

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRAVELOCITY.COM L.P., PRICELINE.COM INC.,
and EXPEDIA, INC.,
Petitioner,

v.

CRONOS TECHNOLOGIES, LLC,
Patent Owner.

Case CBM2014-00082
Patent 5,664,110

Before JENNIFER S. BISK, JAMES B. ARPIN, and
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

DECISION
Denying Covered Business Method Patent Review
37 C.F.R. § 42.208

I. BACKGROUND

Travelocity.com L.P., Priceline.com Inc., and Expedia, Inc. (collectively, “Petitioner”) filed a Petition (Paper 8, “Pet.”) requesting institution of a covered business method patent review of claims 1–3, 8–19, 22–28, 31–36 and 41–44 of U.S. Patent No. 5,664,110 (Ex. 1001, “the ’110 Patent”) pursuant to 35 U.S.C. §§ 321–329. Cronos Technologies, LLC (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 324.

The standard for instituting a covered business method patent review is set forth in 35 U.S.C. § 324(a):

THRESHOLD.—The Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.

Petitioner challenges claims 1–3, 8–19, 22–28, 31–36, and 41–44 of the ’110 Patent as unpatentable under 35 U.S.C. § 103(a) over various combinations of references. Pet. 16. For the reasons that follow, the Petition is *denied*.

A. *The ’110 Patent (Ex. 1001)*

The ’110 Patent generally relates to a remote ordering terminal that provides a user the ability to create or edit, or both, one or more order lists that are resident in memory within a user device and the further ability to review a user-interpretable display of the contents of such lists. Ex. 1001, col. 1, ll. 38–42. The remote ordering terminal provides multiple merchant stock databases, a data format/transfer computer (DFTC) as an interface

between customers and the merchant databases, and a user device referred to as a display/processor unit (DPU) at each of multiple customer sites for creating and transmitting order lists. *Id.* at col 1, ll. 42–47.

Figure 2 of the '110 patent is reproduced below:

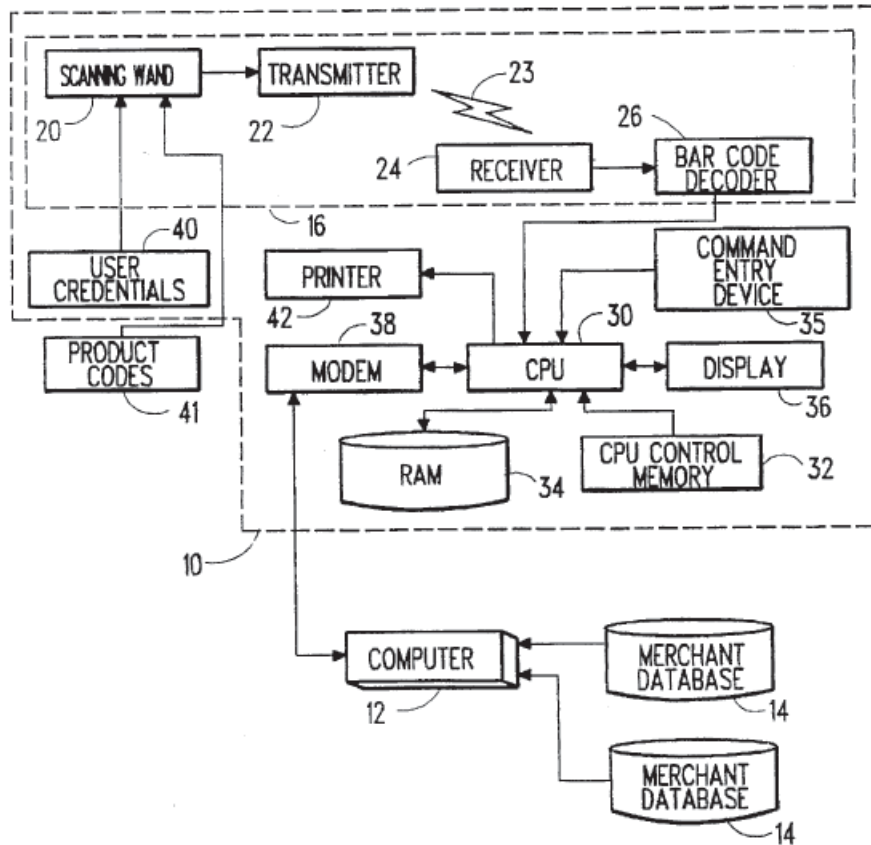


FIG. 2

Figure 2 is a schematic representation of the remote ordering system according to the '110 Patent.

As illustrated in Figure 2, each DPU 10 includes data entry device 16 which provides coded information to the rest of DPU 10. *Id.* at col. 3, ll. 5–7. In the embodiment of Figure 2, data entry device 16 includes optical

scanning wand 20 having RF transmitter 22 in communication with RF receiver 24, and also includes bar code decoder 26. *Id.* at col. 3, ll. 7–11. Scanning wand 20 may be passed over some form of bar code 41, whether displayed on a screen, printed on packaging for a desired product, in a catalog of codes, on coupons, or printed on a credit-card sized identification control card. *Id.* at col. 3, ll. 11–15. “The specific bar code employed may be Code 128, Codabar, or one of the UPC (UPC-A, UPC-E) or EAN (EAN-8, EAN-13) codes, or any other code including system specific code.” *Id.* at col. 3, ll. 15–18.

Regardless of the detection means or the code read, “the received code is interpreted by bar code decoder 26 to provide a common representation of the coded information, such as in ASCII format.” *Id.* at col. 3, ll. 18–21. The code may be user identification means, a merchant identification means, or a product bar code scanned from a list or screen. *Id.* at col. 3, ll. 5–21; *see id.* at col. 10, ll. 30–41. The user may create a list for local storage and review and for provision to a remotely-located order processing system. *See id.* at col. 7, ll. 1–13. When the list is provided to the order processing system, the order processing system returns new or replacement user-discernible information data, or both, relating to the items on the list. *Id.* at col. 1, ll. 54–58.

B. Related Matters

The ’110 Patent has been asserted in proceedings listed in the Petition. Pet. 67–70; *see* Paper 6, 1–2. The ’110 Patent currently is being asserted against Petitioner in *Cronos Technologies LLC v. Travelocity.com L.P.*, Case No. 1:13-cv-01544-LPS (D. Del.); *Cronos Technologies LLC v. Priceline.com*, Case No. 1:13-cv-01541-LPS (D. Del.); and *Cronos*

Technologies LLC v. Expedia Inc., Case No. 1:13-cv-01538-LPS (D. Del.).
Exs. 1002–1004.

C. Illustrative Claims

Petitioner challenges claims 1–3, 8–19, 22–28, 31–36, and 41–44 of the '110 Patent. Pet. 1. Claims 1 and 22 are independent. Claims 2, 3, and 8–19 depend from independent claim 1; and claims 23–28, 31–36, and 41–44 depend from independent claim 22. *See* Ex. 1001, col. 14, l. 46–col. 18, l. 28. Independent claim 1 is directed to a remote ordering terminal (*id.* at col. 14, l. 46–col. 15, l. 22), and independent claim 22 is directed to a method for remote ordering (*id.* at col. 16, l. 23–col. 17, l. 4). Claims 1 and 22 of the '110 Patent are illustrative of the claims at issue:

1. A remote ordering terminal for providing at least one list of at least one item or group of items to a remotely located order processing system associated with one or more merchants on each of a plurality of occasions, each item or group of items having an item code associated therewith, said remote ordering terminal comprising:

user and/or merchant identifier means;

at least one data entry device for providing said terminal with said item associated item codes and with data from said user and/or merchant identifier means;

a database unit providing a user-specific database including user-discernable item data associated with item codes for user-selected items or groups of items;

memory to provide storage for said user-specific database, said memory in communication with said at least one data entry device for storing said at least one list;

communication means for associating said memory and said

order processing system upon user command for remotely accessing said order processing system over a multi-user network, for transmitting said at least one list to said order processing system using said data from said user and/or merchant identifier means, and for receiving new and/or replacement user-discernable item data from said order processing system during association of said memory and said order processing system, said new and/or replacement user-discernable item data corresponding *only*^[1] to said at least one item or group of items of said at least one list;

a message display portion in communication with said memory and said user-specific database for displaying order pertinent information including said user-discernable item data from said memory; and

at least one command entry device responsive to user selection of items from said order pertinent information for assembling said at least one list and for enabling said user command, resulting in said transmitting of said at least one list to said order processing system,

wherein said at least one list is comprised of an order to be processed by said order processing system, or a provisional order list transmitted to said order processing system, transmission of either resulting in on-demand receipt of said new and/or replacement user-discernable item data within said user-specific database for said at least one item or group of items.

Id. at col. 14, l. 46–col. 15, l. 22 (emphasis added).

22. A method for remote ordering at least one desired item by a user from one of a plurality of merchants using a system having a user device, a central computer, one of a plurality of

¹ Prior to issuance of a Notice of Allowance, the Examiner amended each of claims 1 and 22 to include the word “only.” Ex. 1012, 225–6. Neither party addresses this added word in its claim construction.

merchant databases, and a communications link including a multi-user network, said at least one desired item having a unique identifying code associated therewith, the method comprising:

storing for a plurality of user-specific items, in an identifier database accessible at said user device for user perception at said user device, a user-cognizable identifier of said at least one item corresponding to said identifying code;

user inputting said identifying code corresponding to said at least one desired item into said user device by machine recognition of said user input identifying code;

accumulating from said identifier database selected ones of said user-cognizable identifiers corresponding to said input identifying codes in at least one list of desired items;

selectively associating a transaction identifier having user and/or merchant identifications with said user device to identify a selected merchant database and/or to identify said user to a selected merchant database;

commanding said user device to establish remote communication between said user device and said selected merchant database corresponding to said merchant identification through said central computer over said communications link including said multi-user network;

interactively updating *only* said selected one of said user-cognizable identifiers in said identifier database of user-specific items with current information provided by said merchant database over said communications link in response to a user action at said user device, said user action including

the communication of a provisional list of desired items transmitted to said selected merchant database for the purpose of providing said interactive updating, or the communication of

an order list of desired items transmitted to said selected merchant database for the purpose of providing said interactive updating and remote ordering said desired items comprising said order list; and

passing transaction specific information over said communications link including said identifying codes between said user device and said selected merchant database.

Id. at col. 16, l. 23 – col. 17, l. 4 (emphasis added).

D. Asserted References and Declaration

In its Petition, Petitioner refers to the following references and declaration:

Exhibit	References and Declaration
1002	Infringement Contentions, Cronos Technologies, LLC v. GNC
1004	U.S. Patent No. 5,347,632, issued to Filepp et al. on Sep. 13, 1994, from an application filed July 28, 1989 (“Filepp”)
1005	Viescas, J., The Official Guide to the Prodigy Service, Microsoft Press, 1991 (excerpted Introduction, Chs. 1, 2, 6, and 7) (“Viescas”)
1006	Peapod, Inc., Peapod User Manual v. 3.1, Aug. 1992 (“Peapod”)
1010	U.S. Patent No. 4,654,482, issued to DeAngelis on Mar. 31, 1987 (“DeAngelis”)
1011	Declaration of Richard Taylor, Ph.D. (“Declaration of Dr. Taylor”)

Pet. vi.

E. Asserted Grounds of Unpatentability

Petitioner asserts “[w]hile these references individually may render the claims unpatentable, Petitioner[] rel[ies] on 35 U.S.C. § 103[(a)] to

simplify the number of grounds for trial.” Pet. 19. Therefore, Petitioner challenges the patentability of claims 1–3, 8–19, 22–28, 31–36, and 41–44 of the ’110 Patent based *only* on the following three grounds of unpatentability:

References	Basis	Claims challenged
Viescas, Filepp, and Peapod	§ 103(a)	1–3, 8–15, 17–19, 22, 24, 26–28, 31–36, 41, and 43–44
Viescas, Filepp, Peapod, and DeAngelis	§ 103(a)	1–3, 8–19, 22–28, 31–36, and 41–44
Viescas, Peapod, and the admitted prior art of DeAngelis	§ 103(a)	1–3, 8–19, 22–28, 31–36, and 41–44

Pet. 16.

II. ANALYSIS

A. Financial Product or Service

A “covered business method patent” is a patent that “claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.” Leahy-Smith America Invents Act, Pub. L. No. 112–29, § 18(d)(1), 125 Stat. 284 (2011) (“AIA”); *see* 37 C.F.R. § 42.301(a). For purposes of determining whether a patent is eligible for a covered business method patent review, the focus is on the claims. *See* Transitional Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention, 77 Fed. Reg.

48,734, 48,736 (Aug. 14, 2012). A patent need have only one claim directed to a covered business method to be eligible for review. *Id.*

In promulgating rules for covered business method patent reviews, the Office considered the legislative intent and history behind the AIA’s definition of “covered business method patent.” *Id.* at 48,735–36.

Specifically, the legislative history of the AIA provides that:

The plain meaning of “financial product or service” demonstrates that section 18 is not limited to the financial services industry. At its most basic, a financial product is an agreement between two parties stipulating movements of money or other consideration now or in the future.

. . .

Rather, because the patents apply to administration of a business transactions, such as financial transactions, they are eligible for review under this section. To meet this requirement, the patent need not recite specific financial product[s] or service[s].

157 Cong. Rec. S5432 (daily ed. Sept. 8, 2011)(statement of Sen. Schumer); *see* Transitional Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention, 77 Fed. Reg. at 47,736. Thus, the legislative history indicates that “financial product or service” should be interpreted broadly. *Id.*

Petitioner contends that the patent describes a remote ordering system “that enables customers to order goods and services from merchants. . . . For example, claim 22 recites such a business method: identifying one or more products that a customer desires to purchase, obtaining information about the product, such as its price and placing an order for the item(s).” Pet. 2–3 (citing Ex. 1001, col. 1, ll. 5–47). We are persuaded that the ’110 Patent describes a “financial product or service” consistent with the governing

statute.² We also are persuaded by Petitioner that the e-commerce transactions recited in claims 1 and 22 represent the type of activities “that are financial in nature, incidental to a financial activity or complementary to a financial activity.” Transitional Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention, 77 Fed. Reg. at 48,736.

Patent Owner argues that the patent is not related to a “financial product or service.” Prelim. Resp. 2. Patent Owner’s arguments, however, are not persuasive. As noted above, the presence of claimed embodiments directed to e-commerce transactions makes clear that the method claims have utility to financial processes. *See, e.g.*, Ex. 1001, col. 14, l. 62–col. 15, l. 6 (claim 1), col. 16, ll. 48–53 (claim 22); *see also id.* at col. 1, ll. 42–47 (“The present invention provides multiple merchant stock databases, a data format/transfer computer (DFTC) as an interface between customers and the merchant databases, and a user device referred to as a display/processor unit (DPU) at each of multiple customer sites for creating and transmitting order lists.”). Consequently, we are not persuaded by Patent Owner that the ’110 Patent is not related to a financial product or service. *See* Prelim. Resp. 2. As such, we are persuaded that the challenged claims of the ’110 Patent meet the “financial product or service” component of § 18(d)(1) of the AIA.

B. Technological Invention

The definition of “covered business method patent” in § 18(d)(1) of the AIA does not include patents for “technological inventions.” To determine whether a patent is for a technological invention, we consider two

² *See Apple, Inc. v. Sightsound Techs, LLC*, CBM2013-00019, slip op. at 12 (PTAB October 8, 2013) (Paper 17).

factors: “whether the claimed subject matter as a whole recites a *technological feature* that is novel and unobvious over the prior art; *and* solves a technical problem using a *technical solution*.” 37 C.F.R. § 42.301(b) (emphases added). A patent is ineligible for covered business method patent review only if both factors of this test are satisfied. The following claim drafting techniques, for example, typically do not render the claimed subject matter of a patent a “technological invention”:

(a) Mere recitation of known technologies, such as computer hardware, communication or computer networks, software, memory, computer-readable storage medium, scanners, display devices or databases, or specialized machines, such as an ATM or point of sale device.

(b) Reciting the use of known prior art technology to accomplish a process or method, even if that process or method is novel and non-obvious.

(c) Combining prior art structures to achieve the normal, expected, or predictable result of that combination.

Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,763–64 (Aug. 14, 2012).

Petitioner contends that the method for remote ordering recited in challenged claim 22 of the ’110 Patent is not directed to a technological invention. Pet. 5–7. First, Petitioner contends that, during prosecution of the ’110 Patent, Patent Owner distinguished its claims over the cited art based only on the features of the business process, instead of any “technological feature” recited in the claims. *Id.* Thus, we are persuaded that Petitioner demonstrates that at least challenged claim 22 was not distinguished over the applied art based on a novel and non-obvious technological feature.

Second, Petitioner contends that claim 22 of the '110 Patent does not recite any novel and unobvious technological feature, and does not solve a technical problem. *Id.* at 5. Referring to claim 22, Petitioner contends that this claim “recites only known technologies, such as a central computer, databases, a communications link, a network, and a user device.” *Id.* Petitioner contends that recitation of these “known technologies” does not render this challenged claim of the '110 Patent a “technological invention.” *Id.* Patent Owner does not argue that challenged claim 22 recites unknown technologies or combinations of known technologies to achieve abnormal, unexpected, or unpredictable results. Thus, we are persuaded that Petitioner demonstrates that at least challenged claim 22 does not solve a technical problem using a technical solution.

For purposes of this decision, we are persuaded that at least challenged claim 22 of the '110 Patent is directed to a covered business method, and, therefore, the '110 Patent is eligible for review under AIA § 18(d)(1).

C. Asserted Grounds of Unpatentability

1. Claim Construction

Under 37 C.F.R. § 42.300(b), “[a] claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” The application, from which the '110 Patent issued, was filed December 8, 1994; and the '110 Patent issued on September 2, 1997. Prelim. Resp. 3. Because the application was pending on June 8, 1995, the '110 Patent is entitled to the longer of a term of seventeen (17) years from the date of issue, *i.e.*, September 2, 2014, or twenty (20) years from the filing date, *i.e.*, December 8, 2014. 35 U.S.C.

§ 154(c)(1). Although currently “unexpired,” the ’110 Patent will expire on December 8, 2014, and, therefore, is likely to expire before a final decision is due in any trial that might have been instituted in this proceeding. *See* AIA § 18(a)(1). Nevertheless, the decision on institution is due *before* the patent will expire. *See also* 35 U.S.C. § 324 (in post grant review, a decision on petition is due within three months of the filing of a preliminary response or of the deadline for filing a preliminary response).

Petitioner argues that the challenged claims are to be given their broadest reasonable interpretation in light of the Specification. Pet. 8.³ Patent Owner argues that, because the ’110 Patent will expire before we are able to render any final decision regarding the merits of the Petition, we should not rely on the broadest reasonable construction of the terms of the challenged claims in analyzing the Petition. Prelim. Resp. 4. As noted above, however, the ’110 Patent currently is *unexpired*, and our regulations provide that we are to apply the broadest reasonable construction to the claims of an *unexpired* patent. 37 C.F.R. § 42.300(b). Further, Patent Owner incorrectly argues that the ability to amend is “the sole rubric behind the use of the broadest reasonable interpretation claim construction.” Prelim. Resp. 4. Thus, Patent Owner argues that, because no amendment of an expired patent is possible, we should apply the same standard applied by

³ Petitioner argues that we should look to Patent Owner’s contentions in litigation regarding the ’110 Patent as evidence of the broadest reasonable interpretation for the claims. Pet. 8. Patent Owner’s infringement contentions are, at best, extrinsic evidence of the meaning of the claim terms, and extrinsic evidence is not favored over intrinsic evidence. *See Toyota Motor Corporation v. American Vehicular Sciences LLC*, IPR2013-00424, slip op. at 15 (PTAB Jan. 14, 2014) (Paper 16).

the United States district courts in construing the terms of these challenged claims. *Id.* at 4–5. As explained by another panel of the Board, however, the difference in claim construction standards arises from the ability of a patent owner in a covered business method proceeding to amend its claims and from the fact that there is no presumption of validity before the Office. *See SAP America, Inc. v. Versata Software, Inc.*, CBM2012-00001, slip op. at 7–19 (PTAB June 11, 2013) (Paper 70). Therefore, Patent Owner does not persuade us that, at this point in the proceeding, we should apply a standard other than broadest reasonable construction when construing the challenged claims of the ’110 Patent.

Petitioner argues the construction for various claim terms, including the preambles of claims 1 and 22; certain non-functional descriptive material in claims 13–15, 31, and 44; “user and/or merchant identifier means” in claim 1; and “communications means” in claim 1. Pet. 9–15. Apart from general objections to Petitioner’s proposed claim constructions, Patent Owner does not specifically contest Petitioner’s proposed claim constructions. *See* Prelim. Resp. 2–5.

After reviewing the Petition, including its supporting evidence, and the Preliminary Response, we are not persuaded by Petitioner’s arguments regarding the preambles of claims 1 and 22. Pet. 10–11. The preamble of claim 1 provides antecedent basis for the following terms that appear in the body of the claim: “at least one list,” “at least one item or group of items,” “a remotely located order processing system,” “one or more merchants,” and “an item code.” Ex. 1001, col. 14, ll. 46–51. Similarly, the preamble of claim 22 provides antecedent basis for “at least one desired item,” “a user,” “a user device,” “a plurality of merchant databases,” “a communications

link,” and “a unique identifying code.” *Id.* at col. 16, ll. 23–29. “When limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.” *Proveris Scientific Corp. v. Innovasystems, Inc.*, 739 F.3d 1367, 1372 (Fed. Cir. 2014). Nevertheless, we are persuaded by Petitioner’s argument that the term “user and/or merchant identifier means” in claim 1 is not a means-plus-function limitation. Pet. 13–14. For purposes of this decision and to the extent express claim construction is required here, we determine that Petitioner’s proposed constructions of the remaining claim terms reflect the broadest reasonable interpretation of those terms, consistent with the Specification of the ’110 Patent.

2. *Obviousness Over Combined Prior Art*

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are “such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). 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. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

Petitioner’s declarant, Dr. Taylor, states that

[i]n patent cases involving information storage and retrieval over a network (including electronic commerce

implementations), the “person having ordinary skill in the art” in the early 1990’s is frequently determined to be a person having a 4-year degree in computer science (or its equivalent) with approximately two years of post-graduate study or equivalent work experience.

Ex. 1011 ¶ 8; *see* Pet. 20. Patent Owner does not contest this description of a person of ordinary skill in the art. Therefore, for purposes of this decision, we accept Dr. Taylor’s description of a person of ordinary skill in the art.

Under 37 C.F.R. § 42.304(b)(4), Petitioner *must* state in the Petition “[h]ow the construed claim is unpatentable under [35 U.S.C. § 103(a), and w]here the grounds for unpatentability are based on prior art, the petition must specify where each element of the claim is found in the prior art.” As noted above, Petitioner asserts the following three grounds of unpatentability:

- i. claims 1–3, 8–15, 17–19, 22, 24, 26–28, 31–36, 41, and 43–44 are unpatentable under 35 U.S.C. § 103(a), over the combined teachings of Viescas, Filepp, and Peapod;
- ii. claims 1–3, 8–19, 22–28, 31–36, 41–44 are unpatentable under 35 U.S.C. § 103(a), over the combined teachings of Viescas, Filepp, Peapod, and DeAngelis; and
- iii. claims 1–3, 8–19, 22–28, 31–36 and 41–44 are unpatentable under 35 U.S.C. § 103(a), over the combined teachings of Viescas, Peapod, and the admitted prior art of DeAngelis.

In particular, Petitioner contends that each of the references—Viescas, Filepp, and Peapod—teaches or suggests all of the limitations of each of

independent claims 1 (Pet. 25–30) and 22 (*id.* at 42–51).⁴ Unlike the other asserted grounds, however, Petitioner contends that the combination of Viescas, Peapod, and the admitted prior art of DeAngelis does not rely on Filepp, because Filepp antedates the filing of the '110 Patent by only about three months. Petitioner expresses concern that Patent Owner might swear behind Filepp. Pet. 66. Therefore, Petitioner requests that we consider the combination of Viescas, Peapod, and the admitted prior art of DeAngelis as an *alternative* ground of unpatentability for trial. *Id.* at 67.

Petitioner contends that a person of ordinary skill in the art would have reason to combine these references because (1) Manual of Patent Examining Procedure (MPEP) 2143 teaches numerous reasons consistent with *KSR* for combining references (*id.* at 21–25) and (2) because Dr. Taylor opines that a person of ordinary skill in the art would find it obvious to combine these references (Ex. 1011 ¶¶ 49–55). We note, however, that (1) citation to the MPEP is insufficient rationale to combine the teachings of the cited references in an adjudicative proceeding, such as a covered business method patent review, and (2) Dr. Taylor provides no evidence to support this opinion. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,763 (“Affidavits expressing an opinion of an expert must disclose the underlying facts or data upon which the opinion is based.”). Thus, we find Dr. Taylor’s

⁴ Petitioner does not contend expressly that Filepp teaches certain limitations of the preamble of claim 1 of the '110 Patent. Pet. 25; *cf. id.* at 42–45 (corresponding elements of claim 22 taught by Filepp). Nevertheless, Filepp describes the “internals” of the Prodigy system (*see* Ex. 1004) and Viescas describes “how-to-use” the Prodigy service for the prospective user (*see* Ex. 1005). Pet. 18–19. Therefore, we understand Petitioner to contend implicitly that Filepp also teaches those limitations of the preamble of claim 1 of the '110 Patent.

opinion on this issue conclusory. Moreover, because neither Petitioner nor Dr. Taylor specifies what teachings of each reference a person of ordinary skill in the art would combine, we find Petitioner's arguments and Dr. Taylor's opinion unpersuasive. Pet. 42–43 (citing Ex. 1011 ¶¶ 49–53).

After reviewing the Petition, the applied art, and the Declaration of Dr. Taylor, as well as the arguments presented by Patent Owner, we determine that Petitioner fails to show where each limitation of challenged claims 1 and 22 is taught by *one* of the combined references. Petitioner must show what reason or reasons a person of ordinary skill in the art would have to combine the limitations allegedly taught by each one of the combined references to achieve the recitations of claims 1 and 22. In particular, it is not sufficient for Petitioner to assert that each of the references teaches all of the limitations of the challenged claims 1 and 22 and then to leave it to us to apply the teachings for Petitioner to demonstrate its asserted grounds. *See* Pet. 18. This is especially true when Petitioner expressly forgoes asserting grounds of unpatentability based on the application of the cited references *individually* to the challenged claims. *Id.* Further, general citations to the MPEP or to the United States Supreme Court's decision in *KSR*, or both, are insufficient to provide an adequate reason or reasons to combine the teachings of the applied references and demonstrate “that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 324(a).

On this record, we are not persuaded that it is more likely than not that Petitioner would prevail in showing that claims 1–3, 8–19, 22–28, 31–36, and 41–44 are unpatentable over any asserted combination of Viescas, Peapod, and the other references. An obviousness inquiry is based on

factual inquiries including the difference between the claimed invention and the prior art. *Graham*, 383 U.S. at 17–18. For independent claims 1 and 22, Petitioner has not articulated any difference between the recited terminal and method and each of Viescas, Filepp, and Peapod. Pet. 25–32, 42–51, 61–63, 64, 66–67. Without having identified specifically the differences between the recited invention and the prior art, Petitioner has failed to make a meaningful obviousness analysis under 35 U.S.C. § 103(a), and, thus, has failed to establish that it is more likely than not that that independent claim 1 or 22 is unpatentable over the asserted *combinations* of Viescas, Peapod, and the other references. Without Petitioner having identified specifically these differences, we are unable to evaluate properly any reason offered by Petitioner for modifying Viescas, and Peapod, in view of the other references. Consequently, Petitioner has failed to demonstrate that it is more likely than not that it would prevail on the ground that independent claims 1 and 22 are unpatentable over Viescas, Peapod, and the other references. For the same reasons, Petitioner also has failed to demonstrate that it is more likely than not that it would prevail with respect to the remainder of the challenged claims.

Accordingly, Petitioner fails to establish that it is more likely than not that Petitioner would prevail in showing unpatentability of claims 1–3, 8–19, 22–28, 31–36, and 41–44 based on Viescas, Filepp, Peapod, and/or DeAngelis.

III. CONCLUSION

For the foregoing reasons, we conclude that the information presented in the Petition fails to establish that it is more likely than not that Petitioner

would prevail in establishing the unpatentability of any of the challenged claims of the '110 Patent.

IV. ORDER

Accordingly, it is

ORDERED that the Petition is *denied* as to all challenged claims.

FURTHER ORDERED that no covered business method patent review is instituted.

PETITIONER:

Christopher Rourk
Nathaniel St. Clair II
JACKSON WALKER L.L.P.
crouk@jw.com
nstclair@jw.com

PATENT OWNER:

Douglas L. Bridges
Melvin Barnes
CAPITOL LEGAL GROUP, PLLC
bridges@capitallegalgroup.com
barnes@capitallegalgroup.com