

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UIPATH, INC.,
Petitioner,

v.

RULE 14 LLC,
Patent Owner.

IPR2024-01304
Patent 9,229,977 B2

Before JO-ANNE M. KOKOSKI, NABEEL U. KHAN, and
ANDREAS BALTATZIS, *Administrative Patent Judges*.

BALTATZIS, *Administrative Patent Judge*.

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

I. INTRODUCTION

UiPath, Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–21 (the “challenged claims”) of U.S. Patent No. 9,229,977 B2 (Ex. 1001, “the ’977 patent”). Paper 1 (“Pet.”). Rule 14 LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

Under 35 U.S.C. § 314(a), the Board “may not authorize an *inter partes* review to be instituted unless . . . the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” After considering the Petition, the Preliminary Response, and the evidence of record, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing with respect to at least one claim challenged in the Petition. Accordingly, we deny institution of an *inter partes* review.

II. BACKGROUND

A. *Real Parties in Interest*

Petitioner identifies itself as the real party in interest. *See* Pet. 7. Patent Owner identifies itself as the real party in interest. Paper 4 (Patent Owner’s Mandatory Notices).

B. *Related Matters*

The parties list the following co-pending litigation as a related matter: *Rule 14, LLC v. UiPath, Inc.*, Case No. 2:23-cv-627 (E.D. Tex.) (“co-pending litigation”).

Petitioner concurrently filed a petition for *inter partes* review challenging claims 1–20 of related U.S. Patent No. 11,048,712 B2 (IPR2024-01306).

C. The '977 Patent (Ex. 1001)

The '977 patent relates to a method for analyzing data by generating a query based on a topic of interest. Ex. 1001, 2:6–8. For example, a user may generate a query using natural language. *Id.* at 4:9–12. The query search terms are then “expanded based on search lexicons.” *Id.* at 4:16–19. “The lexicon may be generated based on user input and/or may be generated based on automatic word association, such as synonym/antonym trees and lexicons of positive and/or negative modifiers.” *Id.* at 4:21–24; *see also* 6:32–44. After the search terms are expanded, the query is executed on a plurality of data sources. *Id.* at 4:27–34. The data sources may include open-source data and proprietary data sources. *See id.*

Once the search is completed, the query results are reviewed. *Id.* at 4:54. “If the results are satisfactory, specific data sources may be selected to be monitored.” *Id.* at 4:54–56. “The monitoring may be performed by data extractors that monitor changes to a data source in real-time.” *Id.* at 4:60–61. For example, “[w]hen information at the data sources is updated or located to match the query terms, a data extractor extracts the data to be analyzed.” *Id.* at 4:61–64. The extracted data may then be communicated to specific individuals or other users. *Id.* at 5:1–17.

D. Illustrative Claims

Petitioner challenges claims 1–21 of the '977 patent. Pet. 8. Claims 1, 10, and 19 are the challenged independent claims of the '977 patent. Claim 1 is illustrative of the challenged subject matter, and is reproduced below.

1. A method of analyzing data, comprising:
generating, via a first user, a query based at least in part on a topic of interest;
expanding search terms of the query;

executing the query on a plurality of data sources;

selecting at least one data source from the plurality of data sources, the at least one data source being selected when results of the query are greater than or equal to an accuracy thresholds;

monitoring, based on a set schedule, the at least one data source to extract data from the at least one data source when at least an update to stored data that matches the query, newly added data that matches the query, or a combination thereof; and

establishing a communication channel with a second user based at least in part on the data extracted from the at least one monitored data source.

Ex. 1001, 20:12–28.

E. Asserted References

Petitioner relies on the following references in its asserted grounds of unpatentability:

Name	Reference	Ex. No.
Schultz	US 5,721,902	1017
Kirsch	US 6,018,733	1009
Vinsonneau	US 7,043,482 B1	1020
Eichstaedt	US 7,765,228 B2	1014
Lucovsky	US 7,844,603 B2	1015
Moulinier	US 9,418,139 B2	1021
Liang	US 2006/0106793 A1	1010
Mellin	WO 01/65336 A2	1016
Learning Lexis	LEXIS-NEXIS Group, <i>Learning lexis.com</i> (2000)	1011

F. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1–21 of the '977 patent are unpatentable in view of the following grounds. Pet. 25.

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)/Basis
1, 2, 4–6, 8, 10, 11, 13–15, 17, 19, 20	103(a)	Kirsch, Eichstaedt, Lucovsky
1, 4, 6, 8, 10, 13, 15, 17, 19	103(a)	Kirsch, Eichstaedt, Mellin
4, 5, 13, 14, 21	103(a)	Kirsch, Eichstaedt, Lucovsky, Schultz
2, 11, 20	103(a)	Kirsch, Eichstaedt, Mellin, Schultz
3, 12	103(a)	Kirsch, Eichstaedt, Lucovsky, Liang
7, 16	103(a)	Kirsch, Eichstaedt, Lucovsky, Schultz, Moulinier
9, 18	103(a)	Kirsch, Eichstaedt, Lucovsky, Vinsonneau
9, 18	103(a)	Kirsch, Eichstaedt, Mellin, Vinsonneau
1, 2, 5, 6, 8, 10, 11, 14, 15, 17, 19–21	103(a)	Learning Lexis, Kirsch, Lucovsky
4, 13	103(a)	Learning Lexis, Kirsch, Lucovsky, Schultz
3, 12	103(a)	Learning Lexis, Kirsch, Lucovsky, Liang
7, 16	103(a)	Learning Lexis, Kirsch, Lucovsky, Moulinier
9, 18	103(a)	Learning Lexis, Kirsch, Lucovsky, Vinsonneau
1, 3, 4, 10, 12, 13, 19	103(a)	Liang, Lucovsky
1–6, 8, 10–15, 17, 19–21	103(a)	Liang, Lucovsky, Kirsch
1, 10, 19	103(a)	Liang, Kirsch, Mellin

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284 (2011), amended 35 U.S.C. §§ 102 and 103, effective on March 16, 2013. The ’977 patent claims priority to an application that has a filing date before March 16, 2013, i.e., Provisional Application No. 61/679,024, filed August 2, 2012. Therefore, we apply the pre-AIA versions of §§ 102 and 103.

Claim(s) Challenged	35 U.S.C. § ¹	Reference(s)/Basis
2, 5, 11, 14, 20, 21	103(a)	Liang, Kirsch, Mellin, Schultz
7, 16	103(a)	Liang, Lucovsky, Moulinier
7, 16	103(a)	Liang, Lucovsky, Kirsch, Moulinier
9, 18	103(a)	Liang, Lucovsky, Vinsonneau
9, 18	103(a)	Liang, Lucovsky, Kirsch, Vinsonneau

Petitioner relies on the Declaration of Jaideep Srivastava, Ph.D.
(Ex. 1003) in support of its contentions.

III. ANALYSIS

A. Legal Standards

“In an [*inter partes* review], 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 never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review). Furthermore, Petitioner must explain with particularity how the prior art would have rendered the challenged claims unpatentable. 35 U.S.C. § 312(a)(3); 37 C.F.R. § 42.104(b)(4) (“The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”).

A claim is unpatentable under 35 U.S.C. § 103 if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of nonobviousness, i.e., secondary considerations.² *See Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17–18 (1966).

B. Level of Ordinary Skill in the Art

Petitioner argues that one of ordinary skill in the art relevant to the challenged claims, as of the earliest claimed priority date, “would have had a bachelor’s degree in electrical engineering, computer science, or equivalent training, and approximately two years of work experience in software development with a basic knowledge of database searching techniques.” Pet. 15 (citing Ex. 1003 ¶ 26).

Patent Owner does not address the definition of a person of ordinary skill in the art. *See generally* Prelim. Resp.

For the purposes of this Decision, we adopt Petitioner’s formulation for a person of ordinary skill in the art, 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 ’977 patent. *See Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985) (explaining that specific findings regarding ordinary skill level are not required “where the prior art itself reflects an appropriate level and need for testimony is not shown”).

² Neither party presents arguments or evidence relating to secondary considerations.

C. Claim Construction

We construe claim terms according to the standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–17 (Fed. Cir. 2005) (en banc), i.e., as construed in a civil action under 35 U.S.C. § 282(b). *See* 37 C.F.R. § 42.100(b). Under *Phillips*, claim terms are afforded “their ordinary and customary meaning.” 415 F.3d at 1312. “[T]he 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.” *Id.* at 1313. “Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.” *Id.*

Petitioner notifies the Board of three terms being disputed in the co-pending litigation: (1) “a first user,” (2) “expanding search terms of the query,” and (3) “accuracy threshold.” Pet. 12–15. For each term, Petitioner contends the “Board need not resolve” or address the dispute. *See id.* At this stage of the proceeding, Patent Owner does not address claim construction. *See generally* Prelim. Resp.

We agree with Petitioner that we need not resolve the claim construction disputes from the co-pending litigation. Accordingly, we need not construe explicitly any claim terms because no such construction is necessary to determine whether to institute. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (stating that “we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

D. Overview of the References Cited Against the Independent Claims

1. Kirsch (Ex. 1009)

Kirsch relates to “a method of performing effective document searches over multiple, independent document collections.” Ex. 1009, 1:11–13. Kirsch explains that a “known problem in providing access to multiple databases is the relative difficulty or inefficiency in identifying an optimal database or set of databases that should be searched to obtain the best search report for a some particular unstructured, or ad hoc, database query.” *Id.* at 1:64–2:1. This is known as the “collection selection problem.” *Id.* at 2:19–20.³

Kirsch’s method addresses the collection selection problem by using a user query to select a qualified set of most likely relevant document collections. *Id.* at 6:29–30. A collection search engine applies the user query against an identified collection set. *Id.* at 6:34–37. The user query terms may be “reduced and expanded as appropriate into a list of specifically identified search terms.” *Id.* at 7:5–7. “The effective search terms of the processed query . . . are then provided to the collection meta-index search engine . . . for analysis against a collection meta-index.” *Id.* at 7:47–49. “The list of likely most relevant collections is then identified . . . from the list of likely most relevant meta-index documents that are within a predetermined or specific user defined maximum number of collections to select at one time for searching, or that meet at least a minimum relevance ranking threshold, or both.” *Id.* at 9:66–10:4.

³ The Petition explains that the “collection selection” problem was first presented in 1995. *See* Pet. 15–18; Ex. 1003 ¶¶ 35–40.

2. *Learning Lexis (Ex. 1011)*

Learning Lexis is a publication provided by LEXIS-NEXIS to teach users about the lexis.com service.⁴ Ex. 1011, 2. The publication explains that “[t]he *lexis.com* service allows you to conduct research quickly and easily in an impressive variety of sources including case law, statutes, and the world’s leading news and business sources.” *Id.*

Learning Lexis describes options for choosing a source from multiple sources or exploring sources through a source hierarchy. *Id.* at 6–7. The source hierarchy may include multiple data sources, e.g., “Combined Federal & State Case Law – U.S.: All Courts – By State: CA Federal & State Cases.” *Id.* at 7.

Once the user identifies the source, the user enters search terms as either “terms and connectors” or “natural language.” *Id.* at 10. “The *lexis.com* service automatically searches for some words and abbreviations that are equivalent to each other.” *Id.* at 13. Once the search is completed, “[y]ou can have *lexis.com* automatically save and re-run searches for updates at daily, business daily, weekly, or monthly intervals.” *Id.* at 26. Additionally, the search results can be emailed to the user (“yourself”) “or to others.” *Id.* at 34.

⁴ Petitioner presents evidence that Learning Lexis qualifies as a printed publication as of 2001. *See* Pet. 45–48 (citing Exs. 1003, 1011–1013, 1019, 1023–1025, 1029). Patent Owner does not challenge this showing in the Preliminary Response. For the purposes of institution, Petitioner sufficiently shows Learning Lexis qualifies as a printed publication under 35 U.S.C. § 102.

3. *Liang (Ex. 1010)*

Liang relates to “methods and software for the retrieval, mining, filtering and visualization of information stored on a plural of computers connected to the Internet and on a local computer.” Ex. 1010 ¶ 2. Liang describes “a user interface for an intelligent search engine that accepts a user’s natural language description of a search and search automation options.” *Id.* ¶¶ 18, 48, Fig. 1. The software will “broaden[] a search by expanding search keywords into concepts comprising of the synsets, hypernym, and/or hyponym/troponym of a keyword, and acronyms or full expressions of a concept.” *Id.* ¶ 13.

Liang’s user interface further includes options to search in multiple sources, using known source extensions. *Id.* ¶¶ 21, 178, 229, Fig. 4. Liang describes “[a] source clustering program [that] counts the number of web pages and files in the search results that are from a website or domain name, e.g., cnn.com, ieee.org, irs.gov.ucla.edu, etc.” *Id.* ¶ 229. “In one embodiment, the source clustering program selects the first S, where S is a positive integer and can be set by default or by user, websites or domain names, from which the most number of web pages and files are retrieved in the search results.” *Id.*

Liang also describes an option to keep the user’s “search active for a period of time to monitor for new sources and changes to existing sources by specifying a date range . . . , and when a change is detected, the option to alert the user.” *Id.* ¶ 52, Fig. 1. The user may “specify the time period over which he wants to monitor the web page, and the frequency a page/site monitoring program of this invention should check[] the monitored pages for changes.” *Id.* ¶ 347.

4. *Eichstaedt (Ex. 1014)*

Eichstaedt relates “to a system and method for enabling a user to register an interest and subsequently provide a notification (an alert) to the user when new information becomes available regarding the registered interest.” Ex. 1014, 2:5–9. “[Q]ueries can be applied to new content information for registered interests as the new content information becomes available.” *Id.* at 2:43–45.

Eichstaedt describes a poller server that manages polled content to produce scheduled alerts. *Id.* at 7:45–49. The poller server wakes up after a predefined period and checks for current content. *Id.* at 7:65–8:22. The poller server then compares the old query results to the current content. *Id.* at 8:36–44. “[I]f a current content item is different from an old query result, the poller server can replace the old query result with the current content item.” *Id.* Storage servers then access stored alerts to be delivered at predefined periods. *Id.* at 12:34–41.

5. *Lucovsky (Ex. 1015)*

Lucovsky describes a method for distributing user search results. Ex. 1015, 6:16–22; Fig. 4. In one example, a user may enter a search query to obtain search results, automatically copy the search results in an email (as opposed to links to the results), and send the email to a recipient. *See id.* at 7:9–59; Figs. 4–6. In another example, the user may post search results using a message board interface. *See id.* at 8:43–67, Fig. 7. Lucovsky provides additional examples of users sharing search results in an instant messaging interface (*see* Fig. 8) and a blog authoring tool (Fig. 9). *See id.* at 9:1–41.

6. *Mellin (Ex. 1016)*

Mellin relates to a method for group collaboration using email. Ex. 1016, 2:12–15. Mellin specifically addresses the “problem of Internet

document attachment version control by providing a unique way to manage email attachments as independent documents linked to messages or other documents.” *Id.* at 3:24–27.

E. Alleged Obviousness of Claims 1, 10, and 19 over Kirsch, Eichstaedt, and Other References

Petitioner argues that independent claims 1, 10, and 19 are unpatentable as obvious over Kirsch, Eichstaedt, and Lucovsky. Pet. 26–32. Alternatively, Petitioner argues that these claims are unpatentable as obvious over Kirsch, Eichstaedt, and Mellin. *Id.* at 36–37. Patent Owner disagrees, arguing that the Petition fails to establish a reasonable likelihood of prevailing in demonstrating the unpatentability of the claims. *See* Prelim. Resp. 8–17. Specifically, Patent Owner argues that Petitioner’s “obviousness grounds rely on conclusory statements instead of specific reasoning based on evidence,” as to the reasons to combine the references. *Id.* at 8.

On this record, we determine that Petitioner does not establish a reasonable likelihood that one skilled in the art would have combined the references.

1. Steps for Addressing the Collection Search Problem

Claim 1 recites a method of analyzing data, including a series of steps for addressing the collection search problem, i.e., how to narrow an Internet search from many data sources to a few useful collections.⁵ *See* Ex. 1001, 20:12–20; *see also* Pet. 15–18. The claimed steps include generating a

⁵ Claim 10 recites an apparatus comprising a memory unit and a processor configured to perform the method of claim 1. *See* Ex. 1001, 20:59–21:12. Claim 19 recites a computer program comprising a non-transitory computer-readable medium having program code that, when executed, performs the method of claim 1. *See id.* at 22:8–28. The parties treat claim 1 as representative of the independent claims. *See* Pet. 31–32; Prelim. Resp. 14.

query, expanding search terms of the query, executing the query on a plurality of data sources, and selecting at least one data source when the results of the query are greater than or equal to an accuracy threshold.⁶ *See* Ex. 1001, 20:12–20. Petitioner contends that Kirsch teaches or suggests similar steps to solve the collection search problem. *See* Pet. 26–28. For example, Petitioner contends that Kirsch teaches a method of analyzing data⁷ by generating a query, expanding the search terms, searching a plurality of data sources (document collections), and selecting a data source (qualified set of most relevant document collections based on a relevancy threshold, e.g., minimum level of relevance). *Id.* (citing Ex. 1009, 6:29–30, 6:34–37, 6:40–43, 7:47–49, 9:67–10:4, 10:19–21, 14:48–50; Ex. 1003 ¶¶ 60–67).

Patent Owner does not dispute Kirsch’s teachings. We are persuaded by Petitioner’s argument that Kirsch teaches or suggests the claimed steps for addressing the collection search problem.

⁶ Petitioner notes the discrepancy between the singular article “an” and the plural “thresholds.” *See* Pet. 10, n. 1. Petitioner argues that “[t]he specification does not refer to *multiple* accuracy thresholds being used for selection of data sources. Therefore, interpreting the claim to require multiple accuracy thresholds would exclude from the scope of the claim any disclosed embodiment(s) in the specification.” *Id.* Patent Owner does not dispute or address this issue. *See generally* Prelim. Resp. We agree with Petitioner that the natural reading of the term is the singular threshold. Accordingly, for purposes of this decision, we use the singular “threshold.”

⁷ Because Petitioner has sufficiently shown that the prior art teaches the preamble, we need not determine whether the preamble is limiting. *See Nidec*, 868 F.3d at 1017.

2. *Monitoring the Selected Data Source and Communication with a Second User*

Claim 1 recites two additional steps in the claimed method. First, claim 1 adds a step of “monitoring, based on a set schedule, the at least one data source to extract data from the at least one data source when at least an update to stored data that matches the query, newly added data that matches the query, or a combination thereof.” Ex. 1001, 20:21–25 (“monitoring step”). Second, claim 1 adds the step of “establishing a communication channel with a second user based at least in part on the data extracted from the at least one monitored data source.” *Id.* at 20:26–28 (“communication with a second user”).

Petitioner cites additional references in combination with Kirsch to teach these steps. As to the monitoring step, Petitioner relies on Eichstaedt’s teaching of notifying a user by email when new information becomes available regarding the search results. Pet. 29 (citing Ex. 1014, 2:5–15, 2:43–45). Specifically, Petitioner cites Eichstaedt’s poller server that compares an old query to current content, replaces the old query with the current content when different, and delivers an alert with the current content. *Id.* (citing Ex. 1014, 7:67, 8:14–21, 8:28–54, 12:38–41, Figs. 5–6; Ex. 1003 ¶¶ 73–74).

As to communication with a second user, Petitioner relies on Lucovsky teaching “a first user sharing search results with a second user via an email, message board, instant messaging and a blog.” *Id.* at 30 (citing Ex. 1015, Figs. 4–9). Petitioner adds that Eichstaedt further teaches sending an update with new content to both the user that generated the query and other users. *Id.* at 31 (citing Ex. 1014, 4:13–51; Ex. 1003 ¶ 76).

Alternatively, Petitioner relies on Mellin to teach communication with a second user. *Id.* at 37. Specifically, Petitioner argues that Mellin teaches using “a group email address to facilitate collaboration among members of a group.” *Id.* (citing Ex. 1016, 3:24–26).

Patent Owner does not dispute Petitioner’s arguments as to the teachings of Eichstaedt, Lucovsky, and Mellin. *See* Prelim. Resp. 8–14, 16–17. Rather, Patent Owner argues that Petitioner does not establish a reason to combine references, which we discuss in detail below. *See id.*

3. *Reason to Combine the References*

As discussed above, Petitioner combines Kirsch with Eichstaedt and Lucovsky or Mellin to argue that claim 1 is unpatentable as obvious to a person of ordinary skill in the art. Petitioner sets forth reasons to combine Kirsch with Eichstaedt and Lucovsky or Mellin.

a) *Petitioner’s Arguments*

First, as to Eichstaedt, Petitioner argues:

Kirsch and Eichstaedt are both directed to search query technology. It would have been obvious to a [person of ordinary skill in the art (POSITA)] to incorporate Eichstaedt’s monitoring functionality into Kirsch, so that a user could receive periodic updates of new search results from the “selected document collections” in Kirsch.

Pet. 29 (citing Ex. 1003 ¶¶ 70–71).

Second, as to Lucovsky, Petitioner argues:

Kirsch, Eichstaedt and Lucovsky are all directed to search query technology. It would have been obvious to incorporate Lucovsky’s search results sharing techniques with Eichstaedt and Kirsch, so that a first user could share updates with a second user.

Id. at 30 (citing Ex. 1003 ¶ 75).

Third, as to Mellin, Petitioner argues:

In a case where the author of the query (mapped to “a first user” in the claim) was part of a group collaboration, it would have been obvious for the author to designate a group email address to receive search result updates (based on Eichstaedt) so that results were distributed to all collaborators. Any collaborator on the group email address other the author of the search query maps to “a second user.”

Id. at 37 (citing Ex. 1003 ¶¶ 98–99).

b) Patent Owner’s Arguments

Patent Owner argues that Petitioner’s statements are conclusory and do not establish a reason to combine Kirsch with Eichstaedt. *See* Prelim. Resp. 9. For example, Patent Owner argues that the fact that the “references share a field does not by itself establish a reason to combine them.” *Id.* (citing *Securus Techs., Inc. v Glob. Tel*Link Corp.*, 701 F. App’x 971, 976–77 (Fed. Cir. 2017) (non-precedential); *Microsoft Corp. v. Enfish, LLC*, 662 F. App’x 981, 990 (Fed. Cir. 2016) (non-precedential)). Patent Owner further argues that Petitioner “fails to explain *why* a POSITA would have sought to enable a user to ‘receive periodic updates of new search results from the ‘selected document collections’ in Kirsch.”” *Id.* at 10 (emphasis added). Finally, Patent Owner asserts that Dr. Srivastava’s (Petitioner’s declarant) testimony is entitled to little weight because the testimony “largely repeats (word-for-word) the petition’s conclusory assertions.” *Id.* at 11 (citing Pet. 29; Ex. 1003 ¶¶ 70–71; *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15–17 (PTAB Aug. 24, 2022) (precedential)).

Patent Owner presents similar arguments against Petitioner’s reasons to combine Kirsch and Eichstaedt with Lucovsky or Mellin. *See* Prelim. Resp. 12–13 (discussing Lucovsky), 16–17 (discussing Mellin). For

example, Patent Owner argues that Petitioner’s argument to combine Lucovsky’s “search results sharing techniques” with Kirsch and Eichstaedt is “conclusory, circular reasoning” that does not show why one skilled in the art would have combined the references. *Id.* at 13–14. As to Mellin, Patent Owner argues that “the petition fails to explain *why* a query author would want to designate a group email address to receive search results, let alone *why* updates to the search results would want to be shared with the group email address.” *Id.* at 17. Finally, Patent Owner reiterates that Dr. Srivastava’s testimony for combining Kirsch and Eichstaedt with Lucovsky or Mellin “does not cure the petition’s deficiencies, as that testimony repeats the same sort of deficient contentions as the petition.” *Id.* at 14 (citing Ex. 1003 ¶¶ 75–77), 17 (citing Ex. 1003 ¶¶ 98–99).

c) Analysis

We agree with Patent Owner that Petitioner’s arguments for combining Kirsch, Eichstaedt, and Lucovsky or Mellin fail to meet Petitioner’s burden to establish a reasonable likelihood of success.

Our reviewing court has emphasized that the “motivation-to-combine analysis is a flexible one.” *Intel Corp. v. PACT XPP Schweiz AG*, 61 F.4th 1373, 1379 (Fed. Cir. 2023). And it is well-established that “any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *KSR*, 550 U.S. at 420. Despite this flexible standard, our reviewing court cautions that “‘a conclusory assertion with no explanation is inadequate to support a finding that there would have been a motivation to combine’ because ‘[t]his type of finding, without more, tracks the *ex post* reasoning *KSR* warned of and fails to identify any actual *reason* why a skilled artisan would have combined the elements in the manner

claimed.” *TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019) (quoting *In re Van Os*, 844 F.3d 1359, 1361–62 (Fed. Cir. 2017)); *see also TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1066 (Fed. Cir. 2016) (“Although the *KSR* test is flexible, the Board ‘must still be careful not to allow hindsight reconstruction of references . . . without any explanation as to *how* or *why* the references would be combined to produce the claimed invention.”).

Petitioner first argues that Kirsch, Eichstaedt, and Lucovsky are all directed to the same search query technology. *See* Pet. 29–30. Although not expressly stated, Petitioner appears to rely on the “known-technique” rationale for combining references, i.e., “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *Intel*, 61 F.4th at 1380. For example, in *Intel*, the petitioner asserted “that a person of ordinary skill would have been motivated to combine [the asserted references] because they ‘relate to the same field of multiprocessor . . . systems’ and ‘address the same problem: maintaining cache coherency.’” *Id.*

In contrast, Petitioner makes no connection between the similarity of the references and the problem to be solved. For example, Petitioner asserts one skilled in the art would “incorporate Eichstaedt’s monitoring functionality into Kirsch, so that a user could receive periodic updates of new search results from the ‘selected document collections’ in Kirsch.” Pet. 29–30 (citing Ex. 1003 ¶¶ 70–71). But there is no explanation of a need or demand for this feature, or a problem in Kirsch to be solved. Rather this is a conclusory assertion, without explanation, that one skilled in the art would incorporate Eichstaedt’s method to gain the benefit of Eichstaedt’s method.

Further, as Patent Owner notes, Petitioner's declarant testimony is identical to the Petition and does not cite to any evidence either in the asserted references or other documents to support a reason to combine the references. *See, e.g.*, Ex. 1003 ¶¶ 70, 71. In brief, "[t]he declaration does not provide any technical detail, explanation, or statements supporting *why* [Dr. Srivastava] determines that the feature in question was required or would have been obvious based on the prior art disclosure." *Xerox*, Paper 12, 5. Accordingly, we give little weight to Petitioner's declarant testimony because the declaration merely offers conclusory assertions without underlying factual support and repeats, *verbatim*, Petitioner's conclusory arguments. *Id.*

Petitioner's proposed combinations of Kirsch and Eichstaedt with Lucovsky or Mellin fail for the same reasons. Petitioner's proffered reason to combine Kirsch and Eichstaedt with Lucovsky is a conclusory assertion that one of skill in the art would have incorporated Lucovsky's functionality of sharing updates (Pet. 30–31) that is mirrored by Dr. Srivastava's declaration, which lacks further evidence or explanation (*see* Ex. 1003 ¶ 75). Petitioner's proposed reason to combine Kirsch and Eichstaedt with Mellin provides a hypothetical, and asserts that "[i]n a case where the author of the query . . . was part of a group collaboration, it would have been obvious for the author to designate a group email address to receive search result updates (based on Eichstaedt) so that results were distributed to all collaborators." Pet. 37. But this hypothetical is not supported by evidence, either in the Petition itself or the identical recitation in Dr. Srivastava's declaration. *See* Ex. 1003 ¶ 98. Accordingly, Petitioner has not met its burden to show a reasonable likelihood that the patent claims it challenges are unpatentable based on the asserted grounds.

4. *Conclusion as to the Combination of Kirsch, Eichstaedt, and Other References*

For these reasons, Petitioner does not establish a reasonable likelihood that one skilled in the art would have combined Kirsch, Eichstaedt, and Lucovsky or Mellin. Accordingly, Petitioner has not shown a reasonable likelihood of prevailing with respect to independent claims 1, 10 and 19, and their dependent claims⁸ on the grounds relying on the combination of Kirsch, Eichstaedt, and Lucovsky or Mellin.

F. *Alleged Obviousness of Claims 1, 10, and 19 over Learning Lexis, Kirsch, and Lucovsky*

Petitioner argues that independent claims 1, 10, and 19 are unpatentable as obvious over Learning Lexis, Kirsch, and Lucovsky. Pet. 45–60. Patent Owner disagrees, arguing that the Petition fails to establish a reasonable likelihood of prevailing in demonstrating unpatentability of the claims. *See* Prelim. Resp. 23–28.

1. *Generating, Expanding, and Executing a Query*

Petitioner contends that Learning Lexis teaches a method of analyzing data by selecting sources, searching document collections, and retrieving and reviewing documents, “all of which map to ‘analyzing data.’”⁹ Pet. 49 (citing Ex. 1011, 1, 3; Ex. 1003 ¶ 138). Specifically, Petitioner asserts “Learning Lexis teaches that a user generated query is entered into a search box,” in boolean or natural language format, for a topic of interest. *Id.* at 50

⁸ Petitioner’s challenges of dependent claims 2–9, 11–18, and 20–21 all rely on the same underlying combinations of Kirsch, Eichstaedt, and Lucovsky or Mellin, and therefore fail for the same reasons. *See* Pet. 32–45.

⁹ Because Petitioner has sufficiently shown that the prior art teaches the preamble, we need not determine whether the preamble is limiting. *See Nidec*, 868 F.3d at 1017.

(citing Ex. 1011, 10; Ex. 1003 ¶ 139). Next, Petitioner argues that Learning Lexis teaches functionality for “expanding search terms of the query” by “suggesting additional search terms” and “automatically searching” for equivalent terms. *Id.* at 51 (citing Ex. 1011, 10, 13; Ex. 1003 ¶¶ 140, 141).

Petitioner further argues that Learning Lexis teaches “executing the query on a plurality of data sources” with various options for source selection. Pet. 52–54 (citing Ex. 1011, 6–7, 31; Ex. 1003 ¶¶ 142–147). Petitioner highlights the “source hierarchy” option, including “Combined Federal & State Case Law -US,” that combines “individual collections (or data sources) each of which represent[s] the Federal and State cases for a particular state jurisdiction.” *Id.* at 53 (citing Ex. 1003 ¶ 143). Other sources include “Federal Legal – U.S.,” that combines individual collections corresponding to various Federal Circuits, and “States Legal – U.S.,” that combines individual collections of state jurisdictions. *Id.* at 53–54 (citing Ex. 1011, 31; Ex. 1003 ¶¶ 144–145).

Patent Owner does not dispute that Learning Lexis teaches the claimed steps of generating a query, expanding the query, and executing the query on a plurality of data sources. We are persuaded by Petitioner’s argument that Learning Lexis teaches these steps.

2. Selecting a Data Source from a Plurality of Data Sources

Petitioner relies on the combination of Learning Lexis and Kirsch to teach the step of “selecting at least one data source from the plurality of data sources.” Pet. 55–56. Patent Owner argues the Petition does not establish sufficiently that one skilled in the art would have been motivated to combine Learning Lexis and Kirsch as Petitioner proposes. *See* Prelim. Resp. 23–25.

a) Petitioner's Argument

Petitioner asserts that Kirsch teaches “selecting at least one data source” (qualified set) “from the plurality of data sources” (document collections), “when results of the query are greater than or equal to an accuracy thresholds” (based on exceeding a minimum level of relevance and a minimum relevancy ranking threshold). Pet. 56 (citing Ex. 1009, 14:48–50, 6:29–30; Ex. 1003 ¶ 149); *see also* Pet. 27–28. Petitioner argues that it would have been obvious to use Kirsch’s teachings “to select a source (e.g., a collection limited to the specific state jurisdiction) from within the hierarchy to monitor for updates,” in combination with the Learning Lexis “ECLIPSE Feature” discussed below. *Id.* at 55 (citing Ex. 1011, 26).

As to the reason to combine the references, Petitioner proposes a hypothetical: “if an initial query directed to ‘employee drug tests’ indicated that all or most of the pertinent cases were being litigated in a particular state, it would make sense to limit the ongoing monitoring of caselaw developments in the topic to developments in that particular state.” *Id.* at 55–56 (citing Ex. 1003 ¶ 148).

Petitioner further argues:

It would have been obvious to apply Kirsch’s collection techniques to the system taught in Learning Lexis. A POSITA would have been motivated to use the collection selection techniques in Kirsch to narrow the combined sources searched in Learning Lexis in an initial query to a single data source or a subset of the combined sources for ongoing monitoring.

Id. at 56 (citing Ex. 1003 ¶ 150).

b) Patent Owner's Argument

Patent Owner argues that one skilled in the art “would not have sought

to combine *Kirsch* with *Learning Lexis*'s ECLIPSE feature to give the user *less* than what the user desires to search and monitor." Prelim. Resp. 24–25. Instead, Patent Owner argues "[t]hat the user is searching or monitoring cases from multiple jurisdictions (such as every state) indicates that the user wants coverage of all of those jurisdictions, not merely one of them." *Id.* at 25. Patent Owner further argues that neither the Petition nor Dr. Srivastava explains why a skilled artisan would have sought to provide the user with less information than the user sought. *Id.* As to Petitioner's "employee drug test" hypothetical, Patent Owner raises a counter-hypothetical of an employer with employees in multiple states or states not including the particular state to which the search was narrowed. *See id.*

c) Analysis

We agree with Patent Owner that Petitioner's arguments for combining *Learning Lexis* and *Kirsch* fail to meet Petitioner's burden to establish a reasonable likelihood of success.

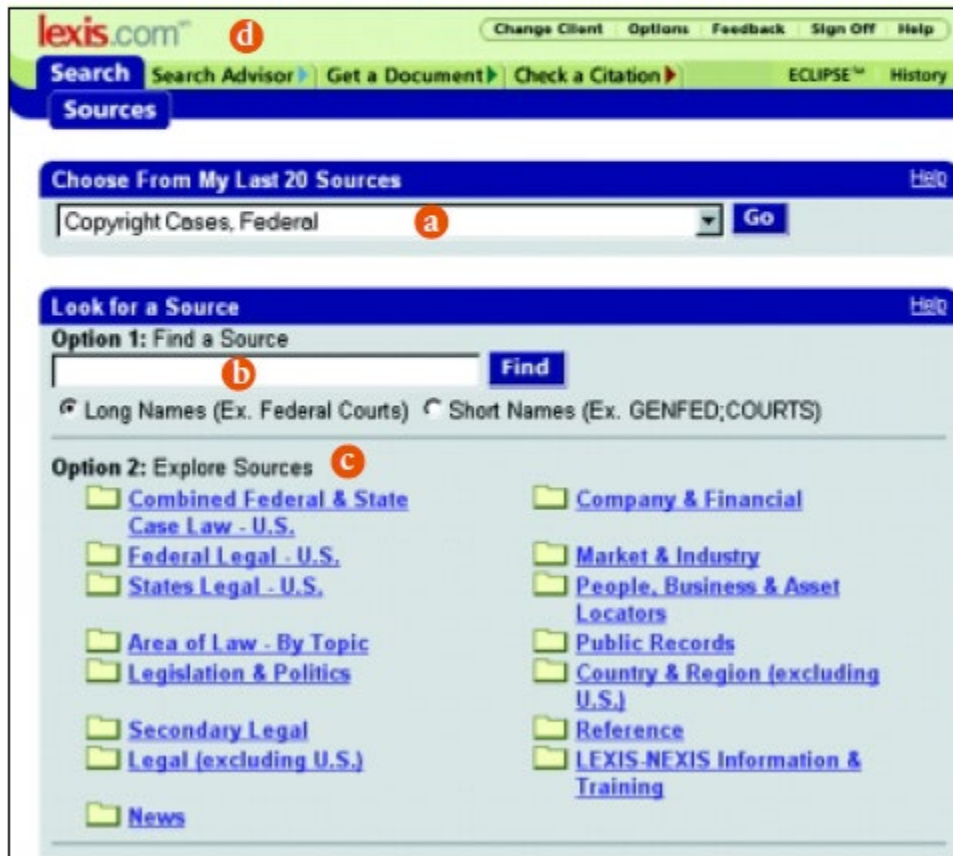
The premise of Petitioner's combination is that one skilled in the art would have applied *Kirsch*'s teachings "to narrow the combined sources searched in *Learning Lexis* in an initial query to a single data source or a subset of the combined sources for ongoing monitoring." Pet. 56 (Ex. 1003 ¶ 150). But this conclusory assertion is not supported by the evidence of record.

We first consider the disclosure of *Learning Lexis*. Petitioner cites *Learning Lexis* page 6 for listing the plurality of sources, reproduced below.

Select a source

You have several options for selecting a source. You can:

- choose a source from the list of sources you recently used;
- find a source by specifying the name of the source;
- explore sources through the source hierarchy; or
- use the LEXIS® Search Advisor (a source selection tool for area-of-law case finding).



The cited page contains a screenshot of the Learning Lexis “Select a source” feature. *See* Ex. 1011, 6.

The source may be chosen using “My Last 20 Sources” or “Look for a Source.” *See id.* “Look for a Source” includes “Option 1: Find a Source” and “Option 2: Explore Sources.” *Id.* Learning Lexis explains that

[e]xploring sources is useful when you’re unsure of the ultimate source you want to use for your research. As the name of the method implies, you explore by pointing and clicking through the source hierarchy until you reach the source you want. Each

selection you make by clicking on the source name takes you deeper into the source hierarchy and a “trail” of your selection displays. A “trail” may look like this:

Combined Federal & State Case Law – U.S.: All Courts – By
State: CA Federal & State Cases

Id. at 7. The screenshot also illustrates “Explore Sources” databases including “Combined Federal & State Case Law – U.S.,” “Federal Legal – U.S.,” and “States Legal – U.S.” *Id.* at 6. Separately, Learning Lexis shows that user can restrict searches to specific Federal circuit courts or State jurisdictions when checking case law citations. *See id.* at 27–31.

Thus, we agree with Petitioner that Learning Lexis illustrates searching at least one data source within a plurality of data sources. However, we are not persuaded by Petitioner’s reasoning to combine the reference with Kirsch’s teachings to automatically narrow the search to one or more data sources taught by Learning Lexis.

As shown by the screenshot reproduced above and the text’s description of “Explore Sources,” Learning Lexis already includes the option for the user to manually select a data source from a plurality of data sources. *See Ex. 1011, 6.* The description for exploring sources further describes how the user clicks through the source hierarchy until the user finds the desired data source, e.g., CA Federal & State Cases. *See id.* at 7. Even if Learning Lexis already solves the problem of selecting a data source from a plurality of data sources, there still may be a motivation to combine the references if Petitioner shows that one skilled in the art would use Kirsch’s known technique to improve Learning Lexis in the same way. *See Intel*, 61 F.4th at 1380–81.

Petitioner’s reasoning relies on its hypothetical, that an initial query indicates “that all or most of the pertinent cases were being litigated in a

particular state,” so “it would make sense to limit the ongoing monitoring of caselaw developments in the topic to developments in that particular state.” Pet. 55–56 (citing Ex. 1003 ¶ 148). Although Petitioner cites to Dr. Srivastava’s declaration, the cited language mirrors the Petition and does not include any citations to the cited references or other evidence to support the hypothetical. *See* Ex. 1003 ¶ 148. Accordingly, we give little weight to Dr. Srivastava’s testimony on this issue because the declaration merely offers conclusory assertions without underlying factual support and repeats, *verbatim*, Petitioner’s conclusory arguments. *Xerox*, IPR2022-00624, Paper 12 at 5.

We agree with Patent Owner that a lexis.com user who intentionally selected a broader database from a choice of more narrow sources would not have sought to automatically narrow the search scope. Prelim. Resp. 24–25. Additionally, we agree with Patent Owner that narrowing the results to a particular state may defeat the purpose of the search for an employer with employees in all 50 states or a different state from the narrowed state. *See id.* at 25. As Learning Lexis illustrates, American jurisprudence is jurisdiction-specific, where the law of one particular state may not be relevant to a user practicing in a different state or circuit. *See, e.g.*, Ex. 1011, 27–31 (providing the option to manually restrict citation searches to specific states or circuits). Accordingly, we are not persuaded by Petitioner’s reasoning to combine Learning Lexis and Kirsch.

3. *Monitoring the Selected Data Source*

Petitioner asserts that Learning Lexis teaches “monitoring, based on a set schedule,” a plurality of data sources, and updating with “newly added data that matches the query” because it describes an “ECLIPSE Feature” that “allows a user to ‘automatically save and re-run searches for updates’ at

periodic intervals, and receive the updates by, e.g., email.” Pet. 57 (citing Ex. 1011, 26; Ex. 1003 ¶ 151). Petitioner relies on Kirsch’s teachings with respect to limiting the monitoring to “the at least one data source to extract data from the at least one data source.” Pet. 55–58 (citing Ex. 1009, 14:48–50, 6:29–30; Ex. 1003 ¶¶ 149–150, 152). Specifically, Petitioner argues that “it would have been obvious to use the teachings of Kirsch to select a source (e.g., a collection limited to the specific state jurisdiction) from within the hierarchy to monitor for updates.” *Id.* at 57–58.

As discussed above, we are not persuaded by Petitioner’s reasoning to combine Learning Lexis and Kirsch. Accordingly, we are not persuaded that Petitioner sufficiently establishes that it would have been obvious to use Kirsch’s teachings with respect to the “monitoring, based on a set schedule, the at least one data source . . .” limitation of claim 1.

4. Communicating with a Second User

Petitioner asserts that Learning Lexis teaches the ECLIPSE Feature can send updates by email. Pet. 58–59 (citing Ex. 1011, 26; Ex. 1003 ¶ 153). Petitioner further asserts that “Learning Lexis also discloses that documents from search results may be emailed ‘to yourself or to others.’” *Id.* at 59 (citing Ex. 1011, 34). Petitioner contends that by combining the ECLIPSE Feature with the email to another person, “Learning Lexis discloses ‘establishing a communication channel with a second user based at least in part on the data extracted from the at least one monitored data source.’” *Id.* at 59 (citing Ex. 1003 ¶¶ 154–155). Alternatively, Petitioner asserts that the

combination of Learning Lexis and Lucovsky teaches this step.¹⁰ *See id.* at 59–60.

Patent Owner argues that ECLIPSE and email delivery to another person are separate features of Learning Lexis. Prelim. Resp. 26–27 (citing Pet. 50; Ex. 1011, 26, 34). Patent Owner argues that “the petition does not establish that ECLIPSE itself provides for emailing ECLIPSE updates to a different person, nor does it establish a reason to combine the separate ‘Email Delivery’ feature with ECLIPSE.” *Id.*

We are persuaded by Petitioner’s argument that it would have been obvious to one skilled in the art to combine Learning Lexis’ features to allow the ECLIPSE search results to be shared with another person by email. Learning Lexis describes sharing search results with another user and monitoring updates by specifying an email address. Accordingly, Petitioner’s reason to combine the different features taught by Learning Lexis is supported by the reference itself.

5. *Conclusion as to the Combinations of Learning Lexis Kirsch, Lucovsky, and Other References*

As discussed above, Petitioner does not establish a reasonable likelihood that one skilled in the art would have combined Learning Lexis and Kirsch as Petitioner proposes. Thus, Petitioner has not shown a reasonable likelihood that it would prevail with respect to at least one of the challenged claims under any of the five grounds that rely on the combination

¹⁰ Because we find Petitioner has shown sufficiently that Learning Lexis itself teaches or suggests the step of communicating monitored data with a second user, we do not address Petitioner’s argument based on Learning Lexis and Lucovsky.

of Learning Lexis and Kirsch.¹¹ Accordingly, we do not institute *inter partes* review of independent claims 1, 10 and 19, and their dependent claims,¹² on the grounds relying on the combination of Learning Lexis and Kirsch.

G. Alleged Obviousness of Claims 1, 10, and 19 over Liang and Other References

Petitioner argues that independent claims 1, 10, and 19 are unpatentable as obvious over Liang and Lucovsky. Pet. 64–71. Alternatively, Petitioner argues that these claims are unpatentable as obvious over Liang, Kirsch, and Lucovsky or Mellin. *Id.* at 72–74, 76–77. Patent Owner disagrees, arguing that Petitioner’s “obviousness grounds rely on conclusory statements instead of specific reasoning based on evidence,” as to the reasons to combine the references. Prelim. Resp. 8.

On this record, we determine that Petitioner does not establish a reasonable likelihood that one skilled in the art would have combined the references.

1. Steps for Addressing the Collection Search Problem and Monitoring the Selected Data Source

Petitioner contends that Liang teaches a method of analyzing data¹³ by generating a query, expanding the search terms, searching a plurality of data

¹¹ (1) Learning Lexis, Kirsch, Lucovsky; (2) Learning Lexis, Kirsch, Lucovsky, Schultz; (3) Learning Lexis, Kirsch, Lucovsky, Liang; (4) Learning Lexis, Kirsch, Lucovsky, Moulinier; and (5) Learning Lexis, Kirsch, Lucovsky, Vinsonneau.

¹² Petitioner’s challenges of dependent claims 2–9, 11–18, and 20–21 all rely on the same underlying combination of Learning Lexis, Kirsch, and Lucovsky, and therefore fail for the same reasons. *See* Pet. 45–63.

¹³ Because Petitioner has sufficiently shown that the prior art teaches the preamble, we need not determine whether the preamble is limiting. *See Nidec*, 868 F.3d at 1017.

sources, and selecting a data source. Pet. 64–69 (citing Ex. 1010 ¶¶ 13, 22, 167, 178, 184, Figs. 1, 4; Ex. 1003 ¶¶ 176–180). Petitioner also contends that Liang teaches the step of monitoring the selected (at least one) data source. *See id.* at 69–70 (citing Ex. 1010 ¶¶ 52, 347, Fig. 1; Ex. 1003 ¶ 181).

Patent Owner does not dispute Liang’s teachings.¹⁴ We are persuaded by Petitioner’s argument that Liang teaches or suggests the claimed steps for addressing the collection search problem and a step for monitoring the at least one data source for new data.

2. Communicating with a Second User

Petitioner cites Lucovsky or Mellin in combination with Liang to teach the step of “establishing a communication channel with a second user based at least in part on the data extracted from the at least one monitored data source.” *See* Pet. 70–71.

a) Petitioner’s Arguments

Petitioner relies on Lucovsky’s teaching of “a first user sharing search results with a second user via an email, message board, instant messaging and a blog.” Pet. 70 (citing Ex. 1015, Figs. 4–9). As to the reason to combine Liang and Lucovsky, Petitioner argues:

Liang and Lucovsky are all directed to search query technology. It would have been obvious to incorporate Lucovsky’s search results sharing techniques with Liang, so that a first user could share updates with a second user.

Id. (citing Ex. 1003 ¶¶ 182–183).

¹⁴ Because we find Petitioner has shown sufficiently that Liang teaches the selecting step, we do not address Petitioner’s combination of Liang with Kirsch directed to the same limitation. *See* Pet. 72–73.

Alternatively, Petitioner relies on Mellin to teach using “a group email address to facilitate collaboration among members of a group.” *Id.* at 76–77 (citing Ex. 1016, 3:24–26). As to the reason to combine Liang and Mellin, Petitioner argues:

In a case where the author of the query (mapped to “a first user” in the claim) was part of a group collaboration, it would have been obvious for the author to designate a group email address to receive search result updates so that the updated search results were distributed to all collaborators. Any collaborator on the group email address other the author of the search query maps to “a second user” in the claim.

Id. (citing Ex. 1003 ¶ 210).

b) Patent Owner’s Arguments

Patent Owner reiterates its previous arguments—applied against Kirsch and Lucovsky or Mellin—to the combination of Liang and Lucovsky or Mellin. First, Patent Owner argues that “references being simply directed to the same field or technology is not a motivation to combine.” Prelim. Resp. 33. Second, Patent Owner argues that Petitioner’s argument “that a POSITA would have combined features in order to obtain the combined features” is conclusory and result-oriented. *Id.* at 34; *see also id.* at 38 (arguing that the Petition fails to explain why one skilled in the art would combine the references). Finally, Patent Owner argues that “Dr. Srivastava’s testimony tracks the petition and adds nothing to the deficient reasoning set forth in the petition.” *Id.* at 34, 38 (citing Ex. 1003 ¶¶ 182–183, 210–211).

c) Analysis

We agree with Patent Owner that Petitioner’s arguments for combining Liang and Lucovsky or Liang and Mellin fail to meet Petitioner’s burden to establish a reasonable likelihood of success.

Petitioner's reasons to combine Liang and Lucovsky or Mellin are identical to its previously stated reasons to combine Kirsch and Lucovsky or Mellin. While not necessarily improper, repeating the identical argument emphasizes Petitioner's conclusory reasoning that one skilled in the art would simply combine the references for the purposes of adding the feature, entirely independent of the primary references' teachings. *See TQ Delta*, 942 F.3d at 1359 (holding that declarant testimony that "fail[s] to provide any meaningful explanation for why one of ordinary skill in the art would be motivated to combine the[] references" is insufficient to support an obviousness determination). And as discussed above, we give little weight to Dr. Srivastava's testimony supporting the reason to combine because the declaration merely offers conclusory assertions without underlying factual support and repeats, *verbatim*, Petitioner's conclusory arguments. *See Xerox*, IPR2022-00624, Paper 12 at 5. Because Petitioner's reasoning is conclusory and not supported by evidence, we are not persuaded that Petitioner has shown sufficiently that one skilled in the art would have combined the references as proposed.

3. *Conclusion as to the Combinations of Liang and Other References*

For these reasons, Petitioner does not establish a reasonable likelihood that one skilled in the art would have combined Liang and Lucovsky or Liang, Kirsch, and Lucovsky or Mellin as Petitioner proposes. Accordingly, Petitioner has not shown a reasonable likelihood of prevailing with respect to independent claims 1, 10 and 19, and their dependent claims,¹⁵ on the grounds relying on the combinations of Liang and other references.

¹⁵ Petitioner's challenges of dependent claims 2, 5, 7, 9, 11, 14, 16, 18, 20, and 21 all rely on the same underlying combinations of Liang and Lucovsky

IV. CONCLUSION

For the foregoing reasons, we determine that Petitioner does not establish a reasonable likelihood of prevailing with respect to any of the challenged claims. Thus, we do not institute an *inter partes* review.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), the Petition is denied, and no *inter partes* review is instituted.

or Liang, Kirsch, and Lucovsky or Mellin, and therefore fail for the same reasons. *See* Pet. 64–81.

IPR2024-01304
Patent 9,229,977 B2

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