

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRIGHT DATA LTD.,

Petitioner

v.

METACLUSTER LT, UAB,

Patent Owner

Case IPR2023-01441
Patent No 7,010,526

PATENT OWNER PRELIMINARY RESPONSE

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Shorthand	Description
2001	Almeroth	Declaration of Kevin Almeroth, Ph.D.
2002	CV	CV of Kevin Almeroth, Ph.D.
2003	Liddy	Elizabeth Liddy, <i>How a Search Engine Works</i> , Searcher (May 2001) (available at https://web.archive.org/web/20010821020414/https://www.infotoday.com/searcher/may01/liddy.htm)
2004	Baeza-Yates	Ricardo Baeza-Yates, <i>Modern Information Retrieval</i> , Addison-Wesley (1999) (full version available at https://archive.org/details/moderninformatio0000baez)
2005	McCarty	Bill McCarty, <i>Learning Debian GNU/Linux</i> , (1 st ed. 1999) (available at https://www.oreilly.com/openbook/debian/book/ch12_02.html)
2006	Merriam-Webster	“Predefined.” Merriam-Webster.com Dictionary, Merriam-Webster, https://www.merriam-webster.com/dictionary/predefined . Accessed 2 Jan. 2024.
2007	Docket	Civil Docket for Case EDTX-2-23-cv-00171
2008	Gilstrap	List of Decisions for Motions to Stay Pending Inter Partes Review by Judge Gilstrap since Jan. 1 st 2023

I. INTRODUCTION

Institution should be denied because the Petition fails to establish a reasonable likelihood of prevailing on any challenged claim. The references cited in each of Petitioner's Grounds fail to disclose the claimed features in as complete detail as is contained in the claims; the Petition improperly attempts to rewrite claim elements in a manner contradictory to their plain meaning to fill the gaps in its anticipation theory; and Dr. Williams' analysis is conclusory and legally insufficient.

Further, to the extent the Board finds any of Petitioner's grounds as reasonable, the Board should still exercise its discretion to deny institution. Petitioner's attempt to conspicuously rewrite the claims to omit claimed features and failure to show how a POSITA would understand the features of the prior art as corresponding to the claimed feature are insufficient to establish the stringent compelling merits standard that is required to overcome discretionary denial. For at least these reasons, institution should be denied.

II. OVERVIEW OF THE '526 PATENT

The '526 Patent discloses a data mining system 10 that can be configured for responding to customer requests for data, enterprise data analysis, competitive intelligence, trending, discovery, web portal services, clustering and taxonomy creation, or the like. EX1001, Abstract, 3:7-19. An example of the overall

architecture of the system can be seen in the illustrative component diagram of FIG.

1 (below). *See Id.*

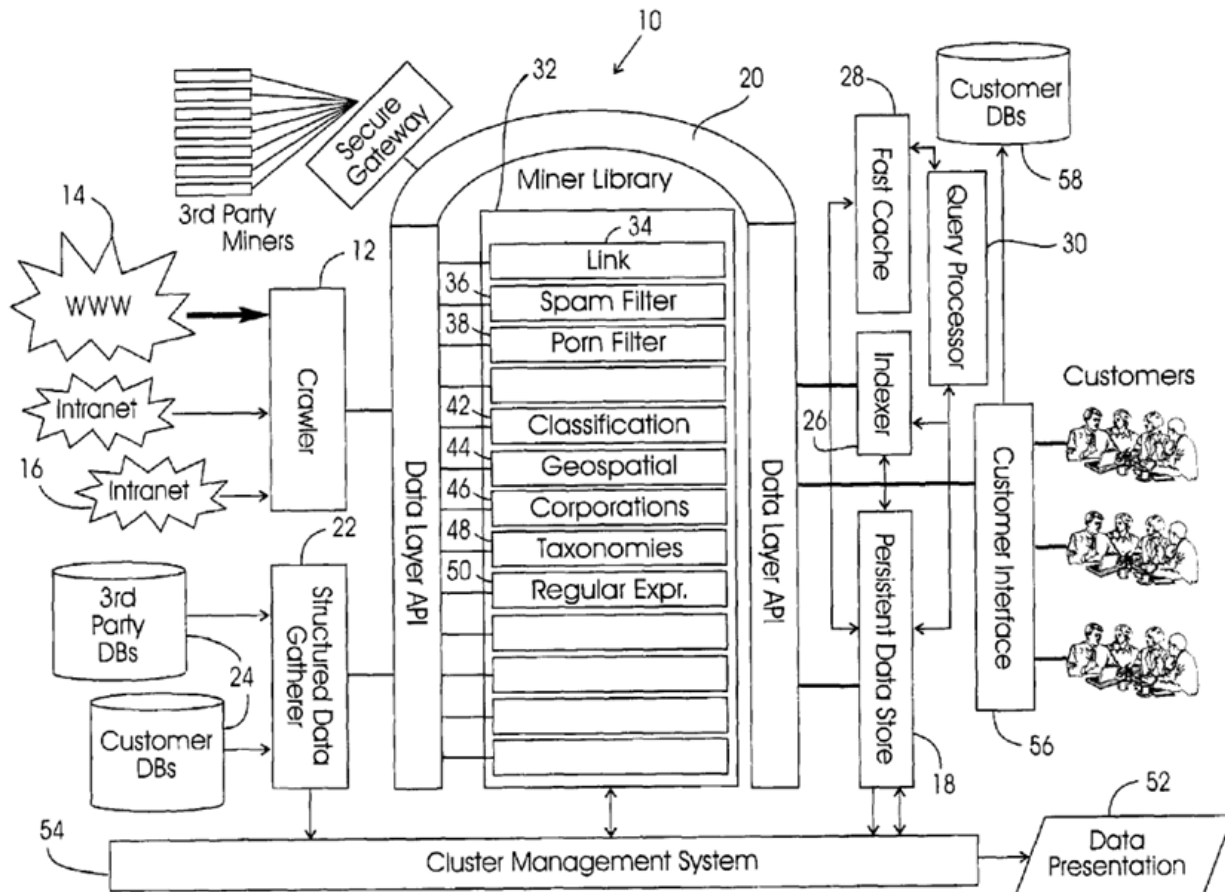


FIG 1

As depicted, the system 10 can include a web crawler 12 for accessing the internet (or an intranet) to record and store web pages in a data store 18. EX1001, 3:25-38. The webpages stored in data store 18 are parsed or “tokenized” to identify the words that occur on each web page and indexed by indexer 26. The indexer 26 may be “a conventional inverted file text indexer” that “indexes web documents and provides a keyword search application programming interface (API) to the

documents.” *Id.*, 4:49-62. Thus, the indexing and tokenization of the webpages allow a user to search the data store 18 via a conventional keyword search. *See id.*, 4:54-62.

Additionally, a data mining layer of the system includes a plurality of data miners, which may be stored in miner library 32, that can access the webpages stored in data store 18. EX1001, 5:47-50. The data miner is “an analysis engine that generates an output, and specifically an output that can include one or more keys representing characteristics of an entity, using a set of rules.” *Id.*, 5:63-66. Examples of some of these miners include:

a link miner 34 which returns links to/from a page, a spam filter 36 for identifying “spam” in the data store 18, a porn filter 38 for identifying pornographic pages in the data store 18, a classification miner 42 that classifies pages based on the occurrence of patterns of terms in the pages, a geospatial miner 44 which identifies any geographic information on a Web page, a corporations miner 46, a taxonomies miner 48 that returns pages having a predefined taxonomy category, a regular expression (regex) miner 50 that provides a stream of pages containing a defined regex, and so on.

Id., 5:52-63.

The miners can access the webpages in the datastore to extract new data, relations, or information from the webpages. *See id.*, 6:25-40; Almeroth, ¶51. Some of the miners can be classified “low level” miners that analyze the tokenized,

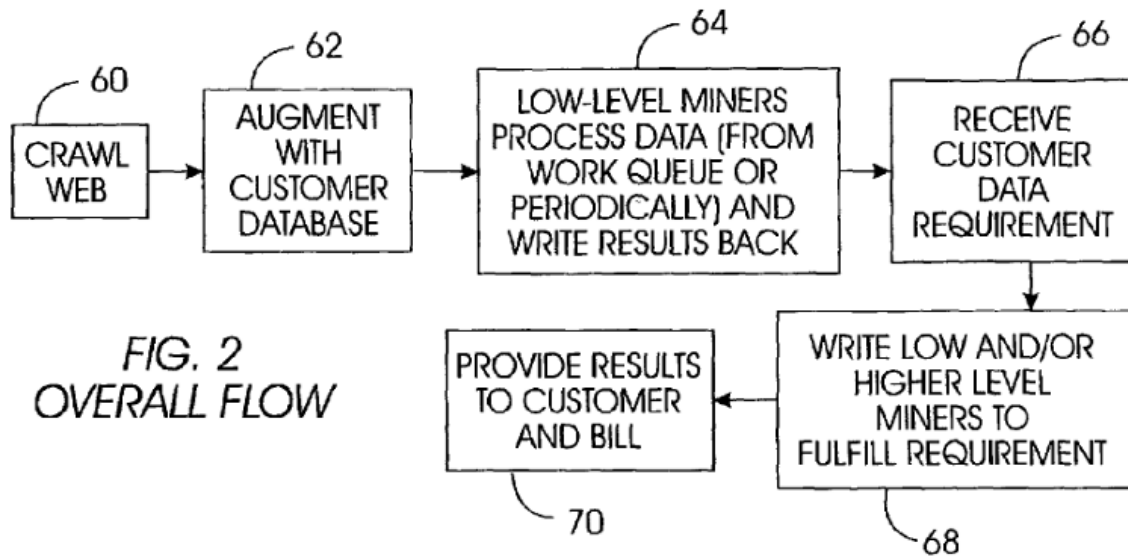
indexed webpages and write back the results of their processing to the data store 18 for other miners and end users to access. *See* EX1001, 7:28-33, 8:18-27. Some “high level” miners can process data that includes the outputs of other miners. *Id.*, 8:32-39 (high level miner may “require entities for processing that have been tagged with keys output by lower level miners”).

The described miners can be pre-existing (e.g., created during implementation of the mining system or during a previous operations) or the system can create new miners during operation, such as in response to a customer request. *Id.*; Almeroth, ¶52. As an example, a high level miner can be created in response to the query “what do our commercial customers in the Pacific Northwest think of our competitor’s health care products in terms of brand name strength and value?” EX1001, 8:40-44. This created miner “might specify that it wishes to receive only pages from the Pacific Northwest, as indicated by a geospatial key appended to entities by the geospatial miner, and only if the competitor's name is featured in the entity, as indicated by a key appended to the entity by a proper name miner.” *Id.*, 8:44-54. Results of the miner’s data processing can then be sent to a customer. *Id.*, 8:54-56.

A. Independent Claims 1 and 34

Independent claim 1 of the ’526 Patent is directed to “a method for data mining.” EX1001, 11:63. Figure 2 of the ’526 Patent, inset below, illustrates a

partial flowchart diagram of an illustrative method of data mining for some of the steps covered by independent claim 1.



See EX1001, 8:13-39.

As illustrated, and with reference to FIG. 1, a crawler 12 may crawl the web to add webpages to a data store 18. *Id.* Once within the data store, at least some data miners may process the stored webpages to include the results of the data miners. EX1001, 8:18-31; Almeroth, ¶54. A customer may submit a request for accessing the stored webpages, such as via customer interface 56. *Id.*, 7:39-42, 8:32-33. In response to the request, high level miners can be created and can process the stored webpages and results from data miners that are associated with the webpages. *Id.*, 8:33-39. The stored webpages will be modified to include the output of the created data miner and results will be provided to the customer. *Id.*, 8:33-56; Almeroth, ¶54.

Claim 1 recites **[1a]** a method for data mining, comprising:

- [1b]** crawling the Internet to return Web pages to a data store;
- [1c]** accessing the data store with at least a first data miner to process data in the store and output at least one result;
- [1d]** receiving a customer request for information;
- [1e]** creating at least a second data miner in response to the customer request for information, the second data miner accessing at least the result of the first data miner to generate an output;
- [1f]** at least partially based on the output of the second data miner, responding to the customer request for information.

EX1001, 11:63-12:7.

Claim 34 includes limitations similar to the Limitations [1a]-[1f] of claim 1, and recites **[34a]** An information service, comprising:

- [34b]** means for accessing, with at least a first data miner, a data store containing information representing at least one Web page to process data in the store and output at least one result;
- [34c]** means for receiving a customer request for information;
- [34d]** means for creating at least a second data miner in response to the customer request for information, the second data miner accessing at least the result of the first data miner to generate an output; and
- [1e]** means for responding to the customer request for information at least partially based on the output of the second data miner.

EX1001, 13:42-54.

III. CLAIM CONSTRUCTION

Claims are interpreted according to the *Phillips* standard. 83 Fed. Reg. 51340, 51340-44 (Oct. 11, 2018); *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). Under this standard, the “ordinary and customary meaning of a claim term 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, i.e., as of the effective filing date of the patent application.” *Phillips*, 415 F.3d at 1313. It has been repeatedly held that “[t]he best source for understanding a technical term is the specification from which it arose, informed, as needed, by the prosecution history.” *Id.*, 1315 (citations omitted); *see also id.*, at 1316 (“the inventor’s intention, as expressed in the specification, is regarded as dispositive.”).

A. **Creating at least a second data miner in response to the customer request for information ... (Claims 1, 34)**

Independent claims 1 and 34 both recite “...creating at least a second data miner in response to the customer request for information...”. Pet., 13. During prosecution, Applicant argued that the cited art (Chipman) did not disclose “creating” a second miner because “no new miners are created. Rather, the request [in Chipman] is passed to pre-existing search engines.” EX1002, 83. Petition contends that “based on [this argument in] the prosecution history, a POSA would understand [Limitation 1e] to require creating a **new** data miner to search the results

of a first data miner to provide customized results to the user based on the customized parameters of the user search request” Pet., 14 (emphasis in original). In support of its construction, Petitioner cites to “the Merriam-Webster dictionary definition of ‘creating,’” which is defined as “to make or bring into existence something new.” *Id.* (citing EX1007, 2).

Petitioner’s claim construction is improper and is merely an attempt to fill the gaps in Petitioner’s invalidation theories. Petitioner cites to evidence relating to the straightforward “creating” portion of the claim language, yet conspicuously changes other language without explanation. As shown in the table below, Petitioner modifies the creating aspect of the claim to recite that the second data miner is a new data miner. Patent Owner does not dispute the construction of a “new data miner” at this point, but this is not the only modification that Petitioner makes to the claim. However, as shown below, Petitioner also omits the requirement that the second data miner is created “in response to the customer request for information.” *See Almeroth*, ¶60. Petitioner offers no support for this proposed change.

Claim Language	Claim Language with Petitioner's Definition	Petitioner's Construction
creating at least a second data miner in response to the customer request for information	<i>bring into existence a new</i> second data miner in response to the customer request for information	creating a new data miner ~~in response to the customer request for information~~ to search the results of a first data miner to provide customized results to the user <u>based on the customized parameters of the user search request</u>

See EX1001, 12:1-4; Pet., 14.¹

Petitioner does not (and cannot) provide any reasoning as to why a POSITA looking at (1) the prosecution history and (2) the dictionary definition of “creating” would construe the claim as proposed by Petitioner’s expert. See Almeroth, ¶61. There is no logical connection between the proposed definition of creating and Petitioner’s rewording of the claim to replace the feature “in response to the customer request for information” with “based on the customized parameters of the user search request.” It is well understood that “[i]nventors are masters of their claims, and the words they use to describe and claim their invention are decisive and binding.” *Bio-Rad Lab'ys, Inc. v. Int'l Trade Comm'n*, 998 F.3d 1320, 1331 (Fed.

¹ All emphasis added unless otherwise indicated.

Cir. 2021). Petitioner cannot dispel this principle via an inapt citation to the prosecution history and conspicuous sleight of hand.

Petitioner's construction is inconsistent with the record, legal precedent, and Petitioner's own reasoning and, therefore, the Board should decline to adopt Petitioner's construction. *See* Almeroth, ¶¶61-62. Ultimately, construction is not needed to understand this straightforward claim phrase, much less to resolve the Petitioner's shortcomings addressed below.

B. Billing the customer for responding to the customer request for information (Claims 2, 35)

Dependent claims 2 and 35 both recite "...billing the customer for responding to the customer request for information." Petitioner asserts that a POSITA would understand the claim limitation to require "billing the customer on a per request basis." Pet., 14. The specification contemplates that "results are provided to the customer ... and the customer is billed, on a per request *or on a subscription* basis" (EX1001, 8:54-56), and nothing in the claim language limits billing to the per-request option. Nor is construction needed.

IV. OVERVIEW OF THE PRIOR ART

A. Jacobsen (EX1003)

Jacobsen discloses a subject specific search engine (SSSE) that performs filtering of websites before they are saved in a database so that only relevant documents will be stored. EX1003, Abstract, ¶[0010]. For example, the system can

be configured to collect and index only the pages deemed relevant for a specific subject, (e.g., law or medicine) similar to a law or medical library. *Id.*, ¶¶[0011]-[0020]. An example of this is shown in FIG. 3B, which depicts a filter 13 that screens information 12 such that only information 14 that passes through the filter will be indexed 15 and stored in database 9.

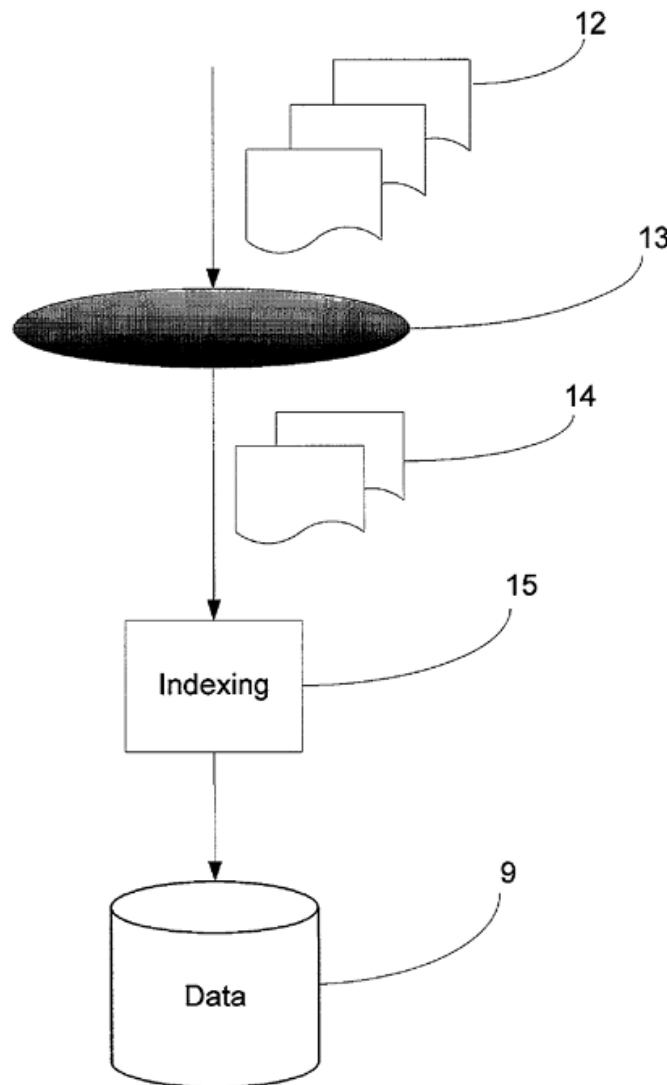


Figure 3B

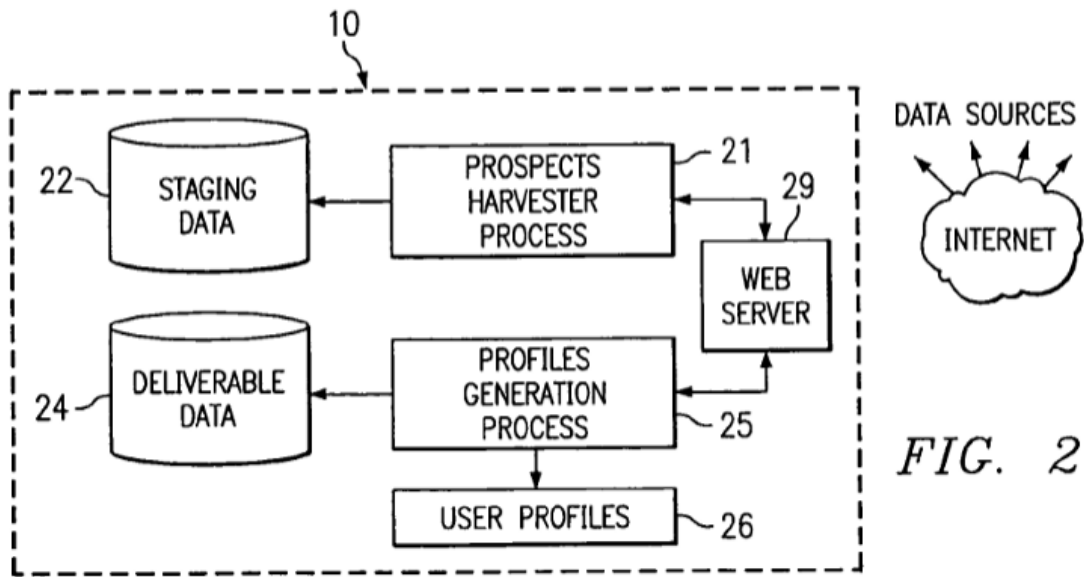
Id., ¶[0047].

Jacobsen further discloses that the system may include a site ranking feature that will rank the most relevant websites in the database according to a user query. EX1003, ¶[0067]-[0069]. This feature is accomplished by two steps: a word scoring step and a word ranking step. *Id.* For the word scoring, each webpage in the database is parsed and assigned a word score, which counts the number of times that specific words appear on the web page. *Id.* For the word ranking, a user query will be parsed to identify non-trivial words (e.g., “it”) and then word scores for the remaining non-trivial words are summed to identify the webpages in which the words occur most often. *Id.* The webpages may be sorted based on this ranking. *Id.*

B. Seibel (EX1004)

Seibel discloses “[a] text indexing system for collecting business intelligence about a client, as well as for identifying prospective customers of the client” EX1004, Abstract. “The general purpose of system 10 is to analyze a client's marketing and sales cycle in order to reveal inefficiencies and opportunities, then to relate those discoveries to net revenue estimates.” *Id.*, 2:60-64.

FIG. 2 of Seibel (reproduced below “illustrates the various functional elements of lead generator system 10,” which are “partitioned between two distinct processes.” *Id.*, 3:59-62. As shown, these two distinct processes include a prospects harvester process 21 and a profiles generation process 25. *See id.*



1. *Prospects Harvester Process*

The “prospects harvester process 21 uses a combination of external data sources, client internal data sources and user parameter extraction interfaces, in conjunction with a search, recognition and retrieval system, to harvest contact information from the web and return it to a staging database 22.” EX1004, 3:63-7:1. This process 21 collects information “from both inside the client’s organization and outside the organization.” *Id.* 4:1-3.

FIG. 3 of Seibel “illustrates ... a first embodiment of the prospects harvester” that performs the process 21 (EX1004, 2:27-28) and includes a crawler process 31 that is operable with five types of data sources: newsgroups, discussion groups, mailing lists, internal documents, and websites. *See* EX1004, 4:66-5:57. Thus, the prospects harvester process 21 may utilize a crawler process 31 (depicted in FIG. 3)

to collect information from various data sources and return it to a staging data base

22. Almeroth, ¶44; EX1004, 3:63-4:3.

2. Profiles Generation Process

Seibel's "profiles generation process 25 analyzes the user's *in-house files* and records related to the user's existing customers to identify and group those customers into profile categories based on the customer's buying patterns and purchasing volumes." EX1004, 4:23-27. Unlike prospects harvester process 21, the profiles generation process 25 only analyzes *internal* information, rather than information from the internet (e.g., websites). Compare EX1004, 3:63-64 ("prospects harvester process 21 uses a combination of external data sources [and] client internal data") with EX1004, 4:31-37 (profiles generation process 25 analyzes "a company's *internal* client records" along with "other *internal* files" to create a profile); see also Almeroth, ¶45 (citing EX1004, 3:15-17). And a POSITA would understand such internal documents to be distinct from webpages found on the internet. Almeroth, ¶46. Using the internal information, "[p]rofiles generation process 25 can be used to create a user (client) profiles database 26, which stores profiles of the client and its customers." EX1004, 4:47-52; see also *id.*, 4:31-37 (process 25 mines "a company's *internal* client records" along with "other *internal* files" to create a profile).

“FIGS. 4 and 5 illustrate a database server system [41]” (EX1004, 2:29-39) that “could be used to implement the profiles generation process 25” depicted in FIG. 2 (*id.*, 5:60-64). Almeroth, ¶47.

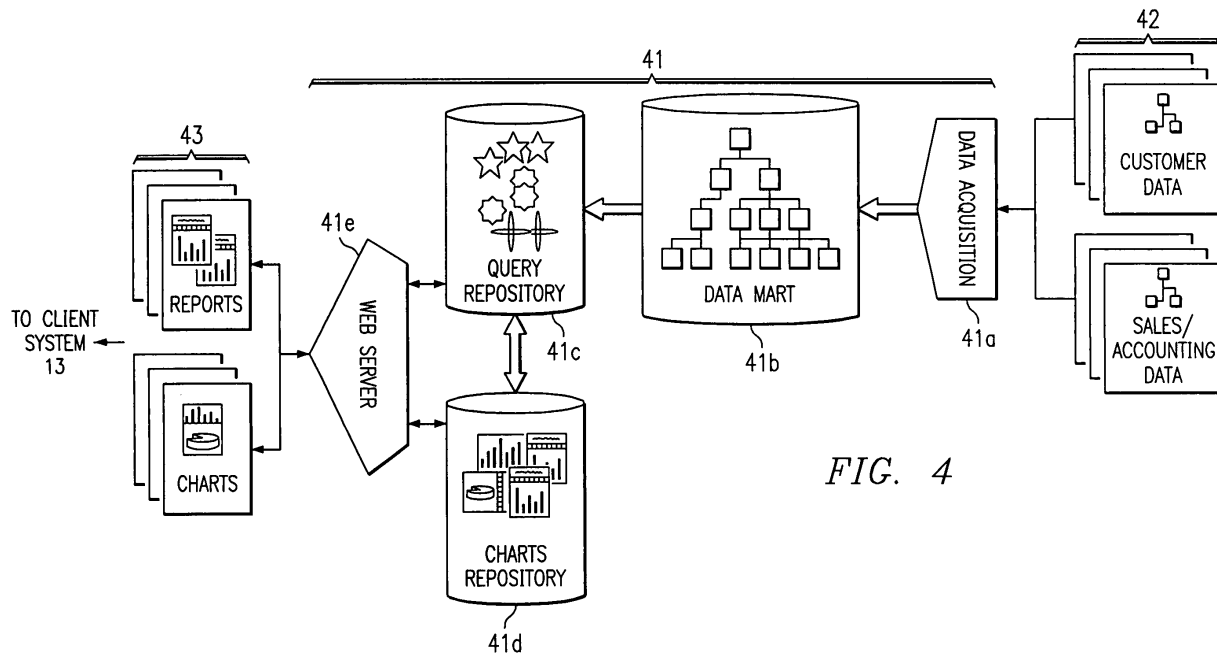


FIG. 4

EX1004, FIG. 4. As depicted, system 41 includes input data 42 that may include various client and customer data from different internal data sources that deliver sales information to data mart 41b. *See* EX1004, 5:65-6:35; *see* Almeroth, ¶47 (“the input data 42 for system 41 does not include webpages the input data 42 for system 41 does not include webpages”) (citing EX1004, 4:31-37, 5:65-66, 5:48-50). System 41 also includes a Predefined Query Repository Component 41c that “stor[es] predefined queries” (EX1004, 6:44-45) and a Business Intelligence Charts Repository Component 41d that “stores the most frequently visited charts” (EX1004,

6:58-62). Sever 41e can either pull charts directly from Business Intelligence Charts Repository Component 41d or can run a “predefined query” from the Predefined Query Repository Component 41c. EX1004, 6:62-7:1

V. RELATED LITIGATION

Patent Owner Oxylabs, UAB, filed suit against Petitioner, Bright Data Ltd., on January 07, 2022, in the referenced action (2:22-cv-00011-JRG-RSP). *see e.g.*, Pet., 70 n.19. Bright Data asserted a Counterclaim on April 14, 2023, that was severed into a new action (2:23-cv-00171-JRG-RSP) that involves United States Patent No. 7,010,526 (the “’526 patent”).

In this current action, both initial invalidity contentions and amended invalidity contentions were already served (EX2007, 2-3) and the exchange of preliminary claim constructions are scheduled to be complete before the Board is expected to issue an institution decision on April 5th, 2024. EX.1013, 4/7. Trial is also expected to occur in late 2024. Pet., 70 (“trial would statistically occur around September 2024”) (citing EX.1014 at 35); *see also* EX.1013, 1/7 (trial set for December 9, 2024). Thus, trial is expected to begin 4-7 months before the Board could issue any final determination in this matter, likely in early April 2025. *See* Pet., 70 (final written decision is expected around March 2025); Paper 3 (Notice of Filing Date Accorded, dated October 5, 2023).

VI. INSTITUTION SHOULD BE DENIED PER *FINTIV*

Discretionary denial under Section 314(a) is appropriate here because the institution would be a highly inefficient use of the Board’s resources in view of the pending Litigation, and the Petition does not present sufficient grounds—much less the required *compelling evidence*. Section 314(a) vests the Director with discretion to deny institution. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016). As explained in Section V above, the parties are already litigating infringement and validity of the ’526 Patent in district court litigation that will reach trial months before this proceeding could reach a final written decision.

The Board considers the presence and status of parallel district court litigation. *NHK Spring Co., Ltd. v. Intri-plex Techs.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential) (“NHK”) and *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2020) (precedential, designated May 5, 2020) (“*Fintiv I*”); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 7-8 (PTAB May 13, 2020) (“*Fintiv II*”).

Fintiv sets forth factors balancing system efficiency and fairness for parallel proceeding(s):

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;

3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Fintiv I, IPR2020-00019, Paper 11 at 5–6.

These factors are analyzed together to determine whether the “‘effect ... on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings,’ ... favors denying a petition even [if] some claims meet the threshold standards for institution under 35 U.S.C. §§ 314(a), and 324(a).” *See* Consolidated Trial Practice Guide (“CTPG”), 58 (quoting § 316(b)), available at <https://www.uspto.gov/TrialPracticeGuideConsolidated> (Nov. 14, 2019). Here, none of the *Fintiv* factors weigh in favor granting institution.

A. Petitioner Has Not Requested a Stay Based on Its IPR Petition

The district court has not granted a stay, and Petitioner has not requested one based on its IPR Petition. *See* Pet. 69 (“neither party has moved to stay the ... Litigation.”). “In the absence of specific evidence, [the Board] will not attempt to predict how the district court in the related district court litigation will proceed

because the court may determine whether or not to stay any individual case, ... based on a variety of circumstances and facts beyond our control and to which the Board is not privy.” *Sand Revolution v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB Jun. 16, 2020) (informative). Petitioner does not present any “specific evidence” and, thus, cannot show that this factor weighs against discretionary denial. *See* Pet., 69.

However, looking to similar cases, motions to stay when the PTAB has not yet instituted post-grant proceedings are consistently denied in the Eastern District of Texas, where Litigation is pending. *Trover Group, Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) (Bryson, J.) (“This Court’s survey of cases from the Eastern District of Texas shows that when the PTAB has not yet acted on a petition for *inter partes* review, the courts have uniformly denied motions for a stay.”). Further, Judge Gilstrap—before whom the Litigation between the parties is pending—has denied motions to stay under similar circumstances. *See Samsung Elecs. Co. Ltd. v. Clear Imaging Research, LLC*, IPR2020-01402, Paper 12 at 12-13 (PTAB Mar. 3, 2021) (denying institution because, in part, Judge Gilstrap deemed unlikely to stay a case in similar circumstances). In fact, Judge Gilstrap granted less than 14% of motions to stay pending an IPR in 2023. *See* EX2008.

Thus, specific evidence suggest that the district court would deny a motion to stay the Litigation. This first factor therefore favors denial of institution or, at best, is neutral.

B. The District Court Trial Will Occur Months Before the Board Could Reach a Final Written Decision in this Proceeding

Petitioner concedes “this factor weighs in favor of discretionary denial.” Pet., 69-70.

The Litigation is scheduled for trial in late 2024 (*see* §V)—at least three or four months before the Board would reach a final written decision in late March or early April 2025 if this IPR were instituted. *Id.* Further, the median time-to-trial—which the Board may view as a more reliable indicator of when a trial in the Texas Litigation would most likely begin—would put the start of the trial roughly *six months* before the Board would reach a final written decision. *Id.* This factor therefore strongly favors denial of institution. *Fintiv I*, at 9; *Fintiv II* at 13.

C. The District Court and Parties Have Invested and Will Invest Significantly in the Litigation

As of the date of this POPR, the parties have already invested resources and will invest significantly more resources by the time an institution decision is reached. *See generally* EX2005.

Here, the parties have already exchanged both preliminary and amended infringement and invalidity contentions. EX2007, 2-3. Petitioner concedes that they

have also conducted a diligent prior art search prior to serving their invalidity contentions. Pet., 71. Numerous other document requests, interrogatories, and discovery has already taken place including: 128 pages of infringement contentions and supporting exhibits served by patent owner and an additional 48 pages of detailed source code allegations; Petitioner served 235 pages of infringement contentions; Patent owner served 21 Interrogatories and 107 document requests, to which Petitioner responded; Petitioner served 47 interrogatories; and Petitioner served 531 pages of invalidity and eligibility contentions as well as amended invalidity contentions. *See* EX2007, 2-3.

In addition to thousands of pages of contentions, interrogatories, and document requests, the parties will have exchanged terms for claim construction, exchanged preliminary claim constructions and extrinsic evidence, and completed the joint claim construction statement before the Board decides on institution. EX1013, 4. This will require completing and serving expert declarations as required by P.R. 4-3(b). Further, claim construction discovery will be underway before the institution decision is made and will be completed shortly after the decision. EX1013, 4. While no substantive orders have issued, the parties have still invested—and will continue to invest—significant resources into the litigation proceeding. Accordingly, this factor is neutral.

Further, as explained above in Section VI.B, all aspect of the trial (e.g., fact discovery, expert discovery, dispositive motions, and the trial itself) will be completed before the Board rules on this matter. Thus, the parties will invest significant resources by the time the Board can reach a final decision.

D. The Petition and the Parallel Litigation Will Have Significant Overlap That is Not Mitigated by Petitioner’s Stipulation

1. Prior Art & Invalidity Theories

Petitioner relies on its stipulation to diminish the amount of overlap between the two parallel proceedings. Pet., 72. However, Petitioner deliberately pursues a stipulation that is significantly narrower than the *Sotera* stipulations typically given weight by the Board. *See* Interim Procedure for Discretionary Denials in AIA Post Grant Proceedings with Parallel District Court Litigation (“Guidance Memo”), 7. For example, in the precedential *Sotera Wireless* decision, the Petitioner stipulated to “not pursue in [the District Court] ... any other ground ... that was raised or could have been reasonably raised in an IPR (*i.e.*, ***any ground that could be raised under §§ 102 or 103 on the basis of prior art patent or printed publications***).” *Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020) (precedential) (emphasis in original).

Here, Petitioner’s stipulation is only for “the same grounds” and leaves open the possibility to pursue any other combination or sub-combination based on the

references cited in the Petition. Pet., 72. The stipulation also leaves open the possibility of Petitioner raising substantively identical invalidity theories based on prior art references that are substantially similar to the art in this proceeding. Particularly with the Litigation going to trial months before a decision here, such a stipulation fails to address the concerns of duplicative efforts. *See, e.g., Samsung Elecs. Co. v. Ancora Techs., Inc.*, IPR2020-01184, Pap. 11 at 18-22 (P.T.A.B. Jan. 5, 2021) (finding narrower stipulation does not mitigate the concerns of inefficiency and determining the factors weights slightly in favor of exercising discretion to deny institution).

2. Additional Claims

Petitioner asserts that 1-3, 6, 8, 9, 16, and 19 are at issue in the Litigation and that claims 1-3, 6-9, 11, 13, 16-17, 19-20, 34-36, 39-42, 44, 46, 49-50, and 52-53 are challenged in this petition. Pet., 71-72. Petitioner then concludes—without any explanation that this factor weighs strongly against denial. This is incorrect. It appears that Petitioner is attempting to argue that at least some of the challenged claims are not at issue in the Litigation. However, this does not weight against discretionary denial.

Petitioner concedes independent claim 1 and dependent claims 2-3, 6, 8, 9, 16, and 19 are at issue in both proceedings. Pet., 71. Petitioner does not argue that the non-overlapping claims (e.g., 34-36, 39-42, 44, 46, 49-50, and 52-53) differ

significantly in some way or that it would be harmed if institution of the non-overlapping claims is denied. In fact, Petitioner's challenges to independent claim 34 merely incorporate its analysis of claim 1, which confirms that Petitioner's challenges of the non-overlapping claims still overlap in subject matter. *See* Pet., 29-31, 63-64. The same is true for other non-overlapping dependent claims. *See* Pet. 31-32, 64-66.

Accordingly, this factor thus weighs in favor of a discretionary denial. *Fintiv*, Paper 11 at 13 & 13 n.25 (citing *Next Caller, Inc. v. TRUSTID, Inc.*, IPR2019-00961, Paper 10 at 14 (PTAB Oct. 16, 2019) (denying institution, even though the petitions jointly involve all 52 claims of the patent and the district court parallel proceeding involves only 7 claims, because the claims all are directed to the same subject matter and petitioner does not argue that the non-overlapping claims differ significantly in some way or argue that it would be harmed if institution of the non-overlapping claims is denied)).

Overall, because there will likely be overlap between the issues raised in the Petition and the parallel litigation and this factor weighs at least somewhat in favor of denying of institution.

E. The Parties Are the Same in the Litigation

Petitioner concedes this “weighs in favor of discretionary denial.” Pet., 72.

F. The Petition Fails to Meet the Compelling Merits Standard

None of the factors above weigh against discretionary denial. Petitioner concedes factors 2 and 5 in favor of discretionary denial and, for the reasons above, each of factors 1, 3, and 4 slightly weigh in favor of discretionary denial or are neutral. As a balancing of *Fintiv* factors 1–5 weighs in favor of denying institution, the Board should look to whether the Petition presents compelling evidence of unpatentability (i.e., compelling merits). See *Commscope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4 (PTAB Feb. 27, 2023) (precedential).

A challenge presents “compelling merits” when the evidence of record before the Board at the institution stage is ***highly likely*** to lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence. See *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102 at 49 (PTAB Oct. 4, 2022) (Director decision, precedential) (describing compelling merits as those that “plainly lead to a conclusion that one or more claims are unpatentable,” and noting that such standard can be met only “if it is highly likely that the petitioner would prevail with respect to at least one challenged claim”). “A compelling merits standard is a ***higher standard*** than the reasonable likelihood required for the institution of an IPR under 35 U.S.C. 314(a), and ... is also ***higher*** than the preponderance of the evidence standard (more likely than not) that applies to final determinations of patentability at the close of trial.” Advance Notice of Proposed

Rulemaking Published April 21, 2023 (“Proposed Rulemaking”), at 16-17; *see also CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23, 3 (Feb. 27, 2023) (precedential). “[O]nly a finding under this higher standard ... would compel the Board to review claims for the public benefit when other considerations favor discretionary denial.” *CommScope*, IPR2022-01242, Paper 23, 3-4.

The Board has denied institution under §314(a) where Patent Owner raises an “argument [that] appears credible” that the alleged prior art did not disclose a limitation of the challenged claims. *See Kranos Corp. v. Apalone, Inc.*, IPR2020-00501, Pap. 13 at 14 (P.T.A.B. July 16, 2020); *Ericsson Inc. v. Collision Comm. Inc.*, IPR2022-01233, Paper 12 at 17-18 (P.T.A.B. January 19, 2023) (No compelling merits where PO presents viable arguments the Petitioner’s position lacks evidence). As further discussed in Sections VII and IX, Petitioners’ arguments completely fail to address key limitations of the claims and Patent Owner’s arguments compel a denial of institution.

Notably, Petitioner fails to sufficiently address Limitation [1e]’s recitation of “creating at least a second data miner in response to the customer request for information ” and similar language in Limitation [34d]. Instead, as explained above in Section III.A, Petitioner attempts to rewrite the claim language to omit this feature. Consequentially, the Petition fails to show that a POSITA would have understood Jacobsen’s search engine ranking algorithm or Seibel’s use of predefined

queries as disclosing creating at least a second data miner in response to the customer request for information. *See infra*, §§VII, IX.

Further, Dr. Williams’ testimony—which repeats the Petition, *verbatim*—does not provide any additional probative evidence that a POSITA would have understood the cited portions of Jacobsen and Seibel as teaching the claimed feature when read in light of the specification and prosecution history. *Cf* EX1001, 1:19-31 (distinguishing the ranking functionality of a keyword search engine from the data miners); EX1002, 83 (distinguishing picking a pre-existing search engine from creating a data miner). Instead, Dr. Williams mirrors the overly broad, conclusory assertions made in the Petition, which improperly outsources to the Board the task of connecting the claim language with the identified features of the cited references and, if instituted, would shift the burden to Patent Owner to disprove conclusory allegations. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015) (“In an IPR, petitioner has the ultimate burden of persuasion to prove unpatentability by a preponderance of the evidence, and this ***burden never shifts to patent owner.***”). Thus, Petitioner’s analysis does not provide evidence sufficient to “plainly” result in a conclusion of unpatentability and *Fintiv* factor 6 weighs in favor of discretionary denial.

At a minimum, factors 2, 4, 5 and 6 favor discretionary denial with factors 1 and 3 being neutral or slightly weighing in favor of discretionary denial. Balancing

these factors based on the record shows a strong interest for the Board to exercise its discretion to deny institution. Accordingly, given the lack of strong countervailing considerations, the likelihood of a stay being granted, the investment of the parties, the overlap of issues, Petitioner’s decision to ***not*** include a *Sotera* stipulation, and the imminence of trial overwhelmingly favor exercising discretion to deny institution in this proceeding.

VII. GROUND 1: THE PETITION FAILS TO SHOW ANTICIPATION OF CLAIMS 1 AND 34 BY JACOBSEN

“A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). Moreover, “[b]ecause the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document but must also disclose those elements ‘arranged as in the claim.’” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (“The identical invention must be shown in as complete detail as is contained in the ... claim.”)

A. Claims 1 and 34 are Novel Over Jacobsen

Claim 1 requires “creating at least a second data miner in response to the customer request for information, the second data miner accessing at least the result of the first data miner to generate an output.” §II.A (Limitation [1e]). Claim 34 includes a similar limitation. *See id.*

For claim 34 (Limitations [34a]-[34e]), “Petitioner incorporates by reference its discussion the above discussion of claim 1 (Limitations [1a]-[1f], respectively), for each element. Pet., 29-31. The Petition and Petitioner’s expert fail to add any additional analysis for the limitations of claim 34. *Id.*; compare EX1008, ¶¶70-83 with *id.*, ¶¶90-101 (repeating analysis of claim 1 verbatim). Thus, Petitioner’s analysis of claims 1 and 34 can be treated as identical, and the Petition’s deficiencies with respect to claim 1 must also apply to claim 34. For the reasons explained below, Petitioner fails to establish Jacobsen anticipates claims 1 and 34.

1. [1e], [34d]: Creating ... in response to the customer request for information

The claims require creating a second data miner in response to the customer request for information. *See supra*, §II.A. Petitioner identifies Jacobsen’s “site ranking feature” as allegedly corresponding to the second data miner. Pet., 26.

Petitioner and its expert fail to address how Jacobsen creates this site ranking feature *in response to the customer request for information*. Pet., 26-27; Almeroth,

¶65. Instead, Petitioner attempts to rewrite the claim language to avoid addressing this limitation. *See supra*, §III.A. However, as explained in Section III.A, Limitation [1e] requires “creating at least a second data miner *in response to the customer request for information*”—not creating a data miner to provide customized results to the user based on parameters of a search request, as Petitioner alleges. Almeroth, ¶65. Thus, Petitioner’s theory must fail for the same reason as its proposed construction. *Microsoft*, 878 F.3d at 1068 (“prior art reference must disclose all elements of the claim ... *arranged as in the claim.*”) (quotations omitted).

Petitioner and Dr. Williams’ only discussion of “creating” a data miner is found in a single conclusory sentence: “Jacobsen discloses creating a second data miner, e.g., site ranking feature, in response to the customer request for information.” Pet., 26; *see also id.*, 22-27. Petitioner fails to cite to any portion of Jacobsen that purportedly discloses creating the site ranking feature *in response to the customer request*. *Id.* Accordingly, the Petition cannot show Jacobsen discloses the claimed “creating” feature. Dr. Williams’ Declaration adds nothing to Petitioner’s analysis merely parroting the Petition and providing no further explanation or support for the conclusions. See 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”); *see also Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15–

17 (PTAB Aug. 24, 2022) (precedential) (according “little weight” to declaration testimony that contains a verbatim restatement of a petition’s conclusory assertions without additional supporting evidence or reasoning).

On top of its evidentiary problems, Petitioner’s theory also fails from the perspective of a POSITA. *See* Almeroth, ¶65 (there is nothing in Dr. Williams’ declaration that would lead a POSITA to understand that Jacobsen discloses creating the site ranking feature in response to the customer request for information). Jacobsen’s site ranking feature (the alleged second data miner) is not created in response to a keyword search query (the alleged customer request). Almeroth, ¶66. A POSITA would have understood that Jacobsen’s site ranking feature is a part of the ranking capability of conventional search engines, which is distinguished from data miners in the specification of the ’526 Patent. *Id.*

There is no express disclosure that Jacobsen creates the site ranking feature (or any other non-identified data miner) in response to a customer request. Aside from the summing of word scores, Jacobsen fails to disclose how its ranking of the web pages, as described in paragraph [0069] of Jacobsen, would have been implemented within its subject specific search engine. Almeroth, ¶67. There are several different methods that could have been used for Jacobsen’s site ranking feature, none of which are articulated by Jacobsen. *Id.*; EX2003, 4-5. There is nothing implicit or inherent within the cited portions of Jacobsen’s disclosure that a

POSITA would identify as creating a new scoring algorithm in response to a keyword search query. Almeroth, ¶67.

To illustrate, one method of implementing Jacobsen's site ranking feature is via a scoring algorithm. Almeroth, ¶68; EX2003, 5. This scoring algorithm would not be created in response to the user query. Rather, a POSITA would have understood the scoring algorithm to be created during implementation of Jacobsen's search engine, which occurs well before any keyword search query. Almeroth, ¶68. To illustrate, if a user entered several keyword search queries at different times, all queries would be passed to the same scoring algorithm and Jacobsen would not create a new scoring algorithm for each query. Almeroth, ¶68; EX2004, 31-32/133. In other words, all queries are passed to the *existing* scoring algorithm. *Id.* Thus, a POSITA would not understand Jacobsen to disclose creating a new scoring algorithm in response to a keyword search query. Almeroth, ¶68.

2. [1e], [34d]: Second Data Miner

In addition to the “creating” limitation, the claims require a second “data miner” that accesses at least the result of the first data miner to generate an output. *See supra*, §II.A. Jacobsen does not expressly disclose the term “data miner.” Almeroth, ¶64. Instead, Petitioner identifies Jacobsen's “site ranking feature” as allegedly corresponding to the second data miner. Pet., 26. Yet, Petitioner provides no explanation of how this “site ranking feature” constitutes a “data miner” and a

POSITA would have understood this “site ranking feature” to be different from the claimed “second data miner.” Almeroth, ¶69.

As explained in the background section of the ’526 Patent, keyword searching and ranking were known functions of existing search engines. EX1001, 1:19-31. The ’526 Patent describes that existing search engines “access Web pages and ... generat[e] an inverted index of words that occur on the Web pages.” *Id.*, 1:19-23. The “[q]ueries are responded to by accessing the index using the requested key words as entering arguments, and then returning from the index the URLs that satisfy the queries. The page identifications that are returned are usually ranked by relevance using, e.g., link information or key word frequency of occurrence.” *Id.*, 1:25-31. Petitioner acknowledges this disclosure of a search engine’s conventional ranking feature. Pet., 16-17.

Against this backdrop of conventional keyword searching and ranking, the ’526 Patent describes its invention—including the claimed “data miners”. To illustrate, the ’526 Patent provides that this keyword search functionality is implemented in system 10 and is attributed to indexer 26—which is described as being distinct from data miners. Almeroth, ¶71. For example, in a preferred embodiment, the “indexer 26 is a generalization of a conventional inverted file text indexer” that “indexes web documents and provides a keyword search application programming interface (API) to the documents.” EX1001, 4:49-62. Thus, a

POSITA would understand that the miners described in the '526 Patent do more than simply provide a keyword search and ranking feature. *Compare* EX1001, 1:46-59 (describing analysis of a question using a conventional keyword search in the background of the '526 Patent) *with* 8:40-56 (describing analysis of ***the same question*** using data miners with a ***different result***); Almeroth, ¶71.

To further illustrate, the terms “miner” and “data mining element” are described as an “analysis engine that generates an output, and specifically an output that can include one or more keys representing characteristics of an entity, using a set of rules.” EX1001, 5:63-66. Petitioner fails to explain why a POSITA would understand Jacobsen’s site ranking feature to read on the claimed data miner—despite the '526 Patent distinguishing its data miners from the ranking features of conventional search engines. Almeroth, ¶72 (citing EX1001, 1:25-31). This alone renders Petitioner’s Ground 1 deficient as it fails to show each and every feature in as complete detail ***as is contained in the claim***. *Richardson*, 868 F.2d at 1236. This showing is required for institution as the burden of persuasion, whether for anticipation or for unpatentability for obviousness, never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citations omitted).

A POSITA would understand the claimed miners to be distinct from the sorting/ranking feature used in the keyword search functionality of conventional

search engines. Almeroth, ¶73. For example, the Modern Information Retrieval Textbook, published in 1999, provides a glossary definition for “data mining” as the “extraction of new data, relations, or partial information from any type of data.” EX2004, 73/133. A POSITA would not understand sorting pages based on the number of times a word occurs as extracting new data, relations, or partial information. Almeroth, ¶73; *see e.g.*, EX2004, 23/133 (describing the process of “determining which documents of a collection contain the keywords in the user query” as unrelated to data mining). As both intrinsic and extrinsic evidence distinguish data miners from the sorting/ranking feature used in the keyword search functionality, a POSITA would understand that the keyword search and ranking functionality (i.e., data retrieval and sorting) do not teach the claimed data miners. Almeroth, ¶73.

VIII. GROUNDS 2-4 DO NOT SAVE THE PETITION’S DEFICIENCIES REGARDING THE INDEPENDENT CLAIMS

Neither of Petitioner’s Grounds 2, 3, or 4 relate to independent claims 1 or 34. Pet., 32-38. Therefore, Grounds 2-4 cannot provide an independent basis for institution. As each of Grounds 1-4 fail to show a reasonable likelihood that the petitioner would prevail as to at least one of the independent claims, the Board should deny institution.

Further, as none of the *Fintiv* factors weighs against denying institution, Grounds 1-4 do not establish the more stringent compelling merits standard that is required for institution.

IX. GROUND 5: THE PETITION FAILS TO SHOW ANTICIPATION OF CLAIMS 1 AND 34 BY SEIBEL

A. Claims 1 and 34 are Novel Over Seibel

To start, Petitioner’s analysis of claim 34 is the exact same as that for claim 1. *See* Pet., 63-64 (incorporating discussion of Limitations [1a]-[1f] for Limitations [341]-[34e]). Thus, Petitioner’s analysis of claims 1 and 34 can be treated as identical, and the Petition’s deficiencies with respect to claim 1 must also apply to claim 34. For the reasons explained below, Petitioner fails to establish Seibel anticipates claims 1 and 34.

1. [1b]-[1c], [34b]: Petitioner’s Mapping of the Data Store is Inconsistent with Seibel’s Disclosure

Limitation [1b] recites “crawling the Internet to return Web pages to a data store” and Limitation [1c] requires accessing *the* data store with a first miner. Limitation [34b] recites a similar limitation: “accessing, with at least a first data miner, a data store containing information representing at least one Web page.” Petitioner contends that Seibel teaches this limitation because “Seibel discloses crawling the Internet using processes 21, 31 to return Web pages to a data store, e.g.,

database server system 41.” Pet., 55, 63 (incorporating the same for claim 34); *see also* EX1008, ¶¶175, 210. This is incorrect. Almeroth, ¶75.

There is no disclosure in Seibel—or explanation in the Petition—that prospects harvester process 21 returns Web pages to database server system 41. As acknowledged by Petitioner, the prospects harvester process 21 “harvest[s] contact information from the web and *return[s] it to a staging data base 22.*” Pet., 53 (quoting EX1004, 3:63-4:1). Seibel never discusses this staging data base 22 outside of this quote. *See generally* EX1004; Almeroth, ¶76. Because there is no disclosure in Seibel that equates staging data base 22 and system 41, a POSITA would not understand prospects harvester process 21 to return anything to database server system 41, let alone webpages. Almeroth, ¶76. That absence is fatal to Petitioner’s grounds because Petitioner asserts that Seibel’s alleged first data miner (profiles generation process 25) accesses database server system 41 (*not* staging data base 22). Stated another way, Petitioner does not show that Siebel’s profiles generation process 25 accesses staging data base 22 to meet the requirement in the claims that the alleged first data miner accesses the alleged data store to which the Web pages are returned. The Petition and Dr. Williams merely parrot a line from Seibel to assert that:

Seibel further discloses that the ‘resulting profiles are then overlaid on the data obtained by [prospects harvester] process 21 to facilitate more

accurate revenue projections and to enhance the sales and marketing process. The client may add certain value judgments (rankings) in a table that is linked to a unique lead id that can subsequently be analyzed by data mining or OLAP analytical tools.’

Pet. 56 (quoting EX1004, 4:39-45); EX1008, ¶178. But this does not say that *process 25* performs this overlay, much less that *process 25* accesses staging data base 22. *See, e.g.*, EX1004, FIG. 2 (no direct link between process 25 and staging data base 22), 3:59-62 (“In the embodiment of FIG. 2, the above described functions of system 10 are partitioned between two distinct processes.”). Thus, Petitioner’s mapping lacks evidentiary support and cannot support a finding of anticipation.

In an attempt to remedy this deficiency, Petitioner attempts to conflate the two separate processes illustrated in FIG. 2: the prospects harvester process 21 and the profiles generation process 25. *See* Pet. 54-55. But this theory is explicitly rebutted by Seibel, which “partition[*s*]” these “two distinct processes.” EX1004, 3:59-62 (stating the “functions of system 10 are partitioned between two distinct processes” and immediately describing the prospects harvester process 21 and the profiles generation process 25). Almeroth, ¶77. Not only is Petitioner’s combination of Seibel’s “distinct processes” absent from Seibel, but Petitioner’s analysis of Limitation [1b] completely fails to connect these different processes. This is fatal to Petitioner’s anticipation theory. *Net MoneyIN*, 545 F.3d 1359, 1369 (“it is not enough [in an anticipation rejection] that the prior art reference discloses part of the

claimed invention, which an ordinary artisan might supplement to make the whole, or that it includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention.”); *see Microsoft Corp. v. Biscotti, Inc.*, 878 F.3d 1052, 1068-70 (Fed. Cir. 2017).

For example, after discussing the prospects harvester process 21 (FIG. 2) and data sources for the prospects harvester process 21, 23 (FIG. 3), Petitioner abruptly turns to database server system 41 (FIG. 4). Pet., 53-54. Petitioner fails to make any connection between the prospects harvester process 21 and database server system 41 which is “used to implement the profiles generation process 25 ...” Almeroth, ¶78 (quoting EX1004, 5:60-64). To the extent Petitioner is intending to rely on the commonality that both prospects harvester process 21 and profiles generation process 25 may be implemented by lead generation 10, this is insufficient to establish anticipation as Seibel makes clear that the “functions of system 10 are ***partitioned*** between two ***distinct*** processes:” the prospects harvester process 21 and the profiles generation process 25. *See* EX1004, 3:60-62. *Net MoneyIN*, 545 F.3d at 1371 (“[D]ifferences between the prior art reference and a claimed invention, however slight, invoke the question of obviousness, not anticipation.”); *see also Intel Corp v. Qualcomm Inc*, IPR2018-01154 Paper 30 at 20 (PTAB 2020) (It is Petitioner that must “persuasively establish that ‘a person of skill in the art, reading the

reference, would ‘at once envisage’ the claimed arrangement or combination of elements.”).

Petitioner’s identification of the data acquisition component 41a of database server system 41 also fails to tie the two processes together for the same reasons explained above. *See also supra*, §IV.B. To the extent Petitioner intends to assert that acquisition component 41a crawls the internet to return webpages to system 41, Seibel does not disclose this. Almeroth, ¶¶79-80. As explained in Section IV.B, profiles generation process 25 (implemented by system 41) only analyzes internal documents. EX1004, 4:31-37 (process 25 analyzes “ a company’s *internal* client records” along with “other *internal* files” to create a profile); *see also* Pet., 56 (“profiles generation process 25 ... analyzes the user’s in-house files”). A POSITA would understand such internal documents to be distinct from webpages found on the internet. Almeroth, ¶79; *See* EX1004, 5:36-57 (distinguishing internal documents from web pages from internet web sites); 9:12-17 (same).

This is confirmed by FIG. 4, which illustrates data acquisition component 41a receiving input data 42, which “can be the client's sales data, customer-contact data, customer purchase data and account data etc.” EX1004 5:65-66. This “client” and “customer” data is described as internal data. Almeroth, ¶80; EX1004, 4:31-37, 5:48-50; *see also* §IV.B. To further illustrate, none of the “[v]arious data sources” described with respect to input data 42 are webpages from the internet. Almeroth,

¶80 (citing EX1004, 5:67-6:10). The fact that data acquisition component 41a may “extract[] data from different data sources” does not mean that one of these data sources would be webpages from Internet web sites. Almeroth, ¶80. In fact, a POSITA would understand that Seibel expressly describes the data sources 42 as being distinct from webpages. Almeroth, ¶80. Thus, Petitioner’s assertion that “Seibel discloses crawling the Internet using processes 21, 31 to return Web pages ... database server system 41” is contrary to the teachings of Seibel and the understanding of a POSITA. *Id.*

2. [1e], [34b]: Creating ... in response to the customer request for information

The claims require creating a second data miner in response to the customer request for information. *See supra*, §II.A. Petitioner identifies Seibel’s “server 41e” as allegedly corresponding to the second data miner. Pet., 57-58.

Petitioner and its expert fail to address how Seibel creates this server *in response to the customer request for information*. *See* Pet., 57-59; Almeroth, ¶83. Instead, Petitioner attempts to rewrite the claim language to avoid addressing this limitation. *See supra*, §III.A. However, as explained in Section III.A, Limitation [1e] requires “creating at least a second data miner *in response to the customer request for information*”—not creating a data miner to provide customized results to the user based on parameters of a search request, as Petitioner alleges. Almeroth,

¶83. Petitioner’s theory must fail for the same reason as its proposed construction. *Microsoft*, 878 F.3d at 1068 (“prior art reference must disclose all elements of the claim ... ***arranged as in the claim.***”) (quotations omitted).

Petitioner and Dr. Williams’ only discussion of “creating” a data miner is found in a single conclusory sentence: “Seibel discloses creating at least a second data miner in response to the customer request for information.” Pet., 57. This conclusory assertion is deficient for the same reasons as discussed above in Section VII.A.1. Petitioner also adds that “Seibel discloses a second data miner, e.g., server 41e runs a query using different parameters (e.g., a quarterly revenue query where the parameters passed are the specific region, the specific year, and the specific quarter) to extract data from data mart 41b to feed the data to the requested chart.” *Id.*, (citing EX1004 at 6:44-7:2). However, Petitioner and its expert fail to explain how or why a POSITA would have understood this cited portion of Seibel as disclosing creating a data miner. Almeroth, ¶83.

Seibel discloses server 41e is a web server “such as Microsoft IIS or Apache server or any other commercially available web server.” Of course, this “web server” is not created in response to a customer request. Almeroth, ¶84 (web server 41e is created when it is installed or implemented, not in response to the customer request for information). Yet, to the extent Petitioner intends to assert that server 41e is somehow creating a data miner in response to the customer request for

information, the Petition does not provide the required particularity. *See e.g.*, Pet. 57 (describing Server 41e as what “extracts (e.g., mines) data”), 58 (Alleging Seibel discloses multiple “data miners” and identifying one of these data miners as “server 41e”); *see also* 35 U.S.C. § 322(a); *Harmonic v. Avid Tech*, 815 F.3d at 1363 (“[T]he petitioner has the burden from the onset to show with particularity why the patent ... is unpatentable.”).

The only other aspect of Seibel cited in Petitioner’s analysis is that server 41e runs a predefined query from the query repository 41c. *See* Pet., 57 (citing EX1004, 6:44-7:2). But a POSITA would not understand running a ***predefined*** query to disclose creating a data miner. Almeroth, ¶85. As depicted in FIGs. 4 and 5, system 41 may include a “***Predefined*** Query Repository Component 41c [that] is the central storage for ***predefined*** queries.” EX1004, 6:44-45. These predefined queries can be used by server 41e to obtain charts in the event the desired chart is not stored in the chart repository 41d. Almeroth, ¶86. To illustrate:

When an end user requests a chart, system 41 first queries the chart repository 41d to see if there is an existing chart. If there is a preexisting chart, server 41e pulls that chart directly from the repository. If there is no preexisting chart, server 41e runs the corresponding predefined query from the query repository 41c in order to extract data from data mart 41b and Subsequently feed the data to the requested chart.

EX1004, 6:62-7:2. Thus, when server 41e runs a query—as alleged by Petitioner—

the “server 41e *runs the corresponding predefined query* from the query repository 41c ...” *See* EX1004, 6:62-7:2.

A POSITA would not understand running this predefined query as creating a second data miner. Almeroth, ¶87. As explained in Sections III.C and III.E of the Petition, Applicant distinguished the claimed “creating” limitation to overcome a rejection based on the Chipman reference during prosecution. *See also* EX1002, 83; Almeroth, ¶87. Specifically, Applicant argued that “picking a pre-existing search engine” or passing a request to “pre-existing search engines” failed to disclose the “creating” limitation. EX1002, 83. Here, Seibel similarly discloses storing predefined queries and then running (i.e., picking) the “corresponding predefined query from the query repository 41c.” Almeroth, ¶87 (quoting EX1004, 6:62-7:2). This “predefined” query would have been created in advance of (i.e., before) server 41e runs the query. Almeroth, ¶87; EX2006, 1 (“predefined” means being “defined *in advance*”). Thus, similar to the arguments made during prosecution, a POSITA would not have understood picking a predefined query to disclose “creating a second data miner in response to the customer request for information,” as claimed. Almeroth, ¶87.

Instead of analyzing this process, Petitioner and its expert simply ignores that the queries are predefined and, instead, attempts to avoid this limitation via its improper claim interpretation, as explained above. This is insufficient to establish a

reasonable likelihood of anticipation, let alone the higher “compelling merits” standard that is required here. *See OpenSky*, IPR2021-01064, Paper 102 at 49 (compelling merits can be met only “if it is highly likely that the petitioner would prevail with respect to at least one challenged claim”).

X. GROUND 6 DOES NOT SAVE THE PETITION’S DEFICIENCIES REGARDING THE INDEPENDENT CLAIMS

Petitioner’s Ground 6 does not relate to independent claims 1 and 34. Pet., 66-68. Therefore, Ground 6 cannot provide an independent basis for institution. As each of Grounds 5 and 6 fail to show a reasonable likelihood that the petitioner would prevail as to at least one of the independent claims, the Board should deny institution.

Further, as none of the *Fintiv* factors weighs against denying institution, Grounds 5 and 6 do not establish the more stringent compelling merits standard that is required for institution.

XI. CONCLUSION

For the reasons explained above, the Board should deny institution because Petitioner has not established any reasonable likelihood of success on any of its proposed grounds.

Dated: January 5, 2024

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(a)(i), the undersigned certifies that this Paper—exclusive of the table of contents, table of authorities, certificate of service, and this certificate of word count—includes 9,639 words. The undersigned relies upon the word count generated by Microsoft Word.

/Eagle H. Robinson/
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on January 5, 2024, complete copies of Patent Owner Preliminary Response and EX2001-EX2008 were served on Petitioner via email (by consent), at the following email address(s):

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