

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORACLE CORPORATION,
Petitioner

v.

JOSEPH L. DEBELLIS,
Patent Owner

Case No. IPR2024-00221
U.S. Patent No. 6,760,720 B1

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

Petitioner Oracle Corporation (“Oracle”) submits this authorized response to Patent Owner’s Request for Director Review (Paper 33, “Request”).

This proceeding involves Patent Owner’s ’720 patent. The ’720 patent relates to a method for searching a database using a graphical user interface. *See* Ex. 1001, 1:7-9. The Petition included a series of grounds, all of which relied on a July 1999 reference to Zellweger. *See* Paper 1 (Petition), 14. Patent Owner responded by, among other things, alleging that the ’720 patent was entitled to an earlier January 1999 date of conception. *See, e.g.*, Paper 13 (Response), 18. In its Final Written Decision, the Board walked through and assessed Patent Owner’s evidence of prior conception. *See* Paper 32 (FWD), 16-21. The Board then concluded that Patent Owner had failed satisfy his burden of production to demonstrate conception of either independent claims 1 or 3. *See id.*, 20-21.

Patent Owner now attempts to challenge this finding. But in so doing he points to nothing in the existing record that mandates a finding any different from that already made by the Board. Instead, Patent Owner makes a series of *new* assertions and arguments. Director Review is not a vehicle to supplement the record or make up for prior evidentiary deficiencies. In any event, virtually everything Patent Owner says is wrong. There is no reason for the Director to further review the Board’s decision.

I. Patent Owner's Request Improperly Raises New Arguments

“The Director will not consider new evidence or new arguments not part of the official record.” Director Review Process, § 3.E. Despite this clear prohibition, Patent Owner's Request is replete with new factual assertions and arguments. Most egregiously, Patent Owner spends the bulk of the Request attempting to correlate his purported activities in 1999 with the limitations of claims 1 and 3 of the '720 patent. See Request, 2-3, 5-12. He did no such thing in his earlier briefing. There, he only generically alleged entitlement to an earlier date of conception. See, e.g., Paper 13 (Response), 18. This deficiency was a principal reason why the Board ruled against Patent Owner. See FWD, 20 (“We agree ... that Patent Owner has not shown conception of the noted claim language....”).

The new factual assertions and arguments do not stop there. For the first time, Patent Owner alleges that a claim limitation requiring “determining a database schema” is a “prior art method[.]” Request, 9. Patent Owner seems to imply that this should have somehow reduced the required conception showing for this limitation. See *id.* Patent Owner made no such assertion in his prior briefing. See generally Paper 13 (Response), 18; Paper 27 (Sur-Reply). Patent Owner also attempts to supplement the record with respect to reduction to practice, interjecting new allegations and arguments regarding how a figure he included in one of his declarations purportedly correlates to the claims. See Request, 10-12. Once again,

none of this appeared in any of Patent Owner's earlier briefing. *See generally* Paper 13 (Response), 20; Paper 27 (Sur-Reply), 4.

A Director Review Request is not a vehicle to interject new factual assertions into the record. Nor is it intended to allow a party to make additional, new arguments that should have been made earlier. That is all Patent Owner does. Patent Owner was required to come forward with evidence showing that he conceived of the claimed invention prior to Zellweger's filing in July 1999 and then diligently reduced that invention to practice. He failed to do so in his response, in his sur-reply, and at oral argument. It is too late for him to do so now.

II. Patent Owner Failed to Identify Any Issues Requiring Director Review

Patent Owner posits that Director review is “warranted to correct a substantial error of procedure and to promote consistent application of law and policy.” Request, 15. No “error of procedure” occurred in this case. Patent Owner failed to satisfy his burden of production to show prior conception. This led the Board to rule against him. This was not an “error”: it was the necessary result given the dearth of evidence. Nor is director review required to “promote consistent application of law and policy.” The law is clear that prior conception of the **claimed** subject matter must be shown. *See, e.g., REG Synthetic Fuels, LLC v. Nestle Oil Oyj*, 841 F.3d 954, 962 (Fed. Cir. 2016). Patent Owner did not present this type of evidence.

Director Review is intended to address abuses of discretion by the Board, important issues of law or policy, erroneous findings of material fact, or erroneous conclusions of law. *See* Director Review Process, § 1.B. Patent Owner identifies no such issues. The Board did not abuse its discretion or make any legal errors. It properly followed the law regarding prior conception. Moreover, Patent Owner points to no factual errors. Indeed, the lack of any such errors appears to be why Patent Owner peppers his request with new factual assertions.

III. Patent Owner Repeatedly Mischaracterizes the Record and the Board's Decision

Finally, Patent Owner's Request is replete with mischaracterizations. Patent Owner begins by arguing that "the Board ... read an unrelated feature from the specification into the claims" by construing claim 1 to require "determining 'the number of entries in the database field for display.'" Request, 1-2. The Board did not construe the claims this way. In fact, the Board found the opposite: it rejected Patent Owner's erroneous contention that the number of database entries must be determined at the time of searching. *See* FWD, 12.

Patent Owner also argues that the "Board improperly disregarded substantial and corroborated evidence of conception and actual reduction to practice." Request, 2. It did not. It walked through all of Patent Owner's evidence. *See* FWD, 16-21. The problem with that evidence was that it was insufficient: Patent Owner made no effort whatsoever to correlate any of his activities to the claims. Relatedly, Patent

Owner argues that “paragraphs 45-47” of one of his declarations (Ex. 2001) “perfectly and completely encapsulated [his] concept of generating a list of data fields.” Request, 6. These paragraphs do not use the word “data fields.” Instead, they use language not found in the claims. Patent Owner now tries to revise declarations filed more than a year ago to give them new, different significance. There is no reason to countenance this type of change now.

Next, Patent Owner alleges that “Petitioner ... admits that my January 1999 disclosure of my invention addresses limitation 3A.” Request, 7. According to Patent Owner, the Board failed to take this purported “admission” into account. *Id.* But Petitioner indisputably made no admission. Rather, Petitioner merely read from Patent Owner’s insufficient declaration evidence. *Compare* Paper 31 (Hearing Tr.), 15:21-24 *with* Ex. 2002, ¶ 5. Quoting the record is not an “admission.”

Patent Owner goes on to argue that by purportedly conceiving truncation methods, he also necessarily conceived of “determining a ... quantity” of search results. Request, 8. As the Board correctly noted, however, the ’720 patent itself includes examples of truncation (*i.e.*, organizing into alphabetized lists) that do not require first knowing the quantity of results. *See* FWD, 20; Ex. 1001, 7:65-8:7.

Finally, Patent Owner spends pages discussing reduction to practice and diligence. *See* Request, 10-15. But the Board did not reach those issues, instead finding that Patent Owner had simply failed to show prior conception.

Respectfully submitted,

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: July 14, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing paper was caused to be served on July 14, 2025 via email upon Patent Owner at the address indicated:

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