “fails to identify how it has construed a number of key claim limitations.” Prelim. Resp. 42. In particular, Patent Owner argues that in related district court proceedings Petitioner contends that the claim terms “inventory” and “distribution channel” are “expressly defined in the patent through lexicography,” but that Petitioner argues in this proceeding no construction is necessary. *Id.* at 42–43 (citing Pet. 14–15; Ex. 2010, 7, 9). According to Patent Owner, it “cannot possibly rebut the petition’s conclusory assertions that certain prior art discloses ‘inventory’ and ‘distribution channel[s]’ without knowing how Petitioner and its expert construed these terms in the first place.” *Id.* at 43–44. Patent Owner further asserts that in related district court proceedings, Petitioner maintains that the claim term “adjusting a price” is indefinite, but fails to explain in this proceeding what definition it is applying. *Id.* at 44–45. Patent Owner also asserts that in related district court proceedings the Parties “have an ongoing dispute regarding what the plain meaning of ‘performance rating’ is,” but “in this proceeding, Petitioner provides no proposed construction for ‘performance rating,’” making it “unclear how Petitioner is applying this term in its [P]etition.” *Id.* at 45.

While the Parties raise arguments related to claim construction, as summarized above, the Parties do not propose competing constructions for any claim term at this stage of the proceeding. *Compare* Pet. 14–15, with Prelim. Resp. 42–45. For purposes of this Decision, we give the claims their

plain and ordinary meaning, and we need not and do not expressly construe any term. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (stating that “we need only construe 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)).

D. Denying Inter Partes Review for Lack of Particularity

In considering Petitioner’s arguments, we begin with the statutory requirement that a petition seeking *inter partes* review must identify “with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3); *see also* 37 C.F.R. § 42.104(b) (specifying necessary elements of a petition). Consistent with those requirements, the Board’s *Trial Practice Guide* advises that petitioners should “avoid submitting a repository of all the information that a judge could possibly consider, and instead focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.” Consolidated Trial Practice Guide, at 39 (Nov. 2019).¹²

This requirement is “of the utmost importance,” as the Federal Circuit has explained, because a detailed and clear explanation of the challenge at the outset is necessary so that the parties and the Board can complete the trial within the statutorily prescribed timeframe:

Unlike district court litigation—where parties have greater freedom to revise and develop their arguments over time and in response to newly discovered material—the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute. While the Board’s requirements are

¹² Available at www.uspto.gov/sites/default/files/documents/tpgnov.pdf.

strict ones, they are requirements of which petitioners are aware when they seek to institute an IPR.

Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd., 821 F.3d 1359, 1369 (Fed. Cir. 2016).

The Board has further explained that the “all-or-nothing” nature of institution decisions following *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018), gives heightened importance to the statutory requirement for particularity in an IPR petition:

Because the Board’s practice, in light of *SAS*, is to institute on all grounds asserted in a petition, the Board may consider whether a lack of particularity as to one or more of the asserted grounds justifies denial of an entire petition. For example, where a petition contains voluminous or excessive grounds, Office guidance indicates “[t]he panel will evaluate the challenges and determine whether, in the interests of efficient administration of the Office and integrity of the patent system (see 35 USC § 316(b)), the entire petition should be denied under 35 USC § 314(a).”

Adaptics Limited v. Perfect Co., IPR2018-01596, Paper 20, at 17–18 (PTAB Mar. 6, 2019) (informative). Following *Adaptics*, the Board has consistently denied petitions that asserted inordinately large numbers of ambiguous grounds. See, e.g., *In EnergySource Minerals, LLC v. TerraLithium LLC*, IPR2019-01607, Paper 10 (PTAB May 4, 2020) (denying institution where the use of “and/or” in listing the references applied under obviousness grounds in the petition led to voluminous, excessive, and ambiguous grounds); *Sinjimoru v. Geneze Innovation Inc.*, IPR2021-00493, Paper 8 (PTAB July 28, 2021) (denying institution where the petition purported to present 32 grounds, but, because many of those grounds asserted multiple statutory bases and multiple combinations of references, the petition actually advanced 205 different grounds); *Playtika Ltd. and Playtika Holding*

Corp. v. NexRF Corp., IPR2021-00952, Paper 14 (PTAB November 6, 2021) (denying institution where the petition “challenges ten claims by combining eight references in various permutations to arrive at 96 grounds” and where the grounds are unclear because petitioner “lumps together the discussion of large numbers of grounds under a single heading” thereby obscuring the specific arguments advanced).

Petitioner argues that the Challenged Claims would have been obvious under the following grounds:

Claims 1-2, 4, 6-10, 12, and 14-20 are obvious over Jacob in view of Phillips (Ground 1), over Jacob in view of Phillips and Evangelist (Ground 2), over Jacob in view of Phillips and Franklin (Ground 3), over Jacob in view of Phillips, Evangelist, and Franklin (Ground 4), over Jacob in view of Phillips and Kono (Ground 9), over Jacob in view of Phillips, Evangelist, and Kono (Ground 10), over Jacob in view of Phillips, Franklin, and Kono (Ground 11), and over Jacob in view Phillips, Evangelist, Franklin, and Kono (Ground 12); Claims 1-20 are obvious over Jacob in view of Phillips and Tamura (Ground 5), over Jacob in view of Phillips, Evangelist, and Tamura (Ground 6), over Jacob in view of Phillips, Franklin, and Tamura (Ground 7), over Jacob in view of Phillips, Evangelist, Franklin, and Tamura (Ground 8), over Jacob in view of Phillips, Tamura, and Kono (Ground 13), over Jacob in view of Phillips, Evangelist, Tamura, and Kono (Ground 14), over Jacob in view of Phillips, Franklin, Tamura, and Kono (Ground 15), over Jacob in view of Phillips, Evangelist, Franklin, Tamura, and Kono (Ground 16).

Pet. 13–14 (emphasis omitted). Petitioner purports to show in the Petition the alleged unpatentability of the Challenged Claims under all sixteen grounds in a single, combined argument and table, addressing all prior art simultaneously with no distinction between grounds or proposed combinations of references. Pet. 28–110. Further, it is apparent from Petitioner’s arguments that the grounds asserted by Petitioner are not limited

to only the sixteen asserted combinations of prior art noted above. Instead, Petitioner presents multiple arguments to purportedly show how various combinations of asserted art teach each limitation of a challenged claim, which Petitioner then combines over all of the limitations of a claim to allegedly show unpatentability. *See, e.g.*, Pet. 33–47. Patent Owner argues that the Petition is “indiscernible” and that Petitioner “has failed to identify its grounds of unpatentability with particularity.” Prelim. Resp. 11.

Because Petitioner begins in the Petition with its contentions directed to claim 9, we use limitations of claim 9 as an example. Pet. 29–80. As to limitation 9[a], Petitioner asserts that it is expressly disclosed by Jacob, and that “if argued further disclosure of allocating is required,” then a person of ordinary skill in the art “would have found it obvious from Jacob (in the recited combinations) in view of Evangelist.” *Id.* at 33–40. As to limitation 9[b], Petitioner relies on Jacob, Tamara, Kono, and Franklin and asserts that “Jacob discloses ‘real time,’” that “real time” was “obvious from Jacob (in the recited combinations) in view of Franklin,” that “[i]f argued further disclosure of receiving sale data is required, this was obvious from Jacob (in the recited combinations)^[1] in view of (1) Kono’s or (2) Tamura’s disclosures above,” and that “[i]f further disclosure of real time in the temporal sense is required, this would have been rendered obvious in view of the disclosures of Phillips (already part of the recited combinations) for the reasons set forth immediately above for Franklin.” *Id.* at 47 (emphasis omitted). Petitioner employs this approach for each of the seven limitations of claim 9 labeled [a] to [g], in addition to the preamble of claim 9. *Id.* at 33–80.

First, Patent Owner argues, and we agree, that Petitioner fails to make explicit what the “recited combinations” are that should be considered, for

example, with Jacob for claims 9[b]. Prelim. Resp. 26 (further noting that Petitioner “relies on unidentified ‘recited combinations’ *thirty-seven (37) times* in its petition without ever explaining what these ‘recited combinations’ are.” *Id.* (citing Pet. 40, 44, 46, 47, 53, 55, 56, 60, 61, 63, 67, 69, 70, 71, 78, 79, 83, 85, 86, 88, 89, 98, 99, 101, 109)).

Second, Patent Owner argues, and we agree, that Petitioner’s arguments present thousands of asserted combinations of prior art. Dr. Madisetti explains that Petitioner’s “omnibus chart does not specify which references pertain to which ground,” such that the “total number of possible combinations can be calculated by multiplying the number of references [Petitioner] lists for each claim element 9[pre]-[g].” Ex. 2001 ¶¶ 61–62. Dr. Madisetti calculates that, because Petitioner argues teachings from multiple references as to each limitation (two references as to 9[pre], two references as to 9[a], four references as to 9[b], four references as to 9[c], three references as to 9[d], three references as to 9[e], three references as to 9[f], and four references as to 9[g]) the number of unique combinations of teachings Petitioner asserts against claim 9 equals 6,912 (i.e., $2*2*4*4*3*3*3*4$). *See* Ex. 2001 ¶ 62. The voluminous and excessive grounds presented in the Petition, alone, warrants denial of *inter partes* review. *See Adaptics*, Paper 20, at 17–18; *see also Avant Technology, Inc. v. Anza Technology, Inc.*, IPR2018-00828, Paper 7 at 13–14 (PTAB October 16, 2018) (denying institution, where the petition relied on a claim chart that asserted multiple claim elements were taught in more than one of the asserted references, resulting in 576 different ways to combine the prior art).

Moreover, the lack of particularity in the Petition is not merely limited to the issue of thousands of asserted combinations of art. Patent Owner

argues, and we agree, that Petitioner presents in the Petition “a single, omnibus claim chart that cites to numerous pages of prior art without any substantive explanation describing how those quotations are relevant or how they should be combined” and “exacerbates this confusion by citing to Dr. Regan’s eight-hundred forty-nine page expert report, which, despite its length, is equally conclusory.” Prelim. Resp. 11. As an example of how Petitioner presented its arguments in the Petition, we focus our discussion on the following limitations of claim 9, which Petitioner identifies as 9[e], 9[f], and 9[g]:

[e] and based on the query being answered in the affirmative, carrying out at least one of the following:

[f] adjust, via the computerized network, a price of the items in the transportation services inventory allocated to each of the linked online distribution channels; and

[g] modify, via the computerized network, the linkage of the items in the transportation services inventory to the respective online distribution channels by reallocating the items in the transportation services inventory to or from said each of the online respective distribution channels from or to the other online distribution channels.

Ex. 1001, 42:14–48; Pet. Claims App’x. ii–iii (adding bracketed lettering to identify portions of the claim).

As to limitation 9[e], Petitioner provides a chart in the Petition that includes what appear to be various quotes attributed to Jacob, Tamura, and Kono. Pet. 61–62. Petitioner provides no citation to any reference with respect to these quotes, but instead cites a multitude of paragraphs from Dr. Regan’s Declaration. *Id.* (citing Ex. 1003 ¶¶ 320–325, 328–331, 335–

340).¹³ In the same table, Petitioner subsequently includes a separate set of string citations to numerous paragraphs from Jacob, Tamura, and Kono. *Id.* at 41–44 (citing Ex. 1004 ¶¶ 74, 82, 83, 131–133, 180; Ex. 1005 ¶¶ 13, 14, 35, Figs. 2–3, cl. 4; Ex. 1007, “Summary,” ¶ 9, 10, 14, 25, 26, cl. 1, Figs. 2, 3). Further, in the same table, Petitioner includes Figures 2 and 3 from Kono, each apparently annotated by Petitioner with red boxes, but Petitioner fails to include in the Petition any identification or explanation of what the red boxes annotate. *Id.* at 62–63. Following the table, Petitioner argues as follows:

For the same reasons Jacob discloses, or at minimum renders obvious, “querying” (*see* cl.9[d] (narrative)), Jacob (in the recited combinations) renders obvious the query being answered in the affirmative. E.g., EX1004, ¶[0180]; EX1003, ¶326.

Alternatively, Jacob (in the recited combinations) in view of (1) Tamura or (2) Kono, render cl.9[e] obvious. *See* cl.9[d]; EX1003, ¶¶327, 334. For the same reasons, Jacob in view of (1) Tamura’s or (2) Kono’s express disclosures (*see* cl.9[e] (chart)), render obvious the query being answered in the affirmative. EX1003, ¶¶332, 341. POSITA would have found it routine to choose such implementation, and clear it would work and provide the expected functionality, yielding predictable results with REOS. EX1003, ¶¶332-333, 341-342.

Id. at 63–64. The Petition follows a similar approach in its discussion of claim limitations 9[f] and 9[g]. *Id.* at 64–80 (providing apparent quotes from references without citations, citing a multitude of paragraphs from Dr Regan’s declaration, providing string citations to numerous paragraphs of

¹³ In this regard, we understand Petitioner’s citation to “EX1003, ¶¶ 328–321” to be a typographical error intended to identify ¶ 331 in place of ¶ 321 of Exhibit 1003.

the asserted references, and reproducing figures from the references with red box annotations and no explanation in the Petition of the annotation).

Patent Owner argues, and we agree, that by citing “dozens of disparate passages from Jacob” in regard to a single limitation, along with “numerous citations to multiple prior art references,” the Petition fails to “identify how the prior art’s teachings should be combined in the grounds of a petition.” Prelim. Resp. at 18–19 (noting in regard to limitation 9[a] that the Petition cites “to nineteen different paragraphs, eight claims and three figures from” Jacob); *see also* Pet. 40 (further arguing in regard to limitation 9[a] that “[i]f further disclosure of allocating is required,” a person of ordinary skill “would have found it obvious from Jacob (in the recited combinations) in view of Evangelist”). Patent Owner further argues that Petitioner’s asserted motivations for combining the teachings of the asserted prior art are “cursory and conclusory” and that, with regard to reasonable expectation of success, Petitioner “repeats the same conclusory statement: ‘[i]t would have been routine to make these implementation choices, and clear they would work, providing the expected functionality and predictable results with REOS.’” Prelim. Resp. 20–22 (quoting Pet. 40, 46–48, 57, 60, 61, 71, 80, 84, 87, 89, 94, 98, 100, 109).

In sum, rather than present its challenges with particularity, the Petition simply reproduces large excerpts from multiple references while improperly incorporating by reference hundreds of pages from an expert declaration that frequently includes conclusory assertions. *See, e.g.,* Ex 1003 ¶¶ 162, 188, 201, 226, 227, 240, 250, 264, 274, 282, 292, 302, 309, 318, 326, 332, 341, 363, 384, 387, 416, 428, 444, 456, 458, 476, 495, 504, 511, 521, 535, 633, 641 (stating in substantially similar terms that it “would have been routine to make such an implementation choice,” and “clear it

would work and provide the expected functionality to yield predictable results with a reasonable expectation of success”).

Accordingly, we find that the Petition falls short of the requirement that it present “with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3). In our view, the large number of grounds is far out of proportion with the number of claims and the complexity of the issues involved. This excessiveness indicates that it would impose an undue burden for Patent Owner to respond to and for the Board to resolve all of the grounds asserted in the Petition. Moreover, in addition to the number of grounds asserted, Petitioner’s arguments in support of those grounds are unclear and impossible to discern. Petitioner does not separately discuss each individual ground, but instead lumps together the discussion of all grounds under a single heading. This grouping together of multiple grounds obscures the specific arguments advanced and the claims challenged in each individual ground. Moreover, we agree with Patent Owner that Petitioner does not adequately explain these multiple-reference combinations, or why ordinarily skilled artisans would be motivated to combine them in the manner recited.

In these circumstances, we determine that denial is appropriate because the Petition asserts voluminous and excessive grounds and fails to identify them with the requisite particularity. *See Microsoft Corp. v. FG SRC, LLC*, 860 Fed. Appx. 708, 713 (Fed. Cir. 2021) (“It is not the Board’s job to cobble together assertions from different sections of a petition or citations of various exhibits in order to infer every possible permutation of a petitioner’s arguments. Arguments in a petition must be made with particularity, not opacity”). We further determine that Petitioner fails to

show a reasonable likelihood it would prevail with respect to any of the Challenged Claims for the reasons detailed above.

IV. CONCLUSION

We deny institution of *inter partes* review of any of the Challenged Claims.

IV. ORDER

Upon consideration of the record before us, it is:

ORDERED that the Petition is denied and no *inter partes* review is instituted.

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