

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBER TECHNOLOGIES, INC.,
Petitioner,

v.

SURGETECH LLC,
Patent Owner.

IPR2023-00738
Patent 11,475,047 B2

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

FLAX, *Administrative Patent Judge*.

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

I. INTRODUCTION

Surgetech LLC (“Patent Owner”) is the owner of U.S. patent 11,475,047 B2 (“the ’047 patent”). Paper 3, 1. On April 7, 2023, Uber Technologies, Inc. (“Petitioner”) filed a Petition for *inter partes* review challenging the patentability of claims 1–6 of the ’047 patent (claims 7–12 are not challenged). Paper 1, 1, 12–13 (“Pet.”). On August 4, 2023, Patent Owner filed a (corrected) Preliminary Response to the Petition. Paper 7 (“Prelim. Resp.”). No further briefing was requested or authorized.

Under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a), we have authority to determine whether to institute trial in an *inter partes* review. We may institute an *inter partes* review if the information presented in the petition filed under 35 U.S.C. § 311, and any preliminary response filed under § 313, shows that there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged in the petition. 35 U.S.C. § 314. Even when that standard is satisfied, however, the Board may deny institution.¹ For example, the Board has explained 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. *Adaptics Limited v. Perfect Co.*, IPR2018-01596, Paper 20, at 17–18 (PTAB Mar. 6, 2019) (informative).

After reviewing the parties’ submissions, we conclude that the Petition lacks the required particularity, and also that the deficiencies in the Petition prevent Petitioner from demonstrating a reasonable likelihood it will

¹ 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.”).

prevail in showing that at least one challenged claim of the '047 patent is unpatentable. Therefore, we deny institution of *inter partes* review. Our reasoning is discussed below.

A. REAL PARTIES-IN-INTEREST

Petitioner identifies “Uber Technologies, Inc.,” and “Uber Freight Holding Corp.,” as real parties-in-interest. Pet. 11. Patent Owner identifies “Surgetech LLC” as a real party-in-interest. Paper 3, 2.

B. RELATED MATTERS

Petitioner identifies: “P[atent] O[wner] asserted '047 (and two related patents) against Uber Technologies, Inc. in *SurgeTech, LLC v. Uber Technologies, Inc. d/b/a Uber*, Case No. 1:22-cv-00882-GBW (D. Del.). [Petitioner] has challenged, in IPR2023-00735, [IPR2023]-00736, and [IPR2023]-00737, two other patents asserted against Uber.” Pet. 11. Patent Owner identifies these same matters as related to this proceeding. Paper 3, 2.

C. THE '047 PATENT

The '047 patent issued on October 18, 2022, from U.S. Application 17/749,091, which was filed on May 19, 2022. Ex. 1001, codes (45), (21), (22). The '047 patent indicates priority to a series of continuation applications and an initial continuation-in-part application spawning from PCT/AU2002/000684, filed on May 18, 2007. *Id.* at code (63), 1:7–19. Petitioner notes the '047 patent's priority indications and does not currently dispute that it should be accorded priority to the identified PCT application. Pet. 1.

The '047 patent's abstract identifies the described invention as:

A computer-implemented method of managing online bookings for transportation services inventory is provided. The

computer-implemented method establishes a channel interface that provides bidirectional communication between at least one server computing device and a vendor computing device. Furthermore, the computer-implemented method stores, via a channel data structure, a channel record for each of a plurality of distribution channels. Additionally, the computer-implemented method receives, from the vendor computing device through the channel interface, a selection, from the plurality of distribution channels, of one or more participant channels for a transportation service. The computer-implemented method also establishes, via the channel data structure, one or more active channel records based upon the one or more participant channels for the transportation service. Furthermore, the computer-implemented method establishes, via the channel data structure, one or more inactive channel records based upon one or more non-participant channels for the transportation service.

Ex. 1001, Abstr.

Figures 1 and 2, reproduced side-by-side below, illustrate an exemplary system for managing inventory allocated to respective re-sellers and a method of operating such a system:

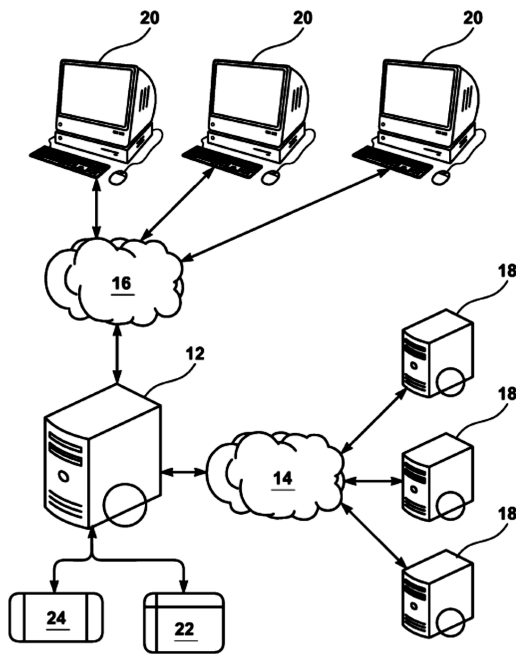


FIG. 1

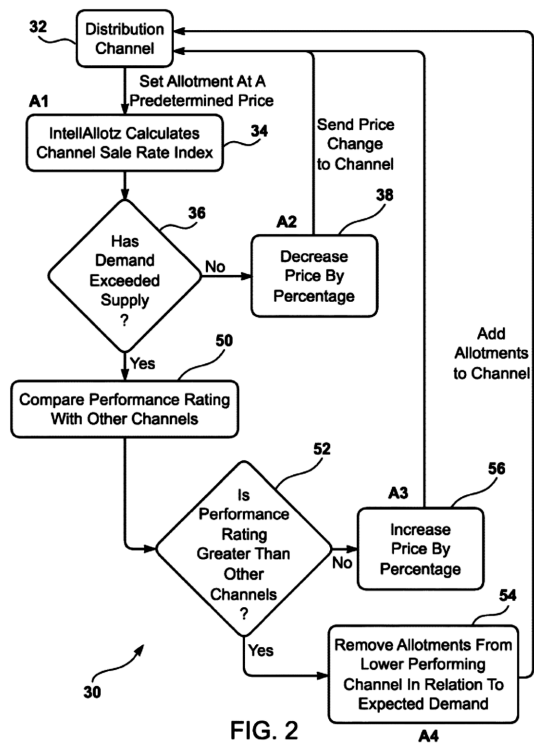


FIG. 2

Figure 1 is a schematic view of system 10 relating to inventory, e.g., hotel rooms, and having computers 12 on a network, such as Internet 14 or private network 16; computer 12 receives data from re-seller servers 18 (also called channels 18), and member/subscribers 20 store data representing inventory on computer 12. *Id.* at 3:1–2, 2:55–4:28. Figure 2 is a flowchart illustrating a method for managing the allocation of inventory and shows distribution channel 32 (which is any channel 18 associated with a user-selected third party re-seller), IntellAlotz Calculation of channel sale rate index is performed at 34, then a determination of whether demand exceeded supply is made at 36, if demand has not exceeded supply the price will be decreased at 38 (then price changes are sent back to channel 32), if demand exceeded supply, a comparison of performance rating of other channels is made at 50, then a determination of whether performance rating is greater than other

channels is made at 52 and, if not, price is increased by a percentage at 56, and if so, allotments are removed at 54 from lower performing channels in relation to expected demand, either way, the method returns to the first step at channel 32. *Id.* at 3:3–5, 5:22–7:56.

Other embodiments and details are further described throughout the '047 patent. *See generally id.*

The '047 patent concludes with 12 claims, of which claims 1 and 4 are the challenged independent claims. Ex. 1001, 39:65–42:59. Claim 1 is illustrative and reproduced below:

1 **[pre]**. A computer-implemented method of managing online bookings for transportation services inventory, the computer-implemented method comprising:

[a] establishing a channel interface that provides bidirectional communication between at least one server computing device and a vendor computing device;

[b] storing, via a channel data structure, a channel record for each of a plurality of distribution channels;

[c] receiving, from the vendor computing device through the channel interface, a selection, from the plurality of distribution channels, of one or more participant channels for a transportation service;

[d] establishing, via the channel data structure, one or more active channel records based upon the one or more participant channels for the transportation service;

[e] establishing, via the channel data structure, one or more inactive channel records based upon one or more non-participant channels for the transportation service;

[f] linking the one or more active channel records to the channel interface;

[g] receiving, in real time for the one or more participant channels corresponding to the one or more active channel

records linked to the channel interface, sale data corresponding to at least one or more additional vendor computing devices;

[h] determining a performance indicator in real time, for each of the one or more participant channels corresponding to the one or more active channel records linked to the channel interface, based at least on the sale data corresponding to said at least one or more additional vendor computing devices; and

[i] for each of the one or more participant channels corresponding to the one or more active channel records linked to the channel interface, adjusting, via the channel interface, a price of the transportation service by an adjustment factor if the performance indicator indicates a performance that fails to meet a performance threshold.

Ex. 1001, 39:65–40:36 (adding sub-numbers as used by Petitioner).

Independent claim 4 is similar to independent claim 1, but its final limitation 4[i] is different and recites: “for each of the one or more participant channels corresponding to the one or more active channel records linked to the channel interface, adjusting, via the channel interface, a price of the transportation service by an adjustment factor *if the performance indicator indicates a performance that meets a performance threshold.*” *Id.* at 40:45–41:15 (italics added). This limitation focuses on whether the measured performance meets, rather than fails to meet, a performance threshold. *Id.* at 41:9–15. Claims 2 and 3 depend from claim 1 and claims 5 and 6 depend from claim 4. *Id.* at 40:37–41:23.

D. ASSERTED GROUNDS FOR UNPATENTABILITY

Petitioner summarizes its asserted grounds for the unpatentability of claims 1–6 of the '047 patent as follows:

Claims 1-6 are rendered obvious by Jacob^[2] in view of Phillips^[3] (**Ground 1**), Jacob in view of Phillips and Evangelist^[4] (**Ground 2**), Jacob in view of Phillips and Franklin^[5] (**Ground 3**), Jacob in view of Phillips, Evangelist, and Franklin (**Ground 4**), Jacob in view of Phillips and Tamura^[6] (**Ground 5**), Jacob in view of Phillips, Evangelist, and Tamura (**Ground 6**), Jacob in view of Phillips, Franklin, and Tamura (**Ground 7**), Jacob in view of Phillips, Evangelist, Franklin, and Tamura (**Ground 8**), Jacob in view of Phillips, Tamura, and Kono^[7] (**Ground 9**), Jacob in view of Phillips, Evangelist, Tamura, and Kono (**Ground 10**), Jacob in view of Phillips, Franklin, Tamura, and Kono (**Ground 11**), Jacob in view of Phillips, Evangelist, Franklin, Tamura, and Kono (**Ground 12**). EX1003, ¶¶104, 577.

See Pet. 12–13. This style of summary of asserted grounds is, of course, not fatal to a petition as there is no rule requiring any specific form, but it lacks the clarity and ease of interpretation of a table that clearly sets out each ground, its basis in law, the claims challenged, and its basis in evidence. Likewise, we customarily summarize a petition’s grounds for unpatentability in such a table in our decisions, but here we choose to reproduce Petitioner’s summary as exemplary of the state of the Petition. As discussed below, the

² US 2007/0075136 A1, published Apr. 5, 2007 (Ex. 1004, “Jacob”).

³ ROBERT L. PHILLIPS, PRICING AND REVENUE OPTIMIZATION (2005) (Ex. 1029, “Phillips”).

⁴ U.S. Patent 7,996,265 B2, issued Aug. 9, 2011 (Ex. 1010, “Evangelist”).

⁵ Michael Franklin, *Dissemination-Based Information Systems*, IEEE Computer Soc., 19(3) Bulletin of the Technical Comm. Data Engineering 19–28 (1996) (Ex. 1009, “Franklin”).

⁶ JP 2005-332346 A, published Dec. 2, 2005 (Ex. 1005, “Tamura”) (English translation of Ex. 1006).

⁷ JP 2002-104622 A, published Apr. 10, 2002 (Ex. 1007, “Kono”) (English translation of Ex. 1008).

Petition does not develop more clarity on the asserted unpatentability grounds as it progresses, but becomes less clear.

As argued by Patent Owner,

the petition expressly encompasses an untold number of additional unnamed combinations. The petition includes, for practically each combination, the cryptic phrase that unspecified “+combinations” also render obvious the claims. But Petitioner fails to explain what these “+combinations” are, again leaving it to the Board and Patent Owner to construct the grounds on which the petition relies.

Prelim. Resp. 4–5. As discussed below, this and other ambiguities make the Petition insufficiently particular as to the challenges asserted.

In support of its grounds for unpatentability, Petitioner submits, *inter alia*, the Declaration of Amelia Regan, PhD (Ex. 1003), and in response Patent Owner submits the Declaration of Vijay Madiseti, PhD (Ex. 2001).

II. DISCUSSION

A. LEVEL OF ORDINARY SKILL IN THE ART

In determining the level of ordinary skill in the art, we consider the types of problems encountered in the art, the prior art solutions to those problems, the rapidity with which innovations are made, the sophistication of the technology, and the educational level of active workers in the field. *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986).

Petitioner asserts:

POSITA 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. Additional graduate education could substitute for professional experience, or significant inventory and pricing management experience could substitute for formal education. EX1003, ¶17. POSITA are presumed knowledgeable of all relevant art, and would thus have been familiar with each reference cited herein and its full teachings.

Pet. 14–15. Patent Owner applies this same definition. Prelim. Resp. 10.

For the purposes of this Decision, we accept Petitioner’s proposed definition of the person of ordinary skill in the art (or ordinarily skilled artisan), which appears to be consistent with the level of skill in the art reflected in the prior art of record and the disclosure of the ’047 patent. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“the prior art itself [may] reflect[]” evidence of the ordinary level of skill in the art) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

B. CLAIM CONSTRUCTION

The Board interprets claim terms in an *inter partes* review using the same claim construction standard that is used to construe claims in a civil action in federal district court. 37 C.F.R. § 42.100(b). In construing claims, district courts and the Board here, by default, give claim terms their ordinary and customary meaning, which is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

Should claim terms require express construction, sources for claim interpretation include “the words of the claims themselves, the remainder of the specification, the prosecution history [i.e., the intrinsic evidence], and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.” *Id.* at 1314 (quoting *Innova/Pure*

Water, Inc. v. Safari Water Filtration Sys., Inc., 381 F.3d 1111, 1116 (Fed. Cir. 2004)). “[T]he claims themselves [may] provide substantial guidance as to the meaning of particular claim terms.” *Id.* However, the claims “do not stand alone,” but are part of “‘a fully integrated written instrument’ . . . consisting principally of a specification that concludes with the claims,” and, therefore, the claims are “read in view of the specification.” *Id.* at 1315 (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 978–79 (Fed. Cir. 1995) (en banc)). Any special definition for a claim term must be set forth in the specification “with reasonable clarity, deliberateness, and precision.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). Without such a special definition, however, limitations may not be read from the specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Petitioner proposes a construction for the claim language “receiving . . . in real time.” Pet. 13–14. Patent Owner does not argue for any specific claim constructions. *See generally* Prelim. Resp.

“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). We determine that, here, no construction of any claim term is necessary for purposes of rendering this Decision. *See Nidec Motor Corp.*, 868 F.3d at 1017.

C. LEGAL STANDARDS CONCERNING INSTITUTION AND DISCRETIONARY DENIAL

“In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v.*

Avid Tech., Inc., 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden of persuasion never shifts to Patent Owner. See *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

An *inter partes* review may be instituted if the information presented by the petitioner in the petition, in view of the patent owner’s preliminary response and the preliminary record, shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition. 35 U.S.C. § 314.

By statute, petitions for *inter partes* review are required to 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) (“CTPG”).⁸

This requirement is “of the utmost importance,” as the Federal Circuit has explained, because a detailed and clear explanation of the challenge at

⁸ Available at www.uspto.gov/sites/default/files/documents/tpgnov.pdf.

the outset is necessary so that the parties and the Board can complete the trial within the statutorily prescribed time frame:

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 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).

Moreover, in *Adaptics*, the Board explained that the “all-or-nothing” nature of institution decisions following *SAS Institute Inc. v. Iancu*, 138 S.Ct. 1348 (2018),⁹ 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

⁹ See *SAS*, 138 S.Ct. at 1355 (holding that under § 314, the Board has “a binary choice—either institute review or don’t”); see also CTPG at 64 (“In instituting a trial, the Board will either (1) institute as to all claims challenged in the petition and on all grounds in the petition, or (2) institute on no claims and deny institution.”).

(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) (quoting *SAS Q&As* (June 5, 2018), at Part D, Question D2).¹⁰

The petition at issue in *Adaptics* asserted ten prior art references against nine patent claims in five grounds, two of which were for anticipation and three for obviousness. *Id.* at 2, 6, 8–9. However, the obviousness grounds relied on “up to ten references connected by the conjunction ‘and/or,’” which made the challenge unclear and resulted in “a multiplicity of grounds” that were “voluminous and excessive.” *Id.* at 18–21. The Board found that “[t]he number of asserted grounds and references is disproportionately large when compared with the number of distinct challenged claims, which indicates that the Petition imposes an undue burden on Patent Owner and the Board.” *Id.* at 21–22.

Following *Adaptics*, the Board has consistently denied petitions that asserted inordinately large numbers of ambiguous grounds. *See, e.g., 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

¹⁰ Available at www.uspto.gov/sites/default/files/documents/sas_qas_20180605.pdf.

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).

D. ANALYSIS OF THE PETITION AND PARTIES’ ARGUMENTS

Under the ostensibly twelve grounds indicated above, Petitioner presents its case for unpatentability by lumping them together, segmenting its arguments not by designated grounds or specific combinations of prior art, but into subsections applying all asserted prior art against first claims 1–3 and then claims 4–6. Pet. 27–108. In a section of the Petition labeled “**Claim Chart: Grounds 1-12,**” Petitioner initially presents a single, but not unified, claim chart as a *series* of related claim chart segments, each listing a claim limitation in a left column with a corresponding right column indicating every asserted prior art reference that allegedly discloses that element, citing to Dr. Regan’s declaration for support, and citing the references themselves, without accompanying explanation, rationale, or details about any respective reference’s disclosure, but including parentheticals with some quotes from the references. *See, e.g., id.* at 27–29 (relating to claim 1’s preamble), 32–37 (relating to claim 1’s first clause 1[a]). These charts themselves include largely conclusory statements that certain claim elements are disclosed in the prior art followed by a string of

cites to prior art references, and incorporate vast swaths of the witness's declaration testimony by mere citation. *Id.*

Following such chart segments, the Petition then includes several paragraphs of Petitioner's rationale for why the prior art references arguably teach the respective claim limitation, including reproductions of figures from the prior art references annotated with highlighting or red boxes around parts of the drawings—such annotations are not necessarily explained. *See, e.g., id.* at 37–41 (relating to claim 1's first clause 1[a]). As an example, we reproduce Petitioner's arguments concerning claim 1's limitation 1[a], below (all emphasis and annotations Petitioner's):

Jacob's system (e.g., computer/server running, e.g., the "RezTrip" application ("REZTRIP")) includes "computer software[,],... hardware[,], or a combination" used by personnel (e.g., "Property Administrators") of inventory-selling "clients" (e.g., vendors such as "Individual Properties"/"group of Properties") to "set up" and "administer[]" Properties and communicate information to REZTRIP. *E.g.*, EX1004, ¶¶[0006], [0069], [0084]-[0086], [0093]-[0097], Figs.7-8; EX1003, ¶180. Jacob further discloses its invention is, e.g., "located... on a plurality of computers connected to one another through... network," e.g., EX1004, ¶[0082], Fig.7 ("Hotel User" and "Revenue System" indicate computer/system, while "Customer," etc. indicate people):

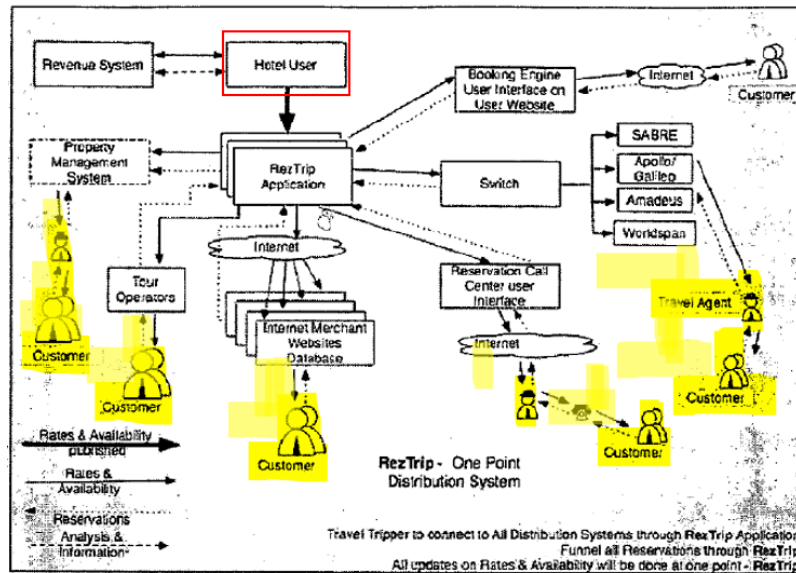


Figure 7

EX1003, ¶180. POSITA would thus have understood Jacob to disclose, expressly, a “vendor computing device.” See n.19; EX1003, ¶181.

If further disclosure of a vendor computing device is required, Jacob (in the recited combinations (“+combinations”)), or Jacob (+combinations) in view of Tamura’s or Kono’s disclosures render this obvious (see chart, *supra*). See n.15; EX1003, ¶¶186, 194. POSITA would have found it obvious, straightforward, and advantageous to implement Jacob’s system (+combinations) using Jacob’s disclosure that “[e]mbodiments... may be located... on a plurality of computers connected to one another through... network,” such that RezTrip’s multiple clients (e.g., “Properties”) use their own vendor computing device(s) that exchange information with, e.g., REZTRIP. Alternatively, POSITA would have found it obvious, straightforward, and advantageous to implement Jacob’s system (+combinations) using Tamura’s or Kono’s beneficial teachings of vendor computing devices (e.g., Tamura’s “sales management system 20”/“sales rep part 50,” Kono’s “Market inventory control computer”/“DB

server”). EX1003, ¶¶191-192, 200-201. This would have enabled a company’s personnel to connect to REZTRIP, and thus, *inter alia*, beneficially: permit multiple employees (and multiple properties) in multiple locations to use a single shared server/database without requiring replicating the RezTrip application/data and without constantly updating in separate locations; enabling the use of fewer more powerful/faster—and, thus, more costly—computer/server installations running RezTrip; and allowing more updates to RezTrip to be done centrally. EX1003, ¶¶192, 201. This would have, e.g., further increased the system’s speed/efficiency in managing property/inventory-related information, furthering Jacob’s goals (p.31), Tamura’s goal of “reducing lost sales opportunities,” and Kono’s goals of “effectively utiliz[ing] market inventory by collectively controlling the inventory control of each agency” and reducing “unnecessary inventory on the market,” see also EX1004, ¶[0005], and would have beneficially facilitated communication and data sharing between and among Jacob’s different users/administrators of properties/ groups of properties, or across properties/groups of properties. EX1003, ¶¶192, 201. For each combination in this narrative, it would have been a routine implementation choice, and clear it would work and provide the expected functionality to yield predictable results with REOS.□ EX1003, ¶¶191-192, 200-201.

If further disclosure of a “*server* computing device” is required, **POSITA would have found this obvious from Jacob (+combinations) or Jacob (+combinations) in view of Tamura’s or Kono’s disclosures** (*see* chart, *supra*). *See* n.16; EX1003, ¶¶186, 194. Jacob discloses database servers (*e.g.*, “SQL ServerTM”) “to manage hotel data” of the kinds input by hotel personnel for use by the RezTrip application, and further discloses RezTrip may have multiple “clients.” *E.g.*, EX1004, ¶¶[0001]-[0002], [0084], [0093]-[0097], [0176], [0180]; EX1003, ¶171. **POSITA would have found it obvious, straightforward, and advantageous to implement Jacob’s disclosed inventory management system (+combinations) such that in the combined system the functions of REZTRIP are performed by a server computing device (including, *e.g.*, by a database server).** Alternatively, POSITA would have

found it obvious, straightforward, and advantageous to implement Jacob’s system (+combinations) using Tamura’s or Kono’s beneficial teachings of server computing devices (e.g., Tamura’s “merchandise distribution server,” Kono’s “Agency communication control”). EX1003, ¶¶191, 200.

Implementing REZTRIP on a server computing device would, inter alia, have beneficially provided additional memory, processing capability, and accessibility by other software/processors, thus allowing the system to more quickly process and store data and make it available to the “computers connected to one another” of Jacob’s system (as well as to other systems), allowing the system to work over a larger system topology with larger data sets (e.g., sale data), to more simply analyze external data, and respond more quickly to changing market dynamics, furthering Jacob’s/Tamura’s/Kono’s goals. *See also* EX1004, ¶[0005]; EX1003, ¶¶191, 200.

Id. at 37–41. Although there are necessarily differences in Petitioner’s assertions and arguments concerning each claim limitation, the above reproduced portion of the Petition is fairly representative. *See id.* at 27–108.

As can be seen in the above-reproduced portion of the Petition, Petitioner asserts that limitation 1[a] of independent claim 1 is taught by some combination of Jacob, Tamura, Kono, and/or “Jacob (+combinations),” although just how any specific modifications to the prior art would have been made based on such potential combinations is not entirely clear (similarly, as another example, limitation 1[c] is allegedly taught by some combination of Jacob, Evangelist, and/or “Jacob’s system (+combinations)”). *Id.* at 27–41, 48–55.

Patent Owner argues that the Petition fails to assert the unpatentability grounds with particularity. Prelim. Resp. 4–6, 11–20, 24–25. Patent Owner argues that, rather than identifying the asserted grounds for unpatentability with particularity, or delineating its twelve grounds, the Petition provides “a

single claim chart for ***all twelve grounds***, putting the burden on the Board and Patent Owner to discern which disclosures correspond to which grounds,” and also fails to clearly explain how the asserted prior art references are combined (or modified). *Id.* at 11–20. Patent Owner argues “it is impossible to discern how [Petitioner] is combining [the asserted] references” and “leaves it up to the Board and Patent Owner to pick through the disparate pieces of [Petitioner]’s claim chart to puzzle together its grounds.” *Id.* at 13, 18. Moreover, Patent Owner asserts that Petitioner’s style of presenting its patentability challenges includes not twelve prior art combinations, but that, “[a]s explained by Dr. Madisetti, in total, there are ***27,648 possible reference combinations*** covered by [Petitioner]’s claim chart and [Petitioner]’s grounds of challenge. *Id.* at 13–14 (citing Ex. 2001 ¶¶ 52–53).

Patent Owner argues that the number of possible prior art combinations is expanded because Petitioner asserts “so-called ‘+combinations’ of its prior art references,” which are references to some unspecified prior art combination, made “***fifty (50) times*** in its petition without ever explaining what these ‘recited combinations’ are.” *Id.* at 24–25 (citing Pet. 38–41, 47, 53, 54, 58–60, 62, 64–67, 75–78, 80, 81, 87–89, 96, 97, 101, 102).

Also, Patent Owner argues that, rather than including within the Petition its rationale and support for its unpatentability grounds with particularly, “[Petitioner]’s omnibus claim chart is also deficient because it does not include any analysis or explanation of the relevance of the cited passages from the prior art,” and Petitioner instead asserts conclusory patentability positions and incorporates by reference a “seven-hundred

seventy-eight page expert report, which, despite its length, is equally conclusory.” *Id.* at 11, 26–30. Similar to the styling of the Petition itself, Patent Owner asserts that Petitioner’s expert declaration “includes no analysis” of the asserted prior art references, but “merely insert[s] disparate quotations from the reference[s].” *Id.* at 26–27 (using the discussion of Evangelist as an example).

Having considered the parties’ submissions and the record, we agree with Patent Owner that the Petition fails for lack of particularity.

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). Here, the precise prior art combinations asserted are ambiguous. Regardless of whether Petitioner reasonably intended to assert thousands of prior art combinations as calculated by Dr. Madisetti, we nonetheless find there to be an unreasonable and unspecific number of possible prior art combinations asserted by Petitioner.

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 seven-hundred seventy-eight page expert report, which, despite its length, is equally conclusory.” Prelim. Resp. 11–12. Moreover, 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 teachings should be combined in the grounds of a petition.” *Id.* at 18–19. 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 generally* Pet.; Ex. 1003.

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 ambiguous 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, making determining whether there is a reasonable likelihood of Petitioner prevailing on any ground or claim likewise not possible. 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. Further, we agree with Patent Owner that Petitioner does not adequately explain these multiple-reference combinations.

Under 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. App'x 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.”).

III. CONCLUSION

Petitioner fails to demonstrate a reasonable likelihood of prevailing at trial in showing that at least one of claims 1–6 of the '047 patent is unpatentable over the cited prior art because the Petition fails to meet the particularity requirement under 35 U.S.C. § 312(a)(3). Accordingly, under 35 U.S.C. § 314(a), we deny institution of this *inter partes* review. This decision does not reflect a final determination on the patentability of the claims.

ORDER

Accordingly, it is hereby:

ORDERED that the Petition is *denied* and we do not institute *inter partes* review.

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For PETITIONER:

Megan Raymond
J. Steven Baughman
Michael Milea
GROOMBRIDGE, WU, BAUGHMAN & STONE LLP
megan.raymond@groombridgewu.com
steve.baughman@groombridgewu.com
mike.milea@groombridgewu.com
uber-surgetech@groombridgewu.com

For PATENT OWNER:

James M. Glass
Quincy Lu
Eric Huang
QUINN EMANUEL URQUHART & SULLIVAN LLP
jimglass@quinnemanuel.com
quincylu@quinnemanuel.com
erichuang@quinnemanuel.com
surgetech-uberiprs@quinnemanuel.com